

HIGHLIGHTS

**SPECIAL EDITION
THE UNITED STATES PATENT AND
TRADEMARK OFFICE (USPTO)**

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A SPECIAL EDITION OF MADRID HIGHLIGHTS

Welcome to this Special Edition of Madrid Highlights, featuring information on the United States Patent and Trademark Office (USPTO) in its role as Office of a Designated Contracting Party under the Madrid Protocol. Thank you to the USPTO for providing the content on pages 4 to 29.

The United States of America is a significant market for branded products and services, so it is no surprise that it is also one of the most frequently designated Contracting Parties under the Madrid System. Since joining the system in 2003, the United States of America has been designated in more than 157,000 international registrations. During the same period, trademark holders from the United States of America have filed approximately 40,000 international applications through the Madrid System.

This inaugural Madrid Highlights Special Edition provides information about two distinctive features of trademark law in the United States of America, namely, the USPTO's approach to the specification of goods and services, and the requirement of use to maintain a grant of protection. It also contains helpful hints and tips when designating the United States of America in an international registration.

We hope you find this publication to be an indispensable reference on the USPTO as Office of a Designated Contracting Party under the Madrid Protocol.

We extend our appreciation and thanks to the USPTO for its kind cooperation in providing the following information on the Madrid System in the United States of America.

Future special editions, featuring information on other highly designated Contracting Parties, are planned in addition to the regular issues of the Madrid Highlights.

THE UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) AS DESIGNATED CONTRACTING PARTY (DCP)

TERMINOLOGY

The following are the terminology and abbreviations used in this article presented in alphabetical order:

- **Common Regulations** = Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement
- **DCP** = designated contracting party under the Madrid System
- **Holder** = the natural or juristic person in whose name the international registration is recorded on the International Register of the IB
- **IA** = international application
- **IB** = International Bureau
- **IR** = international registration
- **MGS** = Madrid Goods & Services Manager
- **MPU** = Madrid Processing Unit; a department within the USPTO designated to the Madrid Protocol System
- **Office action** = letter issued by the USPTO requiring a response to be filed directly with the USPTO
- **Registrant** = the party or holder in whose name the registered extension of protection is granted by the USPTO
- **REP** = request for extension of protection in an international registration or in a request for subsequent designation
- **SD** = subsequent designation
- **TEAS** = USPTO Trademark Electronic Application System
- **TEASi** = USPTO Trademark Electronic Application Submission International System
- **TBMP** = USPTO Trademark Trial and Appeal Board Manual of Procedure
- **TMEP** = USPTO Trademark Manual of Examining Procedure
- **TSDR** = USPTO Trademark Status and Document Retrieval for checking status of applications and registrations, and viewing and downloading application and registration records
- **TTAB** = Trademark Trial and Appeal Board
- **US** = United States of America
- **USPTO** = United States Patent and Trademark Office
- **WIPO** = World Intellectual Property Organization

REQUEST FOR EXTENSION OF PROTECTION TO THE UNITED STATES OF AMERICA

INTRODUCTION

The USPTO has been a member of the Madrid Protocol since November 2, 2003. Extension of protection to the United States (US) may be sought by designating the US either initially in an international application (IA) at the time the IA is filed, or in a subsequent designation (SD) after an international registration (IR) is issued. In the USPTO, a request for extension of protection (REP) is referred to as a “Madrid application,” “Section 66(a) application” (named after Section 66(a) of the US Trademark Act relating to REPs), or “79 series application” (all REPs are assigned a USPTO serial number beginning with “79”); and a REP that is granted protection is referred to as “Madrid registration” or “Section 66(a) registration.” The policies and procedures addressed below apply equally to all REPs regardless of whether the US is designated in the IA or SD. See [TMEP §§1904–1904.15](#) regarding detailed information on REPs to the US.

EXAMINATION OF REQUESTS FOR EXTENSION OF PROTECTION TO THE UNITED STATES OF AMERICA

REPs to the US are not automatically granted protection in the US. REPs are known as “Madrid applications” because they are considered “applications” that must be examined and approved before they are allowed to be registered. This is the same way in which the US national applications are prosecuted. The US incorporated the Madrid application filings into its national application practice. Therefore, regardless of whether it is a Madrid application or US national application, both are examined under the same trademark policies and practices. [TMEP §1904.02\(a\)](#). However, there are a few minor exceptions for Madrid applications that are discussed in this article, such as no option of registration without distinctiveness (i.e., no option of Supplemental Register), no requirement to show use of the mark prior to registration, and no addition of international classes of goods/services to the REP.

REPs are treated and examined like US national applications and are refused registration on the same grounds as US national applications. All USPTO examining attorneys are trained to examine both REPs and US national applications. The assigned examining attorney reviews the application for all grounds, including evaluating the acceptability of the identifications (indications) of goods/services and relative grounds of refusal. REPs that do not satisfy all USPTO requirements at initial review are issued Office actions containing provisional refusals. Applicants are offered an opportunity to respond to the Office actions and provide arguments and/or information to overcome the refusals. Many refusals are easily overcome by submitting the necessary information and/or amending the REP directly with the USPTO. Accordingly, Office actions containing provisional refusals by the USPTO should not discourage applicants, but should be viewed as an opportunity to timely provide the information acceptable to the USPTO examining attorney so that the application may proceed to publication for opposition by third parties.

MATTER REGISTRABLE IN THE UNITED STATES OF AMERICA

All marks in REPs must be eligible for registration on the USPTO Principal Register, meaning the marks must have distinctive character. Distinctive marks include marks that are inherently distinctive (marks by their nature are distinctive) and marks that are proven to have acquired distinctiveness (marks have become distinctive as established by evidence). The types of marks eligible for registration on the USPTO Principal Register are:

- Standard character marks comprising words and letters in Latin characters, numbers in Roman or Arabic numerals, and common punctuation or diacritical marks;
- Two-dimensional design marks with or without wording;
- Marks comprising color only;
- Non-traditional marks such as:
 - Three-dimensional configuration marks (also known as trade dress) with or without wording and/or two-dimensional designs;
 - Sound;
 - Scent;
- Certification marks; and
- Collective trademarks/service marks.

The IA should clearly indicate the nature of the mark to be protected, e.g., the mark is three-dimensional or is a certification mark.

PROVISIONAL REFUSALS BASED ON ABSOLUTE AND RELATIVE GROUNDS – STATUTORY REFUSALS

US trademark law allows for both absolute and relative grounds of refusal. In the USPTO, these refusals are referred to as “statutory refusals” or “substantive refusals” and refusals based on relative grounds are referred to as “likelihood of confusion refusals.” The following are the statutory/substantive grounds for provisional refusals in the US, and the USPTO may refuse registration on one or more of these bases:

- Applicant is not the *owner* of the mark;
- The subject matter for which registration is sought *does not function as a mark* because, for example, the proposed mark:
 - is used solely as a trade name;
 - is functional, i.e., consists of a utilitarian design feature of the goods or their packaging;
 - is a nondistinctive configuration of the goods or their packaging;
 - is mere ornamentation;
 - is the generic name for the goods or services; or
 - is the title of a single creative work or the name of an author or performing artist;
- The proposed mark comprises *immoral or scandalous matter*;
- The proposed mark is *deceptive*;
- The proposed mark comprises matter that may *disparage or falsely suggest a connection with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute*;
- The proposed mark comprises the *flag, coat of arms, or other insignia of the US or any State, municipality, or foreign nation*;
- Applicant’s use of the mark is or would be unlawful because it is *prohibited by statute*;
- The proposed mark comprises a *name, portrait, or signature identifying a particular living individual without the individual’s written consent*, or the name, portrait, or signature of a deceased president of the US during his widow’s life, without written consent of the widow;
- The proposed mark so resembles a previously registered mark as to be likely, when used with applicant’s goods and/or services, to cause confusion or mistake, or to deceive (*likelihood of confusion*); **the USPTO makes such determination with respect to goods/services and not on the basis of classification**;
- The proposed mark is *merely descriptive* (lacks distinctive character) or deceptively misdescriptive of applicant’s goods and/or services; **the USPTO makes such determination with respect to goods/services and not on the basis of classification**;
- The proposed mark is *primarily geographically descriptive* of applicant’s goods and/or services;
- The proposed mark is *primarily geographically deceptively misdescriptive* of applicant’s goods and/or services; and
- The proposed mark is *primarily merely a surname*.

See [TMEP §§1201–1211.02\(b\)\(vii\)](#) for detailed information about these refusals. Generally, some of these statutory/substantive grounds for provisional refusals are based on and only made in cases where use of the mark is claimed and, thus, may not be applicable to designations through the Madrid System.

If a mark is not inherently distinctive (lacks distinctive character), it is not eligible for registration on the USPTO Principal Register. However, applicant may submit a claim and proof of acquired distinctiveness of the entire mark or a portion of the mark (showing the mark or a portion of the mark has become distinctive) under Section 2(f) of the US Trademark Act and still seek registration on the Principal Register. [TMEP §§1212–1212.10](#).

Common Statutory/Substantive Provisional Refusals: The most common statutory/substantive provisional refusals issued by the USPTO are on relative grounds and marks that lack distinctive character.

Relative Grounds – Mark Conflicts with Registered or Earlier Filed Pending Mark – Likelihood of Confusion: Registration will be refused under Section 2(d) of the US Trademark Act because the mark in the REP conflicts with a registered or earlier filed pending mark. This involves consideration of not only the similarities between the marks, but also similarities between the identification (indication) of goods/services. The marks need not be identical; it is sufficient that they are similar. The goods/services also need not be identical; it is sufficient that they are similar or related. The key issue with relative grounds of refusal is not whether the marks themselves, or the goods/services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods/services because of the marks used thereon. See [TMEP §§1207–1208.03\(c\)](#) regarding likelihood of confusion. Unlike some countries, the US trademark law requires examination with respect to goods/services and not on the basis of international class to which the goods/services are assigned. Relatedness of goods/services may be found within the same class or across classes. Therefore, a refusal may be issued as to some, but not all, goods/services within the same class.

Absolute Grounds – Mark Lacks Distinctive Character – Mark is Merely Descriptive: Registration will be refused under Section 2(e)(1) of the US Trademark Act because the mark in the REP lacks distinctive character, meaning the mark merely describes, or is descriptive of, the purpose, function, characteristic, or feature of the identified goods/services. It is not necessary that the mark describes all of the purposes, functions, characteristics, or features, in order for it to be considered merely descriptive. It is enough if the mark describes one significant purpose, function, characteristic, or feature of the identified goods/services. The determination of whether a mark is merely descriptive must be made in relation to the particular goods/services listed in the REP for which registration is sought, and not in the abstract. See [TMEP §§1209–1209.04](#) regarding descriptiveness.

