

103<sup>D</sup> CONGRESS  
1<sup>ST</sup> SESSION

# S. 977

To amend the Trademark Act of 1946 to provide for the registration and protection of trademarks used in commerce, in order to carry out provisions of certain international conventions, and for other purposes.

---

## IN THE SENATE OF THE UNITED STATES

MAY 18 (legislative day, APRIL 19), 1993

Mr. DECONCINI introduced the following bill; which was read twice and referred to the Committee on the Judiciary

---

## A BILL

To amend the Trademark Act of 1946 to provide for the registration and protection of trademarks used in commerce, in order to carry out provisions of certain international conventions, and for other purposes.

1       *Be it enacted by the Senate and House of Representa-*  
2       *tives of the United States of America in Congress assembled,*

3       **SECTION 1. SHORT TITLE.**

4       This Act may be cited as the “Madrid Protocol Imple-  
5       mentation Act”.

1 **SEC. 3. PROVISIONS TO IMPLEMENT THE PROTOCOL RE-**  
2 **LATING TO THE MADRID AGREEMENT CON-**  
3 **CERNING THE INTERNATIONAL REGISTRA-**  
4 **TION OF MARKS.**

5 The Act entitled “An Act to provide for the registra-  
6 tion and protection of trade-marks used in commerce, to  
7 carry out the provisions of certain international conven-  
8 tions, and for other purposes”, approved July 5, 1946, as  
9 amended (15 U.S.C. 1051 and following) (commonly re-  
10 ferred to as the “Trademark Act of 1946”) is amended  
11 by adding after section 51 the following new title:

12 “TITLE XII—THE MADRID PROTOCOL

13 **“SEC. 60. DEFINITIONS.**

14 “For purposes of this title:

15 “(1) MADRID PROTOCOL.—The term ‘Madrid  
16 Protocol’ means the Protocol Relating to the Madrid  
17 Agreement Concerning the International Registra-  
18 tion of Marks, adopted at Madrid, Spain, on June  
19 27, 1989.

20 “(2) BASIC APPLICATION.—The term ‘basic ap-  
21 plication’ means the application for the registration  
22 of a mark that has been filed with an Office of a  
23 Contracting Party and that constitutes the basis for  
24 an application for the international registration of  
25 that mark.

1           “(3) BASIC REGISTRATION.—The term ‘basic  
2 registration’ means the registration of a mark that  
3 has been granted by an Office of a Contracting  
4 Party and that constitutes the basis for an applica-  
5 tion for the international registration of that mark.

6           “(4) CONTRACTING PARTY.—The term ‘Con-  
7 tracting Party’ means any country or inter-govern-  
8 mental organization that is a party to the Madrid  
9 Protocol.

10           “(5) DATE OF RECORDAL.—The term ‘date of  
11 recordal’ means the date on which a request for ex-  
12 tension of protection that is filed after an inter-  
13 national registration is granted is recorded on the  
14 International Register.

15           “(6) DECLARATION OF BONA FIDE INTENTION  
16 TO USE THE MARK IN COMMERCE.—The term ‘dec-  
17 laration of bona fide intention to use the mark in  
18 commerce’ means a declaration that is signed by the  
19 applicant for, or holder of, an international registra-  
20 tion who is seeking extension of protection of a mark  
21 to the United States and that contains a statement  
22 that—

23                   “(A) the applicant or holder has a bona  
24 fide intention to use the mark in commerce,

1           “(B) the person making the declaration be-  
2 believes himself or herself, or the firm, corpora-  
3 tion, or association in whose behalf he or she  
4 makes the declaration, to be entitled to use the  
5 mark in commerce, and

6           “(C) no other person, firm, corporation, or  
7 association, to the best of his or her knowledge  
8 and belief, has the right to use such mark in  
9 commerce either in the identical form of the  
10 mark or in such near resemblance to the mark  
11 as to be likely, when used on or in connection  
12 with the goods of such other person, firm, cor-  
13 poration, or association, to cause confusion, or  
14 to cause mistake, or to deceive.

15           “(7) EXTENSION OF PROTECTION.—The term  
16 ‘extension of protection’ means the protection result-  
17 ing from an international registration that extends  
18 to a Contracting Party at the request of the holder  
19 of the international registration, in accordance with  
20 the Madrid Protocol.

21           “(8) HOLDER OF AN INTERNATIONAL REG-  
22 ISTRATION.—A ‘holder’ of an international registra-  
23 tion is the natural or juristic person in whose name  
24 the international registration is recorded on the  
25 International Register.

