**Tips for Avoiding Denial of Certification**

**of International Application**

**March 2016**

For purposes of certification of the international application and comparison of the information in the international application with the information in the basic application(s)/registration(s), the information in the basic record(s) on the date the Madrid Processing Unit (MPU) reviews the international application controls and not the date the international application was filed.

Prior to filing an international application with the USPTO, ensure the following is considered. Slight differences will trigger a denial of certification by MPU.

**Use TSDR and Not TESS**

When filling out an international application, look to the information for the basic application(s)/registration(s) in the Trademark Status and Document Retrieval (TSDR) system and NOT the Trademark Electronic Search System (TESS). The information displayed in TSDR better reflects how it should be entered in the international application.

**Ownership**

The owner of the international application must be the same as the owner in all of the basic application(s)/registration(s) on the date the international application is reviewed for certification.

*Assignment Filed Within Days of Filing International Application*: If an assignment has been filed in the basic application(s)/registration(s), the applicant should wait until the Assignment Recordation Branch has recorded the assignment before filing the international application to ensure that the correct owner is reflected in the USPTO records.

**Mark**

The mark in the international application must be the same as the mark in all of the basic application(s)/registration(s) on the date the international application is reviewed for certification.

*Color*: If there is a color drawing in the basic application(s)/registration(s) but color is not claimed as a feature of the mark, using the pre-populated TEASi form at the time the international application is filed will generate a black and white drawing in the international application, resulting in a denial of certification, as the marks are not the same.

* If the applicant **does not** want to claim color in the international application, the applicant MUST amend the drawing in the basic application(s)/registration(s) to a black and white drawing BEFORE filing the international application.
* If the applicant **does** want a color mark in the international application and color is not yet claimed in the basic application(s)/registration(s) (even though a color drawing appears in the basic record(s)), the applicant MUST use the free-text TEASi form to upload a color drawing of the mark.

**Description of Mark**

The description of the mark in the international application must be the same as the description of the mark in all of the basic application(s)/registration(s) on the date the international application is reviewed for certification.

**Goods/Services**

The goods/services listed in the international application must be the same as or less than the goods/services listed in the basic application(s)/registration(s) on the date the international application is reviewed for certification.

**Amending Basic Application(s)/Registration(s) to Comply with Above Guidance**

When preparing to file the international application, if it is discovered that changes need to be made to the basic application(s)/registration(s) to comply with the above guidance, the applicant may amend the basic application(s)/registration(s) as follows:

**Amending Basic Application(s):**

* If the basic application **is not assigned** to an examining attorney, the applicant may file a voluntary amendment. A TEAS form (Voluntary Amendment Not in Response to USPTO Office Action/Letter) is available at: <http://teas.uspto.gov/office/pra>.
* If the basic application **is assigned** to an examining attorney, the applicant should contact the examining attorney to request the necessary amendment(s).

**Amending Basic Registration(s):** The applicant should file a Section 7 amendment with the Post Registration Unit. A TEAS form (Section 7 Request for Amendment or Correction of registration Certificate) is available at: <http://teas.uspto.gov/s7r/>.

**Filing an Assignment in Basic Application(s)/Registration(s):** The applicant may file an assignment with the Assignment Recordation Branch using the Electronic Trademark Assignment System (ETAS), available at: <https://etas.uspto.gov/>.

Prior to filing the international application, the applicant is encouraged to contact the Petitions Office at 571-272-8950 with any questions or for clarification about the guidance above.