PROVISIONAL REFUSALS BASED ON NON-COMPLIANCE WITH USPTO REQUIREMENTS – PROCEDURAL REQUIREMENTS

The following are additional grounds for provisional refusal for failure to comply with certain US application requirements. In the USPTO, these refusals are referred to as “procedural requirements.” Registration may be refused on the ground that applicant failed to submit:

- Information about applicant ([TMEP §§803–803.06](#)):
 - applicant’s name, and DBA (“doing business as”) designation, if appropriate;
 - applicant’s legal entity type or designation;
 - applicant’s country of citizenship, if an individual or natural person, or the state or country of incorporation or organization, if juristic applicant;
- A clear reproduction (drawing) of the mark ([TMEP §§202.01, 807–807.18](#));
- A description of the mark, if the mark is not in standard characters ([TMEP §§808–808.03\(g\)](#));
- If the mark includes color, a color claim naming the color(s) that is/are a feature of the mark, and a separate color location statement describing where the color(s) appear(s) on the mark ([TMEP §§807.07\(a\)-807.07\(a\)\(ii\)](#));
- A disclaimer of an unregistrable component (descriptive or generic words and images) of an otherwise registrable mark ([TMEP §§1213–1213.11](#));
- A translation of non-English wording and transliteration of non-Latin characters in the mark, if any ([TMEP §§809–809.03](#)); and
- A statement that identifies any living individual whose name or likeness the mark comprises and indicates that his or her consent is of record, or a statement that the name or portrait does not identify a living individual, if appropriate ([TMEP §§813–813.01\(c\)](#)).

SEARCH MARK FOR AVAILABILITY IN THE UNITED STATES OF AMERICA

Before designating the US, applicant is encouraged to search the USPTO database to ensure that the mark sought to be protected is available for use and not confusingly similar to a

registered or earlier filed pending mark for the same or related goods/services. Searches may be conducted free of charge on the USPTO website using the Trademark Electronic Search System (TESS), available at <http://www.uspto.gov/trademark>. TESS provides access to text and images of registered, pending, and abandoned marks. Additional information on registered and pending marks, including current status, may be obtained by entering the USPTO serial number or registration number in the USPTO Trademark Status and Document Retrieval (TSDR) database, available at <http://tsdr.uspto.gov/>.

The USPTO does not search a mark in advance of filing a REP (i.e., conduct a clearance search) for the applicant and cannot provide legal advice regarding an applicant's particular situation, such as whether another mark is confusingly similar to, or likely to be confused with, the mark in the REP. However, after the REP is received, and as part of examination, the USPTO conducts a search of the mark in the REP and refuses registration if the USPTO finds a registered or earlier filed pending mark that is confusingly similar to the mark in the REP and is for the same or related goods/services.

FILING ISSUES AND USPTO REQUIREMENTS WHEN DESIGNATING UNITED STATES OF AMERICA

The following issues and requirements are noteworthy when designating the US.

(1) Registration on USPTO Principal Register Only – No Supplemental Register Option

A mark in a REP is only eligible for registration on the USPTO Principal Register if it is inherently distinctive, or if a claim of acquired distinctiveness has been made and proven under Section 2(f) of the US Trademark Act. Otherwise, registration is refused in the US. Such a mark may not be registered on the USPTO Supplemental Register. [TMEP §1904.02\(f\)](#).

(2) Filing Basis

The filing basis of a REP to the US is Section 66(a) of the US Trademark Act. The Section 66(a) filing basis cannot be combined with any other US filing basis. Section 66(a) requires transmission of a REP by the International Bureau (IB) to the USPTO and cannot be added or substituted as a basis in an application originally filed with the USPTO under Section 1 or Section 44 of the Trademark Act. [TMEP §1904.01\(a\)](#).

(3) Filing Date

If the REP is made initially in the IA, the filing date of the REP is the date of the IR. If the REP is made in a SD, the filing date of the REP is the date on which the SD was recorded by the IB. [TMEP §1904.01\(b\)](#). The filing date is used by the USPTO to prioritize the order in which applications are examined by the USPTO and to determine priority for purposes of publication for opposition by third parties.

(4) Claim of Priority Filing Date Under Paris Convention

To be eligible for a claim of priority under the Paris Convention, applicant must file the REP to the US within six months of the date of the filing that forms the basis of the priority claim. If the US is designated in an IA, the IR date cannot be later than six months after the date of the filing that forms the basis of the priority claim. If the REP is made in a SD, the date of recordal of the SD cannot be later than six months after the date of the filing that forms the basis of the priority claim. The USPTO electronic system uses the dates provided in the IR to automatically calculate whether a REP receives the benefit of a priority claim. [TMEP §1904.01\(e\)](#).

(5) Filing Fee

The filing fee is collected by the IB in Swiss francs (CHF) and forwarded to the USPTO. [TMEP §1904.01\(f\)](#). The current WIPO fee schedule is available at http://www.wipo.int/madrid/en/madridgazette/remarks/ind_taxes.html.

(6) Declaration of Intent to Use – WIPO Official Form MM18

The USPTO requires that, at the time of filing, a REP to the US must include a declaration containing the following statements: (1) applicant has a bona fide intention to use the mark in commerce that the US Congress can regulate on or in connection with the goods/services identified in the IA or SD; (2) the person making the declaration is properly authorized to execute this declaration on behalf of applicant; (3) the person making the declaration believes applicant to be entitled to use the mark in commerce that the US Congress can regulate on or in connection with the goods/services identified in the IA or SD; **AND** (4) to the best of the knowledge and belief of the person making the declaration, no other person, firm, corporation, association, or other legal entity has the right to use the mark in commerce that the US Congress can regulate, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.

The declaration must be signed by: (1) a person with legal authority to bind applicant; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of applicant; **OR** (3) an attorney authorized to practice before the USPTO who has an actual written or verbal power of attorney or an implied power of attorney from applicant. The signature must be a handwritten signature personally signed in permanent ink by the person who is signing. Another person (e.g., paralegal, legal assistant, secretary) may not sign the name of an attorney or other authorized signatory. The name of the person who signs must be set forth in printed or typed form immediately below or adjacent to the signature.

WIPO official form MM18 contains the USPTO declaration language. The MM18 form is part of the IA or SD when the US is designated and must be filed with the IA or SD. The IB ensures that the MM18 form is annexed to the IA or SD, that the wording of the declaration has not been altered, and that the document has been signed before the REP is forwarded to the USPTO. The IB does not send the MM18 form to the USPTO; it remains part of the IR on file at the IB.

See [TMEP §§602–602.03\(e\)](#) regarding persons authorized to practice before the USPTO and [TMEP §1904.01\(c\)](#) regarding declaration of intent to use requirement.

(7) Use of Mark Not Required To Obtain Registration

Unlike US national applications based on use or intent to use in commerce that the US Congress can regulate, the US trademark law does not require REPs to show use of the mark in commerce in order to obtain registration. Therefore, applicants who already use the mark in the US at the time the US is designated need not submit the dates of use of the mark. Instead, all REPs are required to declare their intent to use the mark at the time the US is designated, by completing and filing the WIPO official form MM18 discussed above. However, after a REP is registered, registrant/holder is required to periodically file maintenance documents attesting to the use of the mark in commerce and submitting specimens of such use with the USPTO (Section 71 affidavits or declarations), discussed below, identical to requirements imposed on US national registrants. Although a REP is not required to prove use in commerce that the US Congress can regulate prior to registration, a registration may be challenged by a third party on the basis of non-use in the US. There is a presumption of abandonment where there has been non-use for three consecutive years. [TMEP §1613.11](#), [TBMP §309.03\(c\)](#).

ROLE OF MADRID PROCESSING UNIT (MPU) WHEN THE UNITED STATES OF AMERICA IS DESIGNATED

The Madrid Processing Unit (MPU) is a special unit within the USPTO that reviews Office actions containing provisional refusals of REPs before they are transmitted to the IB, and provides general information to USPTO customers about the prosecution of REPs. MPU does not conduct substantive examination of REPs. The USPTO examining attorneys examine the REPs for registrability. However, MPU reviews each Office action containing a provisional refusal to ensure the USPTO satisfies the Madrid Protocol requirements. MPU also processes many application-related communications between the USPTO and the IB. Examples of MPU duties are: reviewing and processing notices of correction and restriction from the IB; notifying the IB of final dispositions and further decisions of which goods/services in REPs are ultimately granted protection in the US; notifying the IB of cancellations and invalidations of Madrid registrations; and processing requests for transformation and replacement.

EXAMINATION BY AND REQUIREMENTS OF USPTO

REPs or Madrid applications are examined by the same USPTO examining attorneys who examine the US national applications, and are subject to the same statutory/substantive and procedural refusals as US national applications. [TMEP §1904.02\(a\)](#). The following sections identify the common problems seen in REPs, describe the various USPTO requirements, explain how to provide the information before the REP is examined to avoid a provisional refusal, and discuss ways to overcome a provisional refusal if it is issued.

(1) Legal Nature and Citizenship (Nationality) of Applicant

The USPTO requires the legal nature (e.g., entity type) and citizenship (e.g., nationality) of every applicant. The REP to the US may not include this information as it is not a requirement of the IA. However, applicant has the option to include the legal nature and citizenship in the IA and, if included, the IB forwards it to the USPTO as part of the REP. If this information is not in the REP, the USPTO issues an Office action. To avoid an Office action, applicant should include the legal nature and citizenship in the IA. If applicant is an individual (a natural person), he or she must indicate his or her name and the country of which he or she is a citizen or national. If applicant is a juristic entity (a legal entity such as a corporation or limited liability company), the name, legal nature, and the state or nation under whose laws the applicant is organized must be provided. [TMEP §§803.03–803.04](#).

Regardless of whether applicant is an individual or a juristic entity, the USPTO does not accept as applicant's citizenship the country identified as applicant's "entitlement." Entitlement information merely indicates the basis for applicant's entitlement to file an IA, and is not necessarily applicant's national citizenship.

Applicant's legal nature should be consistent with any abbreviation in applicant's name that indicates applicant is a juristic/legal entity. For example, if applicant's name is "ABC, LLC" and "LLC" is the known abbreviation for "limited liability company," then applicant's legal nature should be identified as "limited liability company." If it is identified as something else (e.g., corporation or partnership), the USPTO issues an Office action requiring applicant to clarify the inconsistency.

Where the legal nature indicates a foreign designation or its abbreviation, if that foreign designation or its abbreviation appears in Appendix D of the Trademark Manual of Examining Procedure (TMEP) ([Appendix D – Foreign Entity Appendix](#)), the USPTO may accept the corresponding US equivalent term in Appendix D as applicant's legal nature and not issue an Office action. For example, if applicant's name is "ABC, S.p.A." and legal nature is identified as "Società per Azioni," the USPTO accepts the foreign designation as applicant's legal nature since Appendix D indicates "S.p.A." is the US equivalent of "corporation," "limited share company," or "joint-stock company." Appendix D is a translation tool when applicant's legal nature identifies a

foreign designation. If applicant's legal nature is not provided in the REP, the USPTO issues an Office action requiring this information be supplied directly to the USPTO.