1           “(9) INTERNATIONAL APPLICATION.—The term  
2           ‘international application’ means an application for  
3           international registration that is filed under the Ma-  
4           drid Protocol.

5           “(10) INTERNATIONAL BUREAU.—The term  
6           ‘International Bureau’ means the International Bu-  
7           reau of the World Intellectual Property Organiza-  
8           tion.

9           “(11) INTERNATIONAL REGISTER.—The term  
10          ‘International Register’ means the official collection  
11          of such data concerning international registrations  
12          maintained by the International Bureau that the  
13          Madrid Protocol or its implementing regulations re-  
14          quire or permit to be recorded, regardless of the me-  
15          dium which contains such data.

16          “(12) INTERNATIONAL REGISTRATION.—The  
17          term ‘international registration’ means the registra-  
18          tion of a mark granted under the Madrid Protocol.

19          “(13) INTERNATIONAL REGISTRATION DATE.—  
20          The term ‘international registration date’ means the  
21          date assigned to the international registration by the  
22          International Bureau.

23          “(14) NOTIFICATION OF REFUSAL.—The term  
24          ‘notification of refusal’ means the notice sent by an  
25          Office of a Contracting Party to the International

1 Bureau declaring that an extension of protection  
2 cannot be granted.

3 “(15) OFFICE OF A CONTRACTING PARTY.—The  
4 term ‘Office of a Contracting Party’ means—

5 “(A) the office, or governmental entity, of  
6 a Contracting Party that is responsible for the  
7 registration of marks, or

8 “(B) the common office, or governmental  
9 entity, of more than 1 Contracting Party that  
10 is responsible for the registration of marks and  
11 is so recognized by the International Bureau.

12 “(16) OFFICE OF ORIGIN.—The term ‘office of  
13 origin’ means the Office of a Contracting Party with  
14 which a basic application was filed or by which a  
15 basic registration was granted.

16 “(17) OPPOSITION PERIOD.—The term ‘opposi-  
17 tion period’ means the time allowed for filing an op-  
18 position in the Patent and Trademark Office, includ-  
19 ing any extension of time granted under section 13.

20 **“SEC. 61. INTERNATIONAL APPLICATIONS BASED ON UNIT-**  
21 **ED STATES APPLICATIONS OR REGISTRA-**  
22 **TIONS.**

23 “The owner of a basic application pending before the  
24 Patent and Trademark Office, or the owner of a basic reg-  
25 istration granted by the Patent and Trademark Office,

1 may file an international application by submitting to the  
2 Patent and Trademark Office a written application in  
3 such form, together with such fees, as may be prescribed  
4 by the Commissioner.

5 **“SEC. 62. CERTIFICATION OF THE INTERNATIONAL APPLI-**  
6 **CATION.**

7 “Upon the filing of an application for international  
8 registration and payment of the prescribed fees, the Com-  
9 missioner shall examine the international application for  
10 the purpose of certifying that the information contained  
11 in the international application corresponds to the infor-  
12 mation contained in the basic application or basic registra-  
13 tion at the time of the certification. Upon examination and  
14 certification of the international application, the Commis-  
15 sioner shall transmit the international application to the  
16 International Bureau.

17 **“SEC. 63. RESTRICTION, ABANDONMENT, CANCELLATION,**  
18 **OR EXPIRATION OF A BASIC APPLICATION OR**  
19 **BASIC REGISTRATION.**

20 “With respect to an international application trans-  
21 mitted to the International Bureau under section 62, the  
22 Commissioner shall notify the International Bureau when-  
23 ever the basic application or basic registration which is  
24 the basis for the international application has been re-  
25 stricted, abandoned, or canceled, or has expired, with re-

1 spect to some or all of the goods and services listed in  
2 the international registration—

3 “(1) within 5 years after the international reg-  
4 istration date; or

5 “(2) more than 5 years after the international  
6 registration date if the restriction, abandonment, or  
7 cancellation of the basic application or basic reg-  
8 istration resulted from an action that began before  
9 the end of that 5-year period.

10 **“SEC. 64. REQUEST FOR EXTENSION OF PROTECTION SUB-**  
11 **SEQUENT TO INTERNATIONAL REGISTRA-**  
12 **TION.**

13 “The holder of an international registration that is  
14 based upon a basic application filed with the Patent and  
15 Trademark Office or a basic registration granted by the  
16 Patent and Trademark Office may request an extension  
17 of protection of its international registration by filing such  
18 a request—

19 “(1) directly with the International Bureau, or

20 “(2) with the Patent and Trademark Office for  
21 transmittal to the International Bureau, if the re-  
22 quest is in such form, and contains such transmittal  
23 fee, as may be prescribed by the Commissioner.



