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.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE.

This Act may be cited as the “Madrid Protocol Implementation Act”.
SEC. 3. PROVISIONS TO IMPLEMENT THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS.

The Act entitled "An Act to provide for the registration and protection of trade-marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes", approved July 5, 1946, as amended (15 U.S.C. 1051 and following) (commonly referred to as the "Trademark Act of 1946") is amended by adding after section 51 the following new title:

"TITLE XII—THE MADRID PROTOCOL

"SEC. 60. DEFINITIONS.

"For purposes of this title:

"'(1) MADRID PROTOCOL.—The term ‘Madrid Protocol’ means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid, Spain, on June 27, 1989.

"'(2) BASIC APPLICATION.—The term ‘basic application’ means the application for the registration of a mark that has been filed with an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.
“(3) **Basic registration.**—The term ‘basic registration’ means the registration of a mark that has been granted by an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

“(4) **Contracting Party.**—The term ‘Contracting Party’ means any country or inter-governmental organization that is a party to the Madrid Protocol.

“(5) **Date of recordal.**—The term ‘date of recordal’ means the date on which a request for extension of protection that is filed after an international registration is granted is recorded on the International Register.

“(6) **Declaration of bona fide intention to use the mark in commerce.**—The term ‘declaration of bona fide intention to use the mark in commerce’ means a declaration that is signed by the applicant for, or holder of, an international registration who is seeking extension of protection of a mark to the United States and that contains a statement that—

“(A) the applicant or holder has a bona fide intention to use the mark in commerce,
“(B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce, and

“(C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, or to cause mistake, or to deceive.

“(7) EXTENSION OF PROTECTION.—The term ‘extension of protection’ means the protection resulting from an international registration that extends to a Contracting Party at the request of the holder of the international registration, in accordance with the Madrid Protocol.

“(8) HOLDER OF AN INTERNATIONAL REGISTRATION.—A ‘holder’ of an international registration is the natural or juristic person in whose name the international registration is recorded on the International Register.
“(9) INTERNATIONAL APPLICATION.—The term ‘international application’ means an application for international registration that is filed under the Madrid Protocol.


“(11) INTERNATIONAL REGISTER.—The term ‘International Register’ means the official collection of such data concerning international registrations maintained by the International Bureau that the Madrid Protocol or its implementing regulations require or permit to be recorded, regardless of the medium which contains such data.

“(12) INTERNATIONAL REGISTRATION.—The term ‘international registration’ means the registration of a mark granted under the Madrid Protocol.

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

“(14) NOTIFICATION OF REFUSAL.—The term ‘notification of refusal’ means the notice sent by an Office of a Contracting Party to the International
Bureau declaring that an extension of protection cannot be granted.

“(15) Office of a Contracting Party.—The term ‘Office of a Contracting Party’ means—

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

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

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

“(17) Opposition period.—The term ‘opposition period’ means the time allowed for filing an opposition in the Patent and Trademark Office, including any extension of time granted under section 13.

SEC. 61. INTERNATIONAL APPLICATIONS BASED ON UNITED STATES APPLICATIONS OR REGISTRATIONS.

“The owner of a basic application pending before the Patent and Trademark Office, or the owner of a basic registration granted by the Patent and Trademark Office,
may file an international application by submitting to the Patent and Trademark Office a written application in such form, together with such fees, as may be prescribed by the Commissioner.

"SEC. 62. CERTIFICATION OF THE INTERNATIONAL APPLICATION.

"Upon the filing of an application for international registration and payment of the prescribed fees, the Commissioner shall examine the international application for the purpose of certifying that the information contained in the international application corresponds to the information contained in the basic application or basic registration at the time of the certification. Upon examination and certification of the international application, the Commissioner shall transmit the international application to the International Bureau.

"SEC. 63. RESTRICTION, ABANDONMENT, CANCELLATION, OR EXPIRATION OF A BASIC APPLICATION OR BASIC REGISTRATION.

"With respect to an international application transmitted to the International Bureau under section 62, the Commissioner shall notify the International Bureau whenever the basic application or basic registration which is the basis for the international application has been restricted, abandoned, or canceled, or has expired, with re-
spect to some or all of the goods and services listed in the international registration—

“(1) within 5 years after the international registration date; or

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

“SEC. 64. REQUEST FOR EXTENSION OF PROTECTION SUBSEQUENT TO INTERNATIONAL REGISTRATION.

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

“(1) directly with the International Bureau, or

“(2) with the Patent and Trademark Office for transmittal to the International Bureau, if the request is in such form, and contains such transmittal fee, as may be prescribed by the Commissioner.
"SEC. 65. EXTENSION OF PROTECTION OF AN INTERNATIONAL REGISTRATION TO THE UNITED STATES UNDER THE MADRID PROTOCOL.