(2) Reproduction (Drawing) and Description of Mark

Reproduction (Drawing) of Mark: A mark in a REP cannot be changed since it is based on the mark in the IR which, in turn, is based on the mark in the basic application/registration. This is true even if the mark in the basic application/registration is changed. Changes to the mark in the basic application/registration are not forwarded to the IB and not reflected in the IR or the REP. While a mark in the REP cannot be changed, the way the mark is reproduced and shown on the drawing may be modified in certain situations, in order to comply with US trademark law and to meet the USPTO drawing requirements. Such modifications are not viewed as changes to the mark but, rather, clarifications as to how the mark is depicted in the reproduction.

The USPTO considers an acceptable reproduction (drawing) as one that: shows good quality image of the mark that clearly depicts all the elements; shows the mark in color, if color is a feature of the mark; does not contain informational matter, such as the US federal registration symbol ®; and shows a single rendition (view) of the mark. If the drawing lacks these basic requirements, the USPTO issues an Office action requiring an amended drawing.

Description of Mark: For all marks not in standard characters, the USPTO requires a description of the mark. An accurate and concise description of the mark must be submitted that describes all significant aspects of the mark, including both literal/textual elements and design elements. [TMEP §§808–808.03\(g\)](#). If the REP does not include a description of the mark or a description is included but is incomplete or inaccurate, the USPTO requires applicant to amend the description to correctly describe all elements of the mark. If the USPTO issues an Office action on this ground, it usually includes a suggested description of the mark, including a color claim and color location statement as part of the description, if appropriate, that applicant may adopt.

The following are the different types of marks that may be granted protection in the US and the USPTO requirements pertaining to each type. If not provided in the REP, the USPTO issues an Office action.

(a) Standard Character Mark

Reproduction (Drawing) of Mark: A mark in standard characters does not claim any specific font, size, or color as a feature of the mark. If applicant intends the mark in the REP to be in standard characters, the USPTO requires that the mark must comply with the US standard character requirements and applicant must submit a claim of standard character. [TMEP §§807.03–807.03\(j\)](#). Due to differences in requirements for standard character claims in different countries, there may be situations where the mark in the IR and REP meets the USPTO requirements for a standard character claim, but no standard character claim is indicated in the IR and REP. If the IR and REP do not state that the mark is in standard characters and applicant seeks to protect the mark in standard characters, applicant may amend the REP to add a claim of standard character. Applicant may not add a standard character claim unless the mark meets the US requirements for standard character.

To avoid an Office action, applicant may submit the standard character claim separately and directly to the USPTO by filing a voluntary amendment, discussed below, as soon as the REP is received in the USPTO and assigned a USPTO serial number. The USPTO uses the following format for the claim: “The mark consists of standard characters without claim to any particular font, size, or color.”

Without a standard character claim, a mark that appears to have stylization, no matter how minor, will be examined as a special form mark, discussed below. The list of standard characters is available on the USPTO website at <http://www.uspto.gov/teas/standardCharacterSet.html>. [TMEP](#)

[§807.03\(b\)](#). **Non-Latin characters are not considered “standard” and any claim of standard character will be disregarded.** Examples of standard character marks are:

COCA-COLA

Registration No.: 4019547

Goods: Lip balm; Lip gloss, in Class 003.

PomaGrand

Registration No.: 3216554

Goods: Fruit juice concentrates; Non-alcoholic beverages containing fruit juices, in Class 032.

Description of Mark: The USPTO does not require a description of the mark for marks in standard characters. Instead, if the mark meets the US standard character requirements and the mark is intended as standard character, applicant must submit a claim of standard character for the record.

(b) Special Form Mark

Reproduction (Drawing) of Mark: A mark is special form if it is not in standard characters. This includes a mark, in whole or in part, in which particular font, size, color, unusual form of punctuation, and/or design elements are a feature of the mark. A special form mark includes a mark that contains superscript, subscript, exponent, or other characters that are not on the list of USPTO standard characters. [TMEP §§807.04–807.04\(b\)](#). The reproduction (drawing) must be of a quality that will reproduce satisfactorily for scanning into the USPTO database. If it is not of a quality that will reproduce satisfactorily for scanning and printing in the USPTO *Official Gazette* and on the certificate of registration, the USPTO requires a new drawing.

Description of Mark: If the mark is special form, the USPTO requires that applicant must provide a description of the mark. If the mark in the REP consists only of wording in stylized font, with no design element, applicant’s completion of the “Verbal elements of the mark” field on the IA may be accepted as the description of the mark, for purposes of compliance with the USPTO description requirement. [TMEP §808.03\(b\)](#). If the reproduction (drawing) of the mark is in color, the USPTO requires applicant to submit the following as part of the description of the mark: (1) a color claim listing all the colors in the mark and stating that the named color(s) is/are a feature of the mark; and (2) a color location statement explaining where each color appears in the mark. [TMEP §§807.07\(a\)–807.07\(a\)\(ii\)](#), [808.02](#).

The following mark types are considered special form marks. Of these, three-dimensional, sound, and color marks are also referred to as “non-traditional marks.”

(i) Mark Comprising Words, Letters and Numerals in Particular Form and/or Two-Dimensional Design

A special form reproduction (drawing) is required if words, letters, numerals, and two-dimensional designs are presented in distinctive form (e.g., particular font, size, color) that engender an uncommon or “special” commercial impression that would be altered or lost if registration issued based on a standard character reproduction. [TMEP §807.04\(b\)](#). The description of the mark must describe in detail all the individual elements that comprise the mark. Examples of such marks are:



Registration No.: 4161375

Services: Beverage delivery services and consultation services provided in connection therewith, in Class 39.

Description: The mark consists of the words "PEPSI DIRECT" in stylized letters and a globe device containing three fields whereby the middle field divides the globe and the globe device is surrounded by a border. There is a curved underline under the word "DIRECT."



Registration No.: 4611348

Goods: Soft drinks, in Class 32.

Description: The mark consists of the word "PEPSI" in white stylized letters in vertical form. The second "P" in "PEPSI" contains a globe device containing three fields. The first field is red, the second field is white, and the third field is blue. The entire mark is on a blue background.

Color Claim: The color(s) red, white and blue is/are claimed as a feature of the mark.

(ii) Three-Dimensional Mark

A three-dimensional mark for goods comprises the configuration (shape) of a product itself or the packaging in which a product is sold. A three-dimensional mark for services comprises, for example, the interior of a restaurant, the exterior of a retail establishment, or a point-of-sale-display such as a costume used by the provider of the services or used in connection with advertising the services. In the USPTO, these marks are referred to as "trade dress." The mark must be depicted on the reproduction (drawing) in a three-dimensional manner that gives the appearance of height, width, and depth to the mark. If the mark comprises only a portion of the trade dress, solid lines must be used on the drawing to show the elements that are claimed as part of the mark, and broken or dotted lines must be used to indicate the portions that are not claimed as part of the mark. [TMEP §§807.10, 1202.02\(c\)\(i\)–1202.02\(c\)\(i\)\(C\)](#).

For goods, the description of the mark must state the mark is "three-dimensional" and constitutes "product design" or "configuration" of the goods themselves or product "packaging" or a "container" in which the goods are sold. For services, the description of the mark must state the mark is "three-dimensional" and constitutes trade dress for the services identified in the REP. The description must specify which elements on the reproduction (drawing) constitute the mark and are claimed as part of the mark, and which are not. The description must make clear what any broken or dotted lines represent and include a statement that the matter shown in broken or dotted lines is not claimed as part of the mark. [TMEP §1202.02\(c\)\(ii\)](#). If the REP does not include a description that meets these standards, the USPTO issues an Office action requiring applicant to provide a description in accordance with these criteria.

It is the responsibility of the applicant to ensure that the mark is, in fact, three-dimensional. When the mark registers and a maintenance document (Section 71 affidavit or declaration) is filed with

the USPTO, discussed below, to show use of the mark in commerce that the US Congress can regulate, the USPTO will examine the specimen to ensure that the mark is three-dimensional. If it is not, the registration may be cancelled and protection of the IR invalidated.

Examples of three-dimensional marks are:



Registration No.: 4503633

Goods: Beers; mineral and aerated waters and other non-alcoholic beverages, namely, alcohol-free beers and non-alcoholic beverages containing fruit juices, in Class 32.

Description: The mark consists of a three-dimensional configuration of packaging for the goods, namely, a bottle of which the bottle top features a graduation hat. The body of the bottle features the design of a single eight pointed star and the word "HUIZON" at the bottom. The bottle features a V-shaped label around the neck, which is not claimed as part of the mark. The outline of the bottle and the label are depicted in broken lines; the broken lines are used to depict the shape and outline of the bottle and represent elements not claimed as part of the mark and serve only to show placement of the mark.



Registration No.: 3963872

Services: Beauty spa services, namely, manicures, pedicures and facials; hair salon services, in Class 44.

Description: The mark consists of trade dress for the interior of a spa and salon that incorporates a brown, pink, fuchsia and off-white color scheme displayed in a manner evoking an ice cream theme. The color brown appears on walls, floor tiles, bench backs, chair seats, and table, counter and bench bases. The color pink appears on wall tiles, table tops, countertops and chair seats. The color fuchsia appears on bench seats. The color off-white appears on bench bases. The representation of the spa and salon shown in dashed or broken lines is intended to show the position of the mark and is not a part of the mark.

Color Claim: The color(s) brown, pink, fuchsia and off-white is/are claimed as a feature of the mark.

If a single rendition (view) of a three-dimensional mark on the drawing does not depict all the elements of the mark, applicant may petition the Director of the US Patent and Trademark Office to waive the single rendition requirement and accept multiple renditions of the mark. In the petition, applicant should explain that the features of the mark cannot be adequately depicted in a single rendition and additional views are necessary to clearly display all the features of the mark being claimed. The USPTO through its Trademark Electronic Application System (TEAS) offers an electronic form for filing a petition, available at <http://go.usa.gov/3rM5j>.

(iii) Sound Mark

A sound mark is comprised solely of sound (e.g., music, words and music, dog barking, duck quacking). The USPTO does not require a reproduction (drawing) of a sound mark. [TMEP §807.09](#). However, the USPTO requires an audio reproduction of the sound mark and a written description of the sound representing the mark, discussed below. Applicant must submit an audio file containing an audio reproduction or recording that contains only the mark itself that is in an electronic file in .wav, .wmv, .wma, .mp3, .mpg, or .avi format and that does not exceed 5 MB in size because TEAS cannot accommodate larger files. The purpose of the audio reproduction is to supplement and clarify the description of the mark.

If the USPTO issued an Office action and applicant responds using the TEAS electronic form “Response to Office Action,” the audio file cannot be attached to, or transmitted with, the response. Instead, after the response is submitted, the audio file must be sent as an attachment to an e-mail message directed to TEAS@uspto.gov, with clear instructions that the electronic audio file should be associated with “the application filed under Serial No. <specify>.” The audio file attached to an e-mail cannot exceed 9 MB.