1 **“SEC. 65. EXTENSION OF PROTECTION OF AN INTER-**  
2 **NATIONAL REGISTRATION TO THE UNITED**  
3 **STATES UNDER THE MADRID PROTOCOL.**

4 “(a) IN GENERAL.—Subject to the provisions of sec-  
5 tion 68, the holder of an international registration shall  
6 be entitled to the benefits of extension of protection of that  
7 international registration to the United States to the ex-  
8 tent necessary to give effect to any provision of the Madrid  
9 Protocol.

10 “(b) IF UNITED STATES IS OFFICE OF ORIGIN.—An  
11 extension of protection resulting from an international  
12 registration of a mark shall not apply to the United States  
13 if the Patent and Trademark Office is the office of origin  
14 with respect to that mark.

15 **“SEC. 66. EFFECT OF FILING A REQUEST FOR EXTENSION**  
16 **OF PROTECTION OF AN INTERNATIONAL**  
17 **REGISTRATION TO THE UNITED STATES.**

18 “(a) REQUIREMENT FOR REQUEST FOR EXTENSION  
19 OF PROTECTION.—A request for extension of protection  
20 of an international registration to the United States that  
21 the International Bureau transmits to the Patent and  
22 Trademark Office shall be deemed to be properly filed in  
23 the United States if such request, when received by the  
24 International Bureau, has attached to it a declaration of  
25 bona fide intention to use the mark in commerce that is

1 verified by the applicant for, or holder of, the international  
2 registration.

3 “(b) EFFECT OF PROPER FILING.—Unless extension  
4 of protection is refused under section 68, the proper filing  
5 of the request for extension of protection under subsection  
6 (a) shall constitute constructive use of the mark, confer-  
7 ring the same rights as those specified in section 7(c), as  
8 of the earliest of the following:

9 “(1) The international registration date, if the  
10 request for extension of protection was filed in the  
11 international application.

12 “(2) The date of recordal of the request for ex-  
13 tension of protection, if the request for extension of  
14 protection was made after the international registra-  
15 tion date.

16 “(3) The date of priority claimed pursuant to  
17 section 67.

18 **“SEC. 67. RIGHT OF PRIORITY FOR REQUEST FOR EXTEN-**  
19 **SION OF PROTECTION TO THE UNITED**  
20 **STATES.**

21 “The holder of an international registration with an  
22 extension of protection to the United States shall be enti-  
23 tled to claim a date of priority based on the right of prior-  
24 ity within the meaning of Article 4 of the Paris Convention  
25 for the Protection of Industrial Property if—

1           “(1) the international registration contained a  
2 claim of such priority; and

3           “(2)(A) the international application contained  
4 a request for extension of protection to the United  
5 States, or

6           “(B) the date of recordal of the request for ex-  
7 tension of protection to the United States is not  
8 later than 6 months after the date of the first regu-  
9 lar national filing (within the meaning of Article  
10 4(A)(3) of the Paris Convention for the Protection  
11 of Industrial Property) or a subsequent application  
12 (within the meaning of Article 4(C)(4) of the Paris  
13 Convention).

14 **“SEC. 68. EXAMINATION OF AND OPPOSITION TO REQUEST**  
15 **FOR EXTENSION OF PROTECTION; NOTIFICA-**  
16 **TION OF REFUSAL.**

17           “(a) EXAMINATION AND OPPOSITION.—(1) A request  
18 for extension of protection described in section 66(a) shall  
19 be examined as an application for registration on the Prin-  
20 cipal Register under this Act, and if on such examination  
21 it appears that the applicant is entitled to extension of  
22 protection under this title, the Commissioner shall cause  
23 the mark to be published in the Official Gazette of the  
24 Patent and Trademark Office.

1       “(2) Subject to the provisions of subsection (c), a re-  
2       quest for extension of protection under this title shall be  
3       subject to opposition under section 13. Unless successfully  
4       opposed, the request for extension of protection shall not  
5       be refused.

6       “(3) Extension of protection shall not be refused  
7       under this section on the ground that the mark has not  
8       been used in commerce.

9       “(4) Extension of protection shall be refused under  
10      this section to any mark not registrable on the Principal  
11      Register.