A detailed description of the sound mark must be provided. If the mark comprises music or words and music, the musical score sheet music should be provided to supplement or clarify the description of the mark. [TMEP §807.09](#). If the USPTO issued an Office action and applicant responds using the TEAS electronic form “Response to Office Action,” the musical score sheet music should be attached as a .jpeg or .pdf file in the “Additional Statements” section of the electronic form, under “Miscellaneous Statements.”

(iv) Color Mark

A color mark is one that consists **solely** of one or more colors used on particular objects. For marks used in connection with goods, color may be used on the entire surface of the goods, on a portion of the goods, or on all or part of the packaging for the goods. For example, a color trademark might consist of purple used on a salad bowl, pink used on the handle of a shovel, or a blue background and a pink circle used on all or part of a product package. Similarly, a color mark for services may consist of color used on all or part of materials used in the advertising and rendering of the services. For instance, a color service mark may be the color brown used on a truck in the rendering of delivery services.

A color mark is never inherently distinctive and, therefore, cannot be registered on the Principal Register. However, color can function as a mark if it is used in the manner of a trademark or service mark and if it is perceived by the purchasing public to identify and distinguish the goods/services on or in connection with which it is used and to indicate their source. In this situation, a color mark may be registered on the Principal Register under Section 2(f) of the US Trademark Act if applicant submits a claim and proof that the mark has acquired distinctiveness (mark has become distinctive). [TMEP §§1202.05–1202.05\(i\)](#).

(v) Collective, Certificate or Guarantee Mark

If the REP indicates the mark is a “collective, certificate, or guarantee mark,” the USPTO issues an Office action requiring applicant to clarify the nature/type of mark for which protection is sought. If the mark is a collective or certification trademark or service mark, applicant must comply with the filing requirements for the particular mark to be protected. See [TMEP §§1302–](#)

[1303.02\(c\)\(ii\)](#) and [TMEP §1305](#) regarding collective marks and [TMEP §§1306–1306.09\(c\)](#) regarding certification marks.

Collective Mark – Definition: A collective mark is a kind of trademark or service mark used by members of a collective organization to show that their goods/services come from members of that organization. Examples of collective organizations are cooperatives, associations, and unions. The collective organization owns the mark but all the members of the collective organization use the mark in connection with the provision of their own goods/services. [TMEP §1302](#).

A collective trademark or collective service mark indicates the commercial origin of goods/services but, as a collective mark, it indicates that the party providing the goods/services is a member of a certain group and meets that group's standards for admission. The mark is used by all members of the group. Therefore, no one member can own the mark and the collective organization holds the title to the collectively used mark for the benefit of all members of the group. The collective organization itself neither sells goods nor performs services under the mark, but may advertise to publicize the mark and promote the goods/services sold by its members under the mark. For example, an agricultural cooperative of produce sellers does not sell its own goods or render services, but promotes the goods and services of its members. [TMEP §1303](#).

Manner of Use: In addition to specifying and containing all elements that are applicable to trademarks and service marks, applicant must specify the class of persons intended to be entitled to use the mark, indicating what their relationship to applicant will be and the nature of the control applicant intends to exercise over the use of the mark. The following language may be used for this purpose: "Applicant intends to control the use of the mark by the members in the following manner: [specify]." A statement that applicant's bylaws or other written provisions specify the intended manner of control is sufficient. [TMEP §§1302–1303.02\(c\)\(i\)](#).

Certification Mark – Definition: A certification mark is a kind of trademark or service mark that certifies objective qualifications and standards of goods/services. A certification mark is one which its owner/certifier permits a person (other than the owner/certifier) to use in commerce that the US Congress can regulate to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods/services or that the work or labor on the goods/services was performed by members of a union or other organization. [TMEP §§1306–1306.09\(c\)](#).

There are two characteristics that differentiate certification marks from trademarks or service marks. First, a certification mark is not used by its owner/certifier and, second, a certification mark does not indicate commercial source or distinguish the goods/services of one person from those of another person. In other words, a certification mark is used by parties (other than the owner/certifier of the mark) who actually provide the goods/services and who have received certification that their goods/services meet the objective standards set by the mark's owner/certifier. The owner/certifier of a certification mark does not use the mark on its own goods/services. The purpose of a certification mark is to inform purchasers that the goods/services possess certain characteristics or meet certain qualifications or standards established by another. A certification mark does not indicate origin in a single commercial or proprietary source. In certifying, the same mark is used on the goods/services of many different providers. [TMEP §§1306.01–1306.01\(b\)](#).

There are generally three types of certification marks: (1) certification marks that certify that goods/services originate in a specific geographic region; (2) certification marks that certify that the goods/services meet certain standards in relation to quality, materials, or mode of manufacture (e.g., approval by Underwriters Laboratories); and (3) certification marks that certify that the work or labor on the products or services was performed by a member of a union or other organization, or that the performer meets certain standards. [TMEP §1306.01](#).

Certification Statement and Certification Standards: In addition to specifying and containing all elements that are applicable to an application for registration of a certification mark, applicant must submit a certification statement and the certification standards. A certification statement indicates the characteristics being certified and, in the case of a geographic certification mark, identifies the general or particular geographic origin of the goods/services. The certification statement must be sufficiently detailed to give proper notice of what is being certified, which may include other characteristics in addition to geographic origin. The statement should begin with the wording “The certification mark, as used (or intended to be used) by authorized persons, certifies (or is intended to certify)” [TMEP §1306.06\(f\)\(i\)](#).

A copy of the certification standards must also be submitted. The certification standards need not have been created by the mark owner/certifier, and may instead be standards established by another party, such as those promulgated by a government agency or developed by a private research organization. The certification standards must, however, encompass the full scope of the goods/services as listed in the REP. For instance, if the goods are “olive oil,” but the submitted certification standards apply only to extra virgin olive oil, applicant must amend the identification to limit the goods to “extra virgin olive oil” or, if possible, submit standards that cover various types of olive oil. [TMEP §1306.06\(f\)\(ii\)](#).

Guarantee Mark: The US Trademark Act does not register guarantee marks.

(3) Disclaimer

If the mark comprises descriptive or generic terms or pictorial representations of descriptive or generic terms (when the picture is equivalent to the written expression), the USPTO requires a disclaimer of such terms and pictorial representations. A disclaimer is a statement in the record that applicant does not claim the exclusive right to use a specified element of the mark. The purpose of a disclaimer is to permit registration of a mark that is registrable as a whole but contains elements that are not registrable standing alone, without creating a false impression of the extent of registrant’s right with respect to certain elements in the mark. The USPTO requires the following format for a disclaimer: “No claim is made to the exclusive right to use ‘_____’ apart from the mark as shown.” [TMEP §§1213–1213.11](#). To avoid an Office action, when designating the US, applicant may include the disclaimer when filing the IA. If a disclaimer is included in the IA, it will be forwarded to all the designated contracting parties (DCPs).

However, no disclaimer is required if the mark as a whole is unitary, meaning the entire mark creates a single commercial impression separate and apart from any individual elements that are descriptive or generic. [TMEP §§1213.05–1213.05\(h\)](#).

(4) Claim of Prior United States of America Registration

If applicant owns an existing registration for the same or similar mark and same or similar goods/services, a claim of prior US live/active registration may be submitted. [TMEP §§812–812.01](#). This provides the examining attorney with information when examining for relative grounds of refusal to determine whether the mark in the REP conflicts with (has a likelihood of confusion with) a registered mark. This information cannot be included in the IA, but may be filed directly with the USPTO in a voluntary amendment, discussed below, as soon as the REP is received in the USPTO and assigned a USPTO serial number. If applicant owns numerous prior registrations, it is sufficient to include two or three registration numbers that are most relevant in terms of the similarity of the marks and relatedness of the goods/services, followed by the wording “and others.” The USPTO standard format for making the claim is: “Applicant is the owner of Reg. No. <specify the number>.” and “Applicant is the owner of Reg. Nos. <specify the numbers> and others.”

(5) Classification of Goods/Services

The IB controls classification of goods/services, i.e., the international class assigned pursuant to Nice Classification System. The USPTO cannot change classification, cannot add classes, and cannot transfer goods/services between classes in a multiple class REP. The USPTO only changes classification if a notice of correction of the classification is received from the IB. The USPTO does not re-classify any goods/services in the REP that the USPTO believes are in the wrong class. Furthermore, if the goods/services in the REP must be amended, the USPTO may only amend to goods/services within the class assigned by the IB. [TMEP §§1401.03\(d\), 1904.02\(b\)](#).

(6) Identification (Indication) of Goods/Services

An application must specify the particular goods/services on or in connection with which the applicant has a bona fide intention to use the mark in commerce that the US Congress can regulate. The applicant must identify the goods/services specifically in order to provide public notice of the particular goods/services which are intended to be used and for which protection is sought, and to allow the examining attorney to conduct proper examination and reach informed judgment concerning relative grounds for refusal (i.e., likelihood of confusion). Therefore, generally, the USPTO does not accept class headings and broad identifications of goods/services. [TMEP §1402.01\(c\)](#). However, the USPTO does accept the wording used in class headings for goods in Class 15 (musical instruments) and Class 23 (yarns and threads for textile use) because “musical instruments” and “yarns and threads for textile use” are deemed definite identifications.

The USPTO identification policy takes into consideration scope and definiteness.

Scope of Identification: When amending the identification, the classification assigned by the IB defines the scope of the goods/services in the REP. Therefore, the USPTO may not allow any amendment that is outside the IB-assigned class. [TMEP §1401.03\(d\)](#). For example, if the goods in the IR and the REP are identified as “clothing, in Class 25,” applicant may only amend the goods to clothing in Class 25. Thus, applicant cannot amend to name any clothing in Class 9, such as “clothing for protection against fire,” since that would be outside the scope of the class assigned by the IB.

In many cases, the identification (indication) of goods/services is merely a repetition of the entire general class heading for a given class. However, use of the words (i.e., the general indications) comprising a class heading as the identification in a REP is not deemed to include all the goods/services in the established scope of that class. In this situation, the USPTO looks to the ordinary meaning of the words for the purposes of determining the scope of the identification. The USPTO does not permit applicant to amend to include any goods/services that fall in the class, unless the goods/services fall within the ordinary meaning of the words (i.e., the general indications) in the **heading**, or to amend to goods/services in other classes. [TMEP §1402.07\(a\)](#).

Amendments of the identification are permitted as long as they limit or clarify the goods/services. Once the identification is amended in a manner that is acceptable to the USPTO, the amendment replaces all previous identifications and restricts the scope of the goods/services to that of the amended language. Further amendments that add to, or expand, the scope of the goods/services are not permitted, even if the goods/services to be added are in the IR or the basic application/registration. [TMEP §1402.07\(e\)](#).

Definiteness of Identification: The USPTO requires that the identification must be definite, meaning it is specific, clear, accurate, and concise. [TMEP §§ 1402.03–1402.03\(f\), 1402.07–1402.07\(e\)](#). The identification should specify the common name of each good/service, using terminology that is generally understood. For goods/services that do not have common names, applicant should use clear and succinct language to describe or explain them. Technical or esoteric language and lengthy descriptions of characteristics or uses are not appropriate. The language should be understandable to the average person and should not require an in-depth

knowledge of the relevant field. The identification may include terms of art in a particular field or industry, but, if those terms are not widely understood by the general population, the identification should include an explanation of the specialized terminology. [TMEP §§1402.01\(c\), 1402.03–1402.03\(f\), 1904.02\(c\)–1904.02\(c\)\(v\)](#). See [TMEP §§1402–1402.15](#) and [TMEP §§1402.11–1402.11\(j\)](#) regarding USPTO practice concerning identifications of goods/services.

The USPTO applies the same standard of specificity of goods/services to REPs that are required for goods/services in US national applications. Goods/services are examined in accordance with the USPTO Acceptable Identification of Goods and Services Manual (ID Manual), available on the USPTO website at <http://tess2.uspto.gov/netahtml/tidm.html>. It is strongly recommended that the USPTO ID Manual be consulted when crafting identifications in response to an Office action. For example, the USPTO does not accept “clothing” for goods in Class 25. Applicant must specify the type of clothing by listing the common name of each item to be protected, such as “clothing, namely, pants, shirts and sweaters” or “children’s clothing, namely, jackets and vests.” Similarly, the USPTO does not accept “business functions” as a service in Class 35. Applicant must specify the field or subject matter of the business function, such as “business functions, namely, business operation, business administration and office functions” or “business functions, namely, business management services for the health care industry.”

Square Brackets in Identification: Under USPTO policy, neither square brackets nor parentheses should be used in the identifications of goods/services. In the USPTO, single square brackets are used to indicate that goods/services have been deleted from a registration and are no longer granted protection. Square brackets and the wording within the square brackets in the USPTO ID Manual is considered informational only. If square brackets appear in identifications (indications) of goods/services in a REP, the examining attorney will issue an Office action requiring applicant to delete the square brackets and the wording within. Failure to respond to the Office action may lead to abandonment, in whole or in part, of the REP.

Punctuation: For ease of examination and clarity for public notice, applicants should use semicolons and commas to separate items within a particular category. Semicolons should generally be used to separate distinct categories of goods/services within a single class. For example, “cleaners, namely, glass cleaners, oven cleaners, and carpet cleaners; deodorizers for pets” is an acceptable identification in Class 3. In this example, the word “cleaners” names the category covering “glass cleaners, oven cleaners, and carpet cleaners.” The semicolon prior to “deodorizers for pets” indicates that the deodorizers are a separate category of goods from the cleaners. When the items are preceded by the word “namely,” a comma should always be used before and after that term. For example, “clothing, namely, hats, caps, sweaters, and jeans” is an acceptable identification of goods in Class 25 and shows proper use of commas. [TMEP §§1402.01\(a\)](#).

If the USPTO issues an Office action on this ground, it usually includes a suggested identification of goods/services that applicant may adopt, if appropriate.

(7) Avoiding Provisional Refusal Regarding Issues Discussed Above

If the REP does not contain all the information necessary to meet the USPTO’s application requirements, the USPTO issues an Office action containing a provisional refusal. Applicant may avoid a provisional refusal as to some or all application requirements in the following ways.

(a) Include Information in International Application

Applicant may provide the information initially in the IA when designating the US. If applicable to the REP, examples of such information include: legal nature and citizenship of applicant; voluntary limitation of the identification (indication) of goods/services to be protected in the US; disclaimer; and translation and/or transliteration. Before designating the US and when crafting identifications, applicant is strongly encouraged to consult WIPO MGS, available on the WIPO website at <http://www.wipo.int/mgs/>, and the USPTO ID Manual, available on the USPTO website at <http://tess2.uspto.gov/netahtml/tidm.html>.

MGS provides an applicant with information about the goods/services that are acceptable to the US and many other DCPs. When designating the US, applicant is encouraged to use the MGS function “Check Acceptance by designated Contracting Party (dCP)” to check whether or not specific wording of goods/services is acceptable in the US. If the goods/services are not shown to be acceptable in the US, applicant is encouraged to consult the USPTO ID Manual for acceptable wording.

(b) Provide Information in Voluntary Amendment Filed Directly With USPTO

Applicant may provide information relevant to the USPTO requirements by filing a voluntary amendment directly with the USPTO. This may be done only after the USPTO sends applicant an application filing receipt acknowledging receipt of the REP by the USPTO and containing the USPTO serial number assigned to the REP. With the serial number, applicant may file the voluntary amendment using the TEAS electronic form “Voluntary Amendment Not in Response to USPTO Office Action/Letter Form,” available at <http://teas.uspto.gov/office/pra>. REPs are assigned to examining attorneys within days after receipt in the USPTO, therefore, the sooner the voluntary amendment is filed, the more likely the assigned examining attorney will see and review it before issuing a first Office action containing a provisional refusal.

If a provisional refusal from the USPTO is anticipated because all the information necessary for registration was not provided in the initial REP, applicant may preempt the refusal by submitting the information in a voluntary amendment. If applicable to the REP, the USPTO requires the following information and applicant is encouraged to submit it via a voluntary amendment:

- Legal nature and citizenship of applicant;
- Claim of standard character;
- Description of the mark;
- Color claim and color location statement;
- Identification (indication) of goods/services: applicant is strongly encouraged to consult the USPTO ID Manual when drafting identifications, available on the USPTO website at <http://tess2.uspto.gov/netahtml/tidm.html>;
- Disclaimer;
- Translation and transliteration; and
- Claim of ownership of prior registration.

See the sections above regarding an explanation of these issues and what the USPTO requires.

(8) USPTO Examination Process and Timeline

The USPTO examination process starts with the assigned examining attorney reviewing the REP and either approving it for publication for opposition by third parties, or issuing a first Office action containing a provisional refusal. If applicant timely responds to the Office action and the response resolves all issues raised in the Office action, the REP is approved and proceeds to publication. If the response does not resolve all issues, a final Office action is issued. Sometimes, the examining attorney may have omitted or mistakenly issued a statutory/substantive refusal or procedural requirement, or applicant’s response raises a new issue. In both cases, a second non-final Office action is issued and, after applicant responds, all outstanding issues, if any, are made final in a final Office action.

After a final Office action, applicant has two response options: (1) amend the REP in a way that resolves and complies with all outstanding issues by filing a request for reconsideration to have the examining attorney reconsider the refusal or requirement; and/or (2) appeal the outstanding issues by filing an appeal with the Trademark Trial and Appeal Board (TTAB). If a request for reconsideration was filed without a notice of appeal and the examining attorney is not persuaded, applicant may then file an appeal, if there is time remaining in the response period. Filing a request for reconsideration does not grant applicant additional time to file an appeal. If the request for reconsideration is denied and no timely appeal is filed, the REP is abandoned. [TMEP §§715–715.04\(b\)](#).

For questions concerning a pending REP, applicant is encouraged to contact the assigned examining attorney.

A typical timeline of the REP application process from initial examination to after registration is available on the USPTO website at <http://go.usa.gov/3rMnT>.

(9) USPTO Office Action Notifying of Provisional Refusal

(a) Deadline for USPTO to Issue Provisional Refusal

As a member of the Madrid Protocol, the USPTO has agreed to notify the IB of all provisional refusals (i.e., reasons why protection cannot be granted in the US) within 18 months of the date the USPTO is notified by the IB. [TMEP §1904.02\(g\)](#).

(b) First Office Action

After review of the REP and determination of which application requirements are not met, the assigned examining attorney drafts the provisional refusal in a first Office action, and identifies and explains each issue. If appropriate, the examining attorney includes suggestions on how to overcome or satisfy each issue. The USPTO sends the first Office action containing the provisional refusal to the IB who then forwards it to the applicant. [TMEP §1904.02\(h\)](#). If applicant has difficulty opening the document from the IB, applicant may view and print that document as well as any other documents relating to the REP from the USPTO TSDR database, available online at <http://tsdr.uspto.gov/>. TSDR provides detailed information about the status and prosecution history of all US trademark applications/registrations. TSDR is available 24 hours a day, 7 days a week, and currently does not require the creation of a user account.

(c) Subsequent Office Actions

After the first Office action, the USPTO sends all subsequent Office actions directly to applicant at the correspondence address of record at the USPTO, not the IB. However, if a new ground of refusal is discovered within the 18 months of the date the USPTO is notified of the REP, it may be raised in a subsequent Office action. In that case, in addition to sending the Office action containing the new provisional refusal to the correspondence address of record, the USPTO also sends a copy to the IB.

(10) Applicant's Response to USPTO Office Action

(a) Deadline to Respond and How to Respond

Applicant has six months to respond to all USPTO Office actions. For the first Office action, the six months starts from the date on which the Office action was sent by the USPTO to the IB. This is the "Mailing Date" located on the IB cover letter accompanying the USPTO's Office action when the IB sends the Office action to applicant. For subsequent Office actions, the six months starts from the "Issue/Mailing Date" identified in the USPTO Office action. [TMEP §1904.02\(h\)](#). The response to the USPTO Office action must be sent directly to the USPTO, not the IB. Applicant is encouraged to file the response electronically using the USPTO TEAS electronic form "Response to Office Action" form, available at <http://teas.uspto.gov/office/roa/>.

(b) Content of Response

The response to an Office action must address all issues raised by the examining attorney in the Office action. Applicant may present arguments against any or all statutory/substantive refusals or procedural requirements, or comply with any or all procedural requirements.

(c) Who Signs Response

If applicant is not represented by an attorney authorized to practice before the USPTO, the individual applicant or someone with legal authority to bind a juristic applicant (e.g., corporate officer or general partner) must sign. In the case of joint applicants who are not represented by an attorney, all joint applicants must sign. If applicant is represented by a US attorney, the attorney must sign. [TMEP §611.03\(b\)](#).

(d) Failure to Respond

If a timely response to any Office action is not received in the USPTO, the USPTO abandons the REP. Applicant (not the IB) is sent a notice of abandonment at the correspondence address of record on file at the USPTO. If only some goods/services in the REP are refused protection, and applicant does not respond to the Office action, the REP is partially abandoned. The goods/services that are refused protection are deleted from the REP. The remaining goods/services are retained and allowed to proceed to publication for opposition by third parties. [TMEP §1904.02\(h\)](#).

Filing Corrections and Restrictions: The filing of a correction or restriction with the IB and the subsequent notification of that correction or restriction from the IB to the USPTO is not considered a “response” to a USPTO Office action. The correction or restriction may be filed with the IB, but applicant must still timely respond to the USPTO Office action, in order to avoid abandonment of the REP. If the correction or restriction moots all statutory/substantive refusals and procedural requirements, the REP proceeds to publication for opposition by third parties. [TMEP §1904.02\(e\)\(iii\)](#).