12      “(b) NOTIFICATION OF REFUSAL.—If, a request for  
13      extension of protection is refused under subsection (a), the  
14      Commissioner shall declare in a notification of refusal (as  
15      provided in subsection (c)) that the extension of protection  
16      cannot be granted, together with a statement of all  
17      grounds on which the refusal was based.

18      “(c) NOTICE TO INTERNATIONAL BUREAU.—(1)  
19      Within 18 months after the date on which the Inter-  
20      national Bureau transmits to the Patent and Trademark  
21      Office a notification of a request for extension of protec-  
22      tion, the Commissioner shall transmit to the International  
23      Bureau any of the following that applies to such request:

24              “(A) A notification of refusal based on an ex-  
25              amination of the request for extension of protection.

1           “(B) A notification of refusal based on the fil-  
2           ing of an opposition to the request.

3           “(C) A notification of the possibility that an op-  
4           position to the request may be filed after the end of  
5           that 18-month period.

6           “(2) If the Commissioner has sent a notification of  
7           the possibility of opposition under paragraph (1)(C), the  
8           Commissioner shall, if applicable, transmit to the Inter-  
9           national Bureau a notification of refusal on the basis of  
10          the opposition, together with a statement of all the  
11          grounds for the opposition, within 7 months after the be-  
12          ginning of the opposition period or within 1 month after  
13          the end of the opposition period, whichever is earlier.

14          “(3) If a notification of refusal of a request for exten-  
15          sion of protection is transmitted under paragraph (1) or  
16          (2), no grounds for refusal of such request other than  
17          those set forth in such notification may be transmitted to  
18          the International Bureau by the Commissioner after the  
19          expiration of the time periods set forth in paragraph (1)  
20          or (2), as the case may be.

21          “(4) If a notification specified in paragraph (1) or  
22          (2) is not sent to the International Bureau within the time  
23          period set forth in such paragraph, with respect to a re-  
24          quest for extension of protection, the request for extension  
25          of protection shall not be refused and the Commissioner

1 shall issue a certificate of extension of protection pursuant  
2 to the request.

3       “(d) DESIGNATION OF AGENT FOR SERVICE OF  
4 PROCESS.—In responding to a notification of refusal with  
5 respect to a mark, the holder of the international registra-  
6 tion of the mark shall designate, by a written document  
7 filed in the Patent and Trademark Office, the name and  
8 address of a person resident in the United States on whom  
9 may be served notices or process in proceedings affecting  
10 the mark. Such notices or process may be served upon  
11 the person so designated by leaving with that person, or  
12 mailing to that person, a copy thereof at the address speci-  
13 fied in the last designation so filed. If the person so des-  
14 igned cannot be found at the address given in the last  
15 designation, such notice or process may be served upon  
16 the Commissioner.

17 **“SEC. 69. EFFECT OF EXTENSION OF PROTECTION.**

18       “(a) ISSUANCE OF EXTENSION OF PROTECTION.—  
19 Unless a request for extension of protection is refused  
20 under section 68, the Commissioner shall issue a certifi-  
21 cate of extension of protection pursuant to the request and  
22 shall cause notice of such certificate of extension of protec-  
23 tion to be published in the Official Gazette of the Patent  
24 and Trademark Office.

1       “(b) EFFECT OF EXTENSION OF PROTECTION.—  
2 From the date on which a certificate of extension of pro-  
3 tection is issued under subsection (a)—

4               “(1) such extension of protection shall have the  
5 same effect and validity as a registration on the  
6 Principal Register, and

7               “(2) the holder of the international registration  
8 shall have the same rights and remedies as the  
9 owner of a registration on the Principal Register.

10 **“SEC. 70. DEPENDENCE OF EXTENSION OF PROTECTION TO**  
11 **THE UNITED STATES ON THE UNDERLYING**  
12 **INTERNATIONAL REGISTRATION.**

13       “(a) EFFECT OF CANCELLATION OF INTERNATIONAL  
14 REGISTRATION.—If the International Bureau notifies the  
15 Patent and Trademark Office of the cancellation of an  
16 international registration with respect to some or all of  
17 the goods and services listed in the international registra-  
18 tion, the Commissioner shall cancel any extension of pro-  
19 tection to the United States with respect to such goods  
20 and services as of the date on which the international reg-  
21 istration was canceled.