(e) Petition to Revive Abandoned Application Due to Applicant’s Failure to Respond

When the REP is abandoned for failure to timely respond to the USPTO Office action, applicant may file a petition to revive. The petition must be filed within two months of the date of the notice of abandonment. The fee for filing the petition is \$100 USD, regardless of the number of classes in the REP. Applicant may file the petition using the TEAS electronic form “Petition To Revive Abandoned Application – Failure to Respond Timely To Office Action,” available at <http://teas.uspto.gov/poa/>. [TMEP §§1714–1714.01\(g\)](#).

(f) Request to Reinstate Abandoned Application Due to USPTO Error

Applicant may file a request to reinstate an abandoned REP if the abandonment was due to USPTO error or mistake. Applicant may file the request using the TEAS electronic form “Request for Reinstatement,” available at <http://go.usa.gov/3rMPz>. [TMEP §1712.01](#). Such requests are only granted when an error or mistake on the part of the USPTO is clear on the face of the application record.

(11) Overcoming Statutory/Substantive Refusals and Procedural Requirements

The US trademark law offers several options for a Madrid applicant to overcome a provisional refusal of the REP. These options are the same as those available to US national applicants. However, since a REP cannot be registered on the USPTO Supplemental Register, registration of a REP is only granted on the USPTO Principal Register.

(a) Make Claim of Acquired Distinctiveness Under Section 2(f)

The USPTO may refuse registration on the Principal Register if the mark is found not inherently distinctive (lacks distinctive character) because, for example, the mark is descriptive, geographically descriptive, or the mark comprises a surname. In that case, applicant may seek registration on the Principal Register under Section 2(f) of the US Trademark Act by claiming and proving the mark has acquired distinctiveness (mark has become distinctive). Such claim

requires applicant to show that the mark or the relevant portion of the mark has acquired distinctiveness in commerce that the US Congress can regulate. Although the dates of first use of the mark are not required for a REP, reference to the length of use in commerce or information as to specific dates of use in commerce, presented in support of the claim of acquired distinctiveness, is relevant to a determination of the acceptability of the claim and should be provided. Evidence of use solely in a foreign country, or between two foreign countries, is not evidence of acquired distinctiveness in the US. [TMEP §§1212–1212.10.](#)

(b) Amend Identification (Indication) of Goods/Services

Office actions typically involve the refusal to register some or all the goods/services in the REP on relative grounds (likelihood of confusion) or because the mark lacks distinctiveness. Generally, amendment of the identification (indication) of goods/services to delete or narrow the goods/services to which the refusal applies overcomes the refusal.

(c) Make Arguments Against Refusals and Requirements

Applicant may present arguments against any or all statutory/substantive refusals or procedural requirements to persuade the examining attorney to withdraw the refusals or requirements.

(d) Amend REP

If the examining attorney offered options to overcome the statutory/substantive refusals and procedural requirements and remains unpersuaded by applicant's arguments to withdraw the refusals and requirements, applicant may amend the REP accordingly so that the application may proceed to publication for opposition by third parties.

REQUEST TO DIVIDE EXTENSION OF PROTECTION APPLICATION

Reasons for Dividing: Applicant may divide a REP for any reason by filing a request to divide with the USPTO. [TMEP §§1110–1110.11\(a\).](#) For example, to overcome a provisional refusal that is limited to particular goods/services or classes, applicant may seek to divide the goods/services or classes that are **not** subject to the refusal into a new application. That new application will proceed to publication for opposition by third parties. The original application containing the goods/services or classes that **are** subject to the refusal will continue to be prosecuted by the examining attorney.

Filing Request to Divide Not a Response to Office Action: If the USPTO issued an Office action, filing a request to divide is not a “response” to that Office action. Applicant must file a separate response. Otherwise the REP may be abandoned, in whole or in part.

ASSIGNMENT – CHANGE OF OWNERSHIP

If the mark in a REP is transferred to a new owner, either in whole or in part, an assignment must be filed directly with the IB to record the change of ownership. Once recorded by the IB, the IB notifies the USPTO. Upon receipt of the notice, the USPTO automatically updates its records. If only part of the REP is transferred to a new owner, the USPTO treats this partial change of ownership as a request to divide and the new holder information is reflected in the new “child” application or registration created. The assignment cannot be filed with the USPTO. If filed with the USPTO, the assignment documents are not processed and are returned to the filer. [TMEP §1904.06.](#)

REPRESENTATION BY LOCAL UNITED STATES OF AMERICA ATTORNEY

Applicant is **NOT** required to appoint a local US attorney to represent applicant in prosecuting the REP before the USPTO. However, any attorney who is appointed must comply with the US national regulations on representation before the USPTO. See [TMEP Chapter 600](#) regarding attorney representation.

A foreign attorney or agent who is not authorized to practice before the USPTO may receive correspondence from the USPTO and transmit it to the applicant or registrant. However, a foreign attorney or agent cannot **prepare** an application, response to an Office action, post-registration maintenance document, or other document to be filed in the USPTO; **sign** an amendment, response to an Office action, petition to the Director of the US Patent and Trademark Office, request to change the correspondence address, or letter of express abandonment; or otherwise represent an applicant, registrant, or party to a proceeding in the USPTO. [TMEP §608.01](#).

CORRESPONDENCE ADDRESS WITH USPTO

Applicant/Holder selects who the USPTO corresponds with and that person's name and address is stated as the correspondence address in the USPTO records. [TMEP §§609–609.04](#).

Applicant: If applicant is not represented by a local US attorney, applicant may directly accept correspondence from the USPTO. The USPTO not only sends correspondence to applicant, but also receives communication from applicant, such as responses to Office actions, phone calls, and e-mails.

Applicant's Representative Named in IR and REP: If the IR indicates that applicant appointed a representative to receive communications from the IB, the IB provides that information to the USPTO. The USPTO treats it as the correspondence address of record until a new correspondence address is provided or an authorized US attorney makes an appearance.

Applicant's US Domestic Representative: Applicant may appoint a domestic representative in the US on whom may be served notices or process in proceedings affecting the mark at the USPTO. However, the domestic representative cannot respond to Office actions, and the USPTO cannot discuss the application in phone calls or via e-mail.

Applicant's Local US Attorney: Applicant may appoint a local US attorney to represent them before the USPTO and receive correspondence from the USPTO. The USPTO treats the attorney information as the correspondence address of record and communicates only with that attorney (not applicant or applicant's domestic representative), and accepts responses to Office actions, phone calls, and e-mails from that attorney. If applicant does not have a local US attorney at the time the USPTO issues the first Office action, but a US attorney responds to the Office action on applicant's behalf and provides an address, the USPTO treats the attorney's address as the correspondence address and updates its records. If a US attorney responds without providing a new correspondence address, the USPTO accepts the response. The USPTO will communicate with that attorney, and all correspondence will continue to be sent to the correspondence address of record.

For all correspondence, the USPTO strongly encourages electronic communication. Applicants are encouraged to provide and authorize use of electronic mail addresses to improve efficiency of the registration process. All relevant communications relating to a REP are available online. For complete file content, see <http://tsdr.uspto.gov/>, and for information on submitting electronic communications, see <http://www.uspto.gov/trademarks/teas/index.jsp>.

WARNING: Non-USPTO Solicitations Resembling Official USPTO Communications:

Applicants are notified that private companies not associated with the USPTO are using publicly available information from the USPTO records to mail or e-mail trademark-related solicitations to

applicants, which may include offers: (1) for legal services; (2) for trademark monitoring services; (3) to record trademarks with US Customs and Border Protection; and (4) to “register” trademarks in the company’s own private registry. Applicants are informed that all official correspondence from the USPTO is from the “United States Patent and Trademark Office” in Alexandria, VA and, if by e-mail, specifically from the domain “@uspto.gov.” More information, including the names of some private companies engaged in non-USPTO solicitations, is available at <http://go.usa.gov/3rMPP>.

APPEAL PROCESS

Applicant may file an appeal with the TTAB of any statutory/substantive ground of refusal (e.g., mark is confusingly similar to a registered or earlier filed pending mark or mark lacks distinctiveness) or procedural requirement (e.g., identification (indication) of goods/services or disclaimer) issued by the USPTO. The fee for filing an appeal is \$100 USD per class. The USPTO through the TTAB’s Electronic System for Trademark Trials and Appeals (ESTTA) offers an electronic form for filing an appeal, available at <http://estta.uspto.gov/>. Final decisions of the TTAB may be appealed to a US Federal District Court or to the Court of Appeals of the Federal Circuit. [TMEP §§1501–1501.07, 1904.02\(a\)](#).

OPPOSITION PROCESS

The US trademark law permits a third party to oppose registration of a REP prior to grant of protection. After the USPTO examines the REP and approves it for publication for opposition by third parties, the REP is published in the USPTO Trademark *Official Gazette*. The purpose of publication is to notify the public that the mark, as used in connection with the identified goods/services, has been approved ex officio, and allow a third party the opportunity to oppose registration. The time period to file an opposition is 30 days, starting from the date of publication in the *Official Gazette* and extendable to six months by filing a request for extension of time to oppose. The fee for filing an opposition is \$300 USD per class. The USPTO offers an electronic form for filing an opposition or a request for extension of time to oppose through the TTAB’s ESTTA system, available at <http://estta.uspto.gov/>. An opposition and a request for extension of time to oppose **must** be filed via ESTTA, otherwise, such filings will be refused. [TMEP §§1503–1503.05, 1904.04](#).

CANCELLATION AND INVALIDATION OF GRANT OF PROTECTION IN THE UNITED STATES OF AMERICA

Once a REP is granted protection in the US, the registered extension of protection may be cancelled and invalidated, in whole or in part, due to the following general reasons: (1) cancellation proceedings instituted by a third party before the TTAB; (2) order of a federal court of the US; (3) failure to file acceptable maintenance documents (Section 71 affidavits or declarations) with the USPTO, discussed below; or (4) registrant’s/holder’s voluntary surrender of the registered extension of protection. Once the registered extension of protection is cancelled, the USPTO sends a notice of invalidation to the IB. [TMEP §§1904.07–1904.07\(d\)](#).

TRANSFORMATION

An extension of protection can be transformed only in the event of an Article 6(4) cancellation of the IR, that is, at the request of the **Office of origin** due to the cancellation of the basic application/registration. It is **not** available if the IR expires for failure to renew, is cancelled, in whole or in part, at the request of holder, or is cancelled, in whole or in part, for any other reason.

If the basic application/ registration is restricted, abandoned, cancelled, or expired with respect to some or all goods/services listed in the IR, the Office of origin notifies the IB. The IB cancels the

corresponding goods/services in the IR and notifies the USPTO of the cancellation. Thereafter, the USPTO cancels, in whole or in part, the corresponding goods/services in the registered extension of protection, or abandon, in whole or in part, the corresponding goods/services in the REP application. In this situation, the holder of the IR may “transform” the cancelled registered extension of protection or abandoned REP application into a US national application under Section 1 or Section 44 of the US Trademark Act.

Transformation must be for the same mark and for some or all the restricted, cancelled, expired, or abandoned goods/services that were covered by the extension of protection. The request for transformation must be filed with the USPTO within three months of the date of cancellation of the international registration. This deadline to file cannot be extended. The filing date of the transformed application is the same as the filing date of the REP and any priority claim is carried over to the transformed US application. The fee for filing a request for transformation is \$275 USD or \$325 USD per class if filed electronically or \$375 USD per class if filed on paper. [TMEP §§1904.09–1904.09\(b\)](#). The USPTO through its Trademark Electronic Application Submission International System (TEASi) offers an electronic form for filing a transformation request, available at <http://go.usa.gov/3rMER>.

REPLACEMENT

If a registered extension of protection to the US and a US national registration are (1) owned by the same registrant/holder, (2) identify the same mark, and (3) list the same goods/services, the registered extension of protection shall have the same rights as those accrued to the US national registration at the time the extension of protection registered.

If the conditions of replacement are met, the US national registration is deemed to be replaced by the registered extension of protection by operation of law. If registrant/holder requests that the USPTO note the replacement in the USPTO records, the request is processed when it includes: (1) the serial number or registration number of the registered extension of protection to the US; (2) the registration number of the replaced US national registration; and (3) the \$100 USD per class fee for filing a request to note replacement.

The USPTO examines the request to note replacement to determine that the registered extension of protection: (1) is owned by the same party as the US national registration; (2) that it identifies the same mark; and (3) that the list of goods/services includes all of those covered by the US national registration. If the requirements of noting replacement are met, the USPTO updates its database and notifies the IB accordingly. The USPTO through TEASi offers an electronic form for filing replacement request, available at <http://go.usa.gov/3rMm3>. [TMEP §1904.12](#).

GRANT OF PROTECTION IN THE UNITED STATES OF AMERICA – REGISTERED EXTENSION OF PROTECTION: REQUIREMENTS AFTER REGISTRATION

(1) Renewal of International Registration and Maintenance of Registered Extension of Protection

The registered extension of protection is granted for a limited time and, in order to keep the registration alive/active, registrant/holder must file maintenance documents.

(a) Renewal of International Registration

US trademark law does not require “renewal” of a registered extension of protection to the US. Instead, registrant/holder must file maintenance documents (Section 71 affidavits or declarations) with the USPTO, discussed below. However, registrant/holder must renew the IR with the IB with respect to the US. If the IR is not renewed, the IR expires (“death of IR”) and the IB notifies the USPTO. Thereafter, the USPTO cancels the registered extension of protection. [TMEP §1905](#).

(b) Maintenance of Registered Extension of Protection – Section 71 affidavit or Declaration

After registration is issued by the USPTO, registrant/holder must file a maintenance document at certain times, under Section 71 of the US Trademark Act, in order to keep alive/active the registered extension of protection to the US. This document is required to prove that the mark is used in commerce that the US Congress can regulate. Alternatively, it may be filed to claim excusable nonuse of the mark, meaning the mark is not in use in commerce but registrant/holder believes the registration should not be cancelled because the nonuse is due to special circumstances that excuse the nonuse and not due to any intention to abandon the mark. In the USPTO, this document is referred to as “Section 71 affidavit or declaration.” If this document is not timely filed and/or does not meet the filing requirements, the registration is cancelled and a notice of invalidation is sent to the IB. Thereafter, the holder may subsequently designate the US for extension of protection. See [TMEP §§1613–1613.19](#) regarding filing Section 71 affidavits or declarations and [TMEP §1613.11](#) regarding excusable nonuse.

For registrants/holders who have provided a valid e-mail address to the USPTO and authorized e-mail communication, the USPTO will send a courtesy e-mail reminder of when post-registration maintenance documents are due. Information about such reminders, including eligibility for receipt, the content of the reminders, and how to opt out of receiving them, is available on the USPTO website at <http://go.usa.gov/3rMvA>.

See the USPTO website for helpful tips on filing a Section 71 affidavit or declaration, at <http://go.usa.gov/3rM6z> and <http://go.usa.gov/3rMFC>. A sample Section 71 affidavit or declaration is available at <http://go.usa.gov/3rMFW>.

(i) Time for Filing

The dates for filing the Section 71 affidavit or declaration are calculated from **the date the registered extension of protection is issued by the USPTO (i.e., US registration date), and not the date the IR issued**. The Section 71 affidavit or declaration must be filed: (1) between the fifth and sixth year after the US registration date; (2) between the ninth and tenth year after the US registration date; and (3) within one year before expiration of each subsequent 10-year interval after the US registration date. There is a six month grace period and a grace period fee after each of these time periods in which registrant/holder may file the Section 71 affidavit or declaration. [TMEP §1613.04](#). The USPTO through TEASi offers an electronic form for filing a Section 71 affidavit or declaration, available at <http://teas.uspto.gov/postreg/sect71>.

(ii) Filing Requirements

The following are the requirement for filing a Section 71 affidavit or declaration, [TMEP §1613.05](#):

- Filed by holder of the IR;
- Include the US registration number;
- Include the fee, currently \$100 UDS per class, and if filed during the grace period, the additional grace period fee, currently \$100 USD per class;
- List the goods/services that are in use; the goods/services for which excusable nonuse is claimed; and/or any goods/services that are to be permanently deleted from the registration;
- State the mark is in use in commerce that the US Congress can regulate on or in connection with the goods/services in the registration, or if the mark is not in use in commerce on or in connection with all the goods/services in the registration, state the date when use stopped, the approximate date when use is expected to resume, and recite facts to show that nonuse as to the stated goods/services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark;
- Include a statement attesting to the use in commerce that the US Congress can regulate or excusable nonuse of the mark, signed and verified (sworn to) by a person who is properly authorized to sign on behalf of the holder; and

- Provide one acceptable specimen showing current use of the mark for each class of goods/services, unless excusable nonuse is claimed. When requested by the USPTO, additional specimens and/or information about the submitted specimens must be provided.

(iii) Examination by Post Registration Division

Once filed, the Section 71 affidavit or declaration is examined by the Post Registration Division of the USPTO. If it does not meet all the filing requirements, the Post Registration Division issues an Office action notifying registrant/holder of the deficiencies and allowing six months to respond to the Office action. Failure to respond results in cancellation of the registration and a notice of invalidation to the IB. If all filing requirements are met, the approval of the Section 71 affidavit or declaration is published in the USPTO Trademark *Official Gazette*. The following requirements are particularly noteworthy when filing the Section 71 affidavit or declaration.

Ownership: The Section 71 affidavit or declaration must be filed by the “holder” of the IR. Section 60 of the US Trademark Act defines “holder” as “the natural or juristic person in whose name the international registration is recorded on the International Register.” The USPTO does not accept a Section 71 affidavit or declaration if it is not filed by the holder. [TMEP §§1613.07–1613.07\(e\)](#).

Specimen: The Section 71 affidavit or declaration must include one acceptable specimen or facsimile for each class showing current use of the mark in commerce that the US Congress can regulate on or in connection with the registered goods/services, unless excusable nonuse is claimed. The USPTO may require, and registrant/holder must provide, additional specimens. [TMEP §§1613.12–1613.12\(c\)](#). See [TMEP §§904.03–904.04\(c\)](#) regarding trademark specimens and [TMEP §§1301.04–1301.04\(h\)\(ii\)](#) regarding service mark specimens. The specimen must show use of essentially the same mark as the mark shown in the registered extension of protection, and must be used on or in connection with the goods/services listed in the registration. A specimen is not acceptable if it shows use of a materially different mark, or shows use of the mark on goods/services not identified in the registration.

A Section 71 affidavit or declaration that does not include an acceptable specimen for each class of goods/services is deficient. The Post Registration Division issues an Office action requiring registrant/holder to submit a substitute specimen. In a multiple class registration, registrant/holder may submit one (or same) specimen if it shows acceptable use of the mark in connection with each class, but registrant/holder should state so in the filing. The Post Registration Division does not require multiple copies of the same specimen but may enter a notation in the registration record indicating which classes the specimen supports.

Fees: The Section 71 affidavit or declaration must include the fee for each class of goods/services that the Section 71 affidavit or declaration covers. If the Section 71 affidavit or declaration is filed within the grace period, the grace period fee is also due. If all the required fees are not included, the Section 71 affidavit or declaration is deficient. The Post Registration Division issues an Office action requiring the submission of the missing fees. The missing fees may be paid before expiration of the deadlines set forth in Section 71 of the US Trademark Act without payment of a deficiency fee, or after expiration of the deadlines with the payment of a deficiency fee. Only a single deficiency fee is required to correct one or more deficiencies in one Section 71 affidavit or declaration. [TMEP §§1613.06–1613.06\(c\)](#). The USPTO current fee schedule is available at <http://go.usa.gov/3rMFR>.

(2) Division of Registered Extension of Protection

A registered extension of protection to the US will only be divided if there is a partial change of ownership filed at the IB, as discussed in the assignment section above. [TMEP §1615.02](#).

MADRID TIPS

CHECKLIST FOR AVOIDING PROVISIONAL REFUSALS BASED ON UNITED STATES OF AMERICA REQUIREMENTS

All of the information provided below is *optional*. However, in order to avoid a provisional refusal from the USPTO when designating the US, the applicant should include the following information on the MM2 form when filing the IA.

- Nationality (citizenship) and legal nature
If the applicant is a natural person, the nationality of the applicant should be included in item 2(f)(i); or

If the applicant is a legal entity (e.g., corporation or limited liability company), the legal nature and place incorporated should be included in item 2(f)(ii), corresponding to any abbreviation in applicant's name in item 2(a). See [Appendix D](#) (Foreign Entity Appendix) of the Trademark Manual of Examining Procedure (TMEP).
- Claim of standard character
If a description of the mark is not included in item 9(e), a standard character should be claimed in item 7(c). Please note that a standard character is equivalent in the US to a word mark, as opposed to a figurative mark.
- Reproduction (Drawing) of mark
The mark in item 7(a) should be clear and all elements legible. The mark should not contain the US federal registration symbol (®).
- Description of the mark
If the applicant does not claim standard character, a description of the mark should be included in item 9(e).
- Color claim and color location statement
If the mark includes color, a color claim and a color location statement should be included in item 8(a) and (b), respectively. The color location statement must be identical to the description of the mark in item 9(e).
- Identification (indication) of goods/services
If the indication of goods/services in item 10(a) contains class headings or broad terms, a limitation with respect to the US should be included in item 10(b) to identify goods/services that are acceptable to the USPTO. See [WIPO Madrid Goods & Services Manager](#) (MGS) and [US Acceptable Identification of Goods and Services Manual](#) (ID Manual) for acceptable identifications.
- Disclaimer
If the mark comprises descriptive or generic terms or pictorial representations of the terms, a disclaimer of such terms and pictorial representations should be included in item 9(g). If a disclaimer is included in the international application, it will apply to the international registration as a whole (meaning for all the designated Contracting Parties).
- Translation
If the mark comprises non-English wording, the translation should be included in item 9(b).

FREQUENTLY ASKED QUESTIONS (RELATING TO UNITED STATES OF AMERICA DESIGNATION)

Question 1: I am a foreign representative before the International Bureau. Can I sign the form MM18 on behalf of my client?