22       “(b) EFFECT OF FAILURE TO RENEW INTER-  
23 NATIONAL REGISTRATION.—If the International Bureau  
24 does not renew an international registration, the cor-  
25 responding extension of protection to the United States

1 shall cease to be valid as of the date of the expiration of  
2 the international registration.

3       “(c) TRANSFORMATION OF AN EXTENSION OF PRO-  
4 TECTION INTO A UNITED STATES APPLICATION.—The  
5 holder of an international registration canceled in whole  
6 or in part by the International Bureau at the request of  
7 the office of origin, under Article 6(4) of the Madrid Pro-  
8 tocol, may file an application, under section 1 or 44 of  
9 this Act, for the registration of the same mark for any  
10 of the goods and services to which the cancellation applies  
11 that were covered by an extension of protection to the  
12 United States based on that international registration.  
13 Such an application shall be treated as if it had been filed  
14 on the international registration date or the date of  
15 recordal of the request for extension of protection with the  
16 International Bureau, whichever date applies, and, if the  
17 extension of protection enjoyed priority under section 67  
18 of this title, shall enjoy the same priority. Such an applica-  
19 tion shall be entitled to the benefits conferred by this sub-  
20 section only if the application is filed not later than 3  
21 months after the date on which the international registra-  
22 tion was canceled, in whole or in part, and only if the ap-  
23 plication complies with all the requirements of this Act  
24 which apply to any application filed pursuant to section  
25 1 or 44.



1 **“SEC. 71. AFFIDAVITS AND FEES.**

2       “(a) REQUIRED AFFIDAVITS AND FEES.—An exten-  
3 sion of protection for which a certificate of extension of  
4 protection has been issued under section 69 shall remain  
5 in force for the term of the international registration upon  
6 which it is based, except that the extension of protection  
7 of any mark shall be canceled by the Commissioner—

8               “(1) at the end of the 6-year period beginning  
9       on the date on which the certificate of extension of  
10       protection was issued by the Commissioner, unless  
11       within the 1-year period preceding the expiration of  
12       that 6-year period the holder of the international  
13       registration files in the Patent and Trademark Of-  
14       fice an affidavit under subsection (b) together with  
15       a fee prescribed by the Commissioner; and

16               “(2) at the end of the 10-year period beginning  
17       on the date on which the certificate of extension of  
18       protection was issued by the Commissioner, and at  
19       the end of each 10-year period thereafter, unless—

20                       “(A) within the 6-month period preceding  
21       the expiration of such 10-year period the holder  
22       of the international registration files in the Pat-  
23       ent and Trademark Office an affidavit under  
24       subsection (b) together with a fee prescribed by  
25       the Commissioner; or

1           “(B) within 3 months after the expiration  
2           of such 10-year period, the holder of the inter-  
3           national registration files in the Patent and  
4           Trademark Office an affidavit under subsection  
5           (b) together with the fee described in subpara-  
6           graph (A) and an additional fee prescribed by  
7           the Commissioner.

8           “(b) CONTENTS OF AFFIDAVIT.—The affidavit re-  
9           ferred to in subsection (a) shall set forth those goods or  
10          services recited in the extension of protection on or in con-  
11          nection with which the mark is in use in commerce and  
12          the holder of the international registration shall attach to  
13          the affidavit a specimen or facsimile showing the current  
14          use of the mark in commerce, or shall set forth that any  
15          nonuse is due to special circumstances which excuse such  
16          nonuse and is not due to any intention to abandon the  
17          mark. Special notice of the requirement for such affidavit  
18          shall be attached to each certificate of extension of protec-  
19          tion.

20          **“SEC. 72. ASSIGNMENT OF AN EXTENSION OF PROTECTION.**

21          “An extension of protection may be assigned, to-  
22          gether with the goodwill associated with the mark, only  
23          to a person who is a national of, is domiciled in, or has  
24          a bona fide and effective industrial or commercial estab-  
25          lishment either in a country that is a Contracting Party

1 or in a country that is a member of an intergovernmental  
2 organization that is a Contracting Party.

3 **“SEC. 73. INCONTESTABILITY.**

4 “The period of continuous use prescribed under sec-  
5 tion 15 for a mark covered by an extension of protection  
6 issued under this title may begin no earlier than the date  
7 on which the Commissioner issues the certificate of the  
8 extension of protection by under section 69.”.

9 **SEC. 4. EFFECTIVE DATE.**

10 This Act shall take effect on the date on which the  
11 Madrid Protocol enters into force with respect to the Unit-  
12 ed States.

○

S 977 IS—2