Answer: A foreign representative cannot sign on behalf of the applicant unless he or she: (1) is an attorney authorized to practice before the USPTO; (2) has legal authority to bind the applicant (e.g., corporate officer); or (3) has firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant.

Question 2: I am one of the joint holders and I am authorized to sign on other's behalf. Can we file a single form MM18 with the Office of origin?

Answer: Regardless of your authority, each joint applicant must sign the form MM18.

Question 3: I have received a provisional refusal from the USPTO about the lack of information such as legal nature, claim of standard character, description of the mark, color claim, disclaimer and translation. Can I include this information in the international registration?

Answer: No, you cannot include such information in the International Register after the international registration issues. However, you can provide the information directly to the US by filing a response to the Office action containing the provisional refusal.

Question 4: Who may file and sign the Section 71 affidavit of use with the USPTO?

Answer: The Section 71 affidavit of use must be **filed** in the name of the holder of the IR. The Section 71 affidavit must be **signed** by the holder or a person properly authorized to sign on behalf of the holder. That person may be: (1) an attorney authorized to practice before the USPTO; (2) a person with legal authority to bind the holder (e.g., corporate officer); or (3) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the holder.

Question 5: Can the Section 71 affidavit of use be filed with the International Bureau?

Answer: No. The Section 71 affidavit of use must be filed directly with the USPTO.

Question 6: I am a foreign representative. Can I receive the Section 71 affidavit reminder from the USPTO?

Answer: If your email address is recorded in the USPTO record in the Correspondence Field, the reminder will be sent to you. You are encouraged to check and/or update these addresses to ensure that the notice is sent to the proper address.

Question 7: We have already filed Section 71 maintenance documents with the USPTO. Why should we also renew the international registration with the International Bureau?

Answer: The filing of the Section 71 affidavit of use is the special requirement under US Law. Under the Madrid system, the holder must renew the international registration with the International Bureau.

Question 8: Our designation of the US has been invalidated at the USPTO more than 6 months ago. Why has the invalidation not been recorded in the International Register?

Answer: The International Bureau cannot record the invalidation in the International Register until the USPTO notifies the International Bureau.

Question 9: Is there any time limit for the sending of the invalidation notice to the International Bureau?

Answer: No. It is entirely up to each Office to decide when the invalidation can be sent to the International Bureau. For example, the USPTO transmits such a notice approximately between 8 and 12 months after the date the registered extension of protection to the US is cancelled. The reason for this delay is to allow opportunity for the holder/registrant to appeal an incorrectly cancelled registration.

CONTRACTING PARTIES

ACCESSION OF CAMBODIA TO THE MADRID PROTOCOL

Cambodia became the 95th member of the Madrid System on March 5, 2015, following the deposit with the Director General of WIPO of its instrument of accession to the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Protocol will enter into force, with respect to Cambodia, on June 5, 2015, allowing businesses to register their trademarks in more than 110 countries.

USEFUL INFORMATION

NEW VERSION OF THE MADRID E-RENEWAL SERVICE

An updated version of the [E-Renewal](#) service for the international registration of marks is now available. This service allows you to file online a request for a renewal of an international registration, before its expiration date or within the six-month grace period following this date. You can pay the due fees using a [WIPO Current Account](#) or a credit card.

It provides the following features:

- Detailed and up-to-date information on the international registration (international registration number, holder, Office of Origin, representative, designated Contracting Parties);
- Visual reproduction of the mark when applicable;
- Status of protection per designated Contracting Party;
- Calculation table of applicable fees displayed per type and per Contracting Party; and
- Automatic confirmation e-mail with the details of the renewal.

Fees are calculated according to the rules in the [Common Regulations](#) under the Madrid System, taking into account the goods and services protected in the designated Contracting Parties, after the recording of a final decision. Madrid E-Renewal now covers limitations, transfers and invalidations on goods and services for designated Contracting Parties.

To renew the international registration for a Contracting Party in respect of all the goods and services, including those for which protection was not granted, do not use Madrid E-Renewal. Instead please request this renewal in paper format, using [Form MM11](#).

For further information on the E-Renewal service functions and fees calculation, read the [news item](#).

MADRID E-FILING AVAILABLE FOR AUSTRALIAN BRAND OWNERS

Australian trademark holders can now apply online to protect and manage their marks in key export markets through the Madrid E-Filing service.

Madrid E-Filing via IP Australia's eServices provides secure electronic access to the Madrid Registry and helps trademark holders to avoid procedural difficulties in filing international trademark applications.

Benefits for trademark applicants:

- Data entry validation based on national records. This helps to reduce irregularities and “unable to certify notices”, and speeds up processes.
- Payment of applicable fees in Swiss Francs in one single transaction using a WIPO Current Account or a credit card.
- Streamlined processing at the Office of Origin - IP Australia.
- Immediate transmission to WIPO. No time is lost in communication between the Office of Origin and WIPO.
- Online monitoring of applications and portfolios. Electronic notifications and critical processing dates allow live tracking of registrations.

Further information on [Madrid E-Filing in Australia](#).

TRAINING WORKSHOP FOR NATIONAL OFFICES ON THE OPERATIONS OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

The next Training Workshop for National Offices will take place in Geneva, Switzerland, from April 15 to 17, 2015. It provides training on the role of Offices in the Madrid System and in-depth information on communications to and from WIPO, including WIPO's newest IP tools and databases. The workshop is specifically designed for new Contracting Parties to the Madrid Protocol, Developing Countries and Least Developed Countries (LDCs).

THE 137th ANNUAL MEETING OF THE INTERNATIONAL TRADEMARK ASSOCIATION (INTA)

WIPO will participate in the 137th Annual Meeting of the International Trademark Association (INTA) from May 2 to 6, 2015, in San Diego, California, United States of America. Detailed information on the 137th INTA Annual Meeting can be found at INTA's web site: <http://www.inta.org/2015AM/Pages/Home.aspx>.

Members of the WIPO Delegation will be available to answer questions regarding the acquisition and maintenance of trademark and industrial designs rights via the Madrid System for the International Registration of Marks and the Hague System for the International Registration of Industrial Designs and the resolution of disputes regarding all forms of intellectual property as well as domain names at the WIPO Arbitration and Mediation Center.

The provisional program of the Madrid System User's Meeting (MSUM) during the 137th INTA Annual Meeting is available at the WIPO web site at: http://www.wipo.int/export/sites/www/madrid/en/docs/inta_2015_program.pdf.

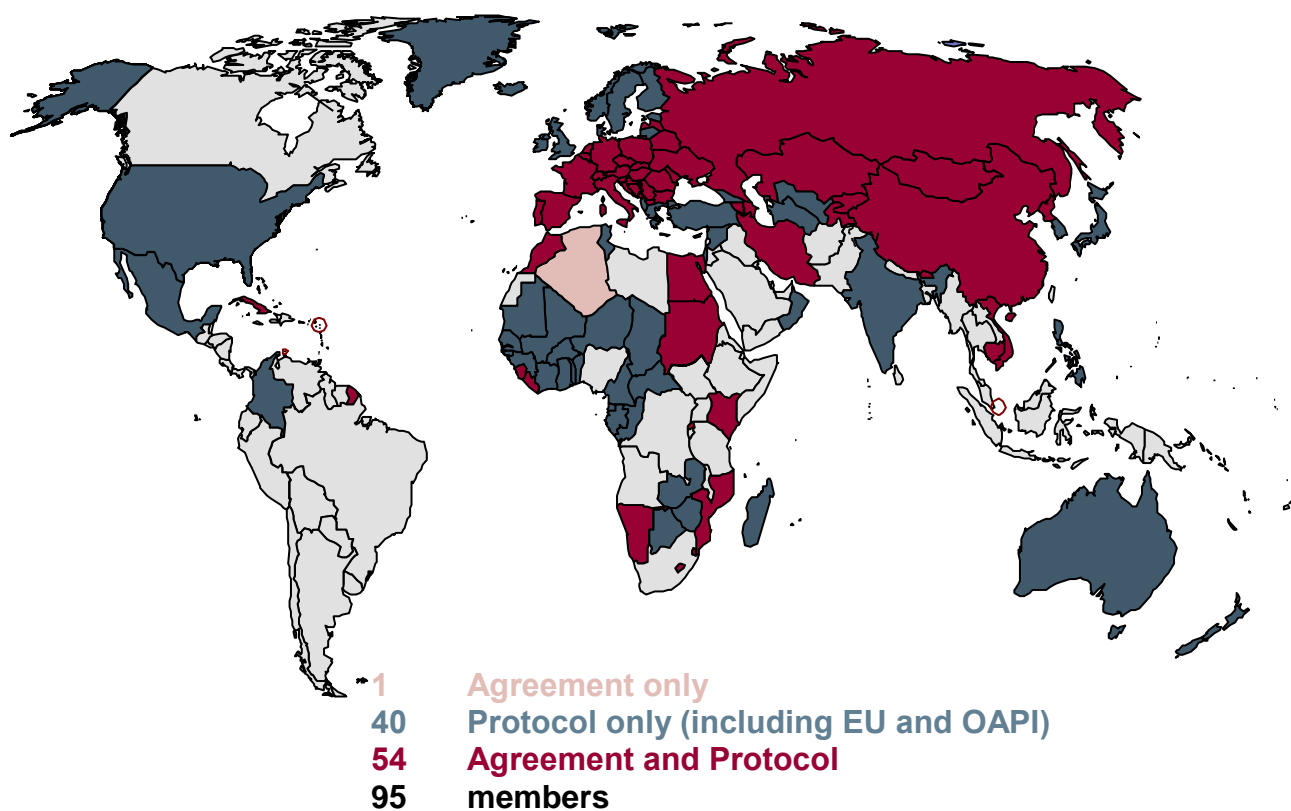
SPANISH VERSION OF THE TENTH EDITION OF THE NICE CLASSIFICATION

The International Bureau, in cooperation with the Spanish-speaking Madrid Union members (Cuba, Colombia, Mexico and Spain) has finalized the update of the NCL10-15 Spanish version on October 15, 2014. The complete list of goods and services including explanatory notes was published on January 1, 2015, and it is available through the following link:

<http://web2.wipo.int/nef/en/project/1435/NS015>.

In order to access the documents, please click on the number of the annex you need (column ANX).

MADRID UNION MAP



HOW TO CONTACT US:

Telephone Opening hours: 9:00 a.m. to 6:00 p.m. Geneva time
(3.00 a.m. to 11.00 a.m. US Eastern time zone).

General Queries: Madrid Customer Service, +41 22 338 8686, intreg.mail@wipo.int

Extracts Queries: Madrid Clients Records Unit, +41 22 338 8484, madrid.records@wipo.int

Specific Queries: Madrid Processing Teams, specialized by your Office of Origin/residence

Team 1:madrid.team1@wipo.int

+41 22 338 750 1

Team 2:madrid.team2@wipo.int

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