“(a) In General.—Subject to the provisions of section 68, the holder of an international registration shall be entitled to the benefits of extension of protection of that international registration to the United States to the extent necessary to give effect to any provision of the Madrid Protocol.

“(b) If United States is Office of Origin.—An extension of protection resulting from an international registration of a mark shall not apply to the United States if the Patent and Trademark Office is the office of origin with respect to that mark.

"SEC. 66. EFFECT OF FILING A REQUEST FOR EXTENSION OF PROTECTION OF AN INTERNATIONAL REGISTRATION TO THE UNITED STATES.

“(a) Requirement for Request for Extension of Protection.—A request for extension of protection of an international registration to the United States that the International Bureau transmits to the Patent and Trademark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, has attached to it a declaration of bona fide intention to use the mark in commerce that is
verified by the applicant for, or holder of, the international registration.

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

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

(2) The date of recordal of the request for extension of protection, if the request for extension of protection was made after the international registration date.

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

SEC. 67. RIGHT OF PRIORITY FOR REQUEST FOR EXTENSION OF PROTECTION TO THE UNITED STATES.

The holder of an international registration with an extension of protection to the United States shall be entitled to claim a date of priority based on the right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if—
“(1) the international registration contained a claim of such priority; and
“(2)(A) the international application contained a request for extension of protection to the United States, or
“(B) the date of recordal of the request for extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention).

“SEC. 68. EXAMINATION OF AND OPPOSITION TO REQUEST FOR EXTENSION OF PROTECTION; NOTIFICATION OF REFUSAL.

“(a) EXAMINATION AND OPPOSITION.—(1) A request for extension of protection described in section 66(a) shall be examined as an application for registration on the Principal Register under this Act, and if on such examination it appears that the applicant is entitled to extension of protection under this title, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office.
“(2) Subject to the provisions of subsection (c), a request for extension of protection under this title shall be subject to opposition under section 13. Unless successfully opposed, the request for extension of protection shall not be refused.

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

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

“(b) Notification of Refusal.—If, a request for extension of protection is refused under subsection (a), the Commissioner shall declare in a notification of refusal (as provided in subsection (c)) that the extension of protection cannot be granted, together with a statement of all grounds on which the refusal was based.

“(c) Notice to International Bureau.—(1) Within 18 months after the date on which the International Bureau transmits to the Patent and Trademark Office a notification of a request for extension of protection, the Commissioner shall transmit to the International Bureau any of the following that applies to such request:

“(A) A notification of refusal based on an examination of the request for extension of protection.
“(B) A notification of refusal based on the filing of an opposition to the request.

“(C) A notification of the possibility that an opposition to the request may be filed after the end of that 18-month period.

“(2) If the Commissioner has sent a notification of the possibility of opposition under paragraph (1)(C), the Commissioner shall, if applicable, transmit to the International Bureau a notification of refusal on the basis of the opposition, together with a statement of all the grounds for the opposition, within 7 months after the beginning of the opposition period or within 1 month after the end of the opposition period, whichever is earlier.

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

“(4) If a notification specified in paragraph (1) or (2) is not sent to the International Bureau within the time period set forth in such paragraph, with respect to a request for extension of protection, the request for extension of protection shall not be refused and the Commissioner
shall issue a certificate of extension of protection pursuant
to the request.

“(d) Designation of Agent for Service of Process.—In responding to a notification of refusal with
respect to a mark, the holder of the international registra-
tion of the mark shall designate, by a written document
filed in the Patent and Trademark Office, the name and
address of a person resident in the United States on whom
may be served notices or process in proceedings affecting
the mark. Such notices or process may be served upon
the person so designated by leaving with that person, or
mailing to that person, a copy thereof at the address speci-
fied in the last designation so filed. If the person so des-
ignated cannot be found at the address given in the last
designation, such notice or process may be served upon
the Commissioner.

“Sec. 69. Effect of Extension of Protection.

“(a) Issuance of Extension of Protection.—Un
less a request for extension of protection is refused
under section 68, the Commissioner shall issue a certifi-
cate of extension of protection pursuant to the request and
shall cause notice of such certificate of extension of protec-
tion to be published in the Official Gazette of the Patent
and Trademark Office.
“(b) Effect of Extension of Protection.—From the date on which a certificate of extension of protection is issued under subsection (a)—

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

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

“SEC. 70. Dependence of Extension of Protection to the United States on the Underlying International Registration.

“(a) Effect of Cancellation of International Registration.—If the International Bureau notifies the Patent and Trademark Office of the cancellation of an international registration with respect to some or all of the goods and services listed in the international registration, the Commissioner shall cancel any extension of protection to the United States with respect to such goods and services as of the date on which the international registration was canceled.

“(b) Effect of Failure to Renew International Registration.—If the International Bureau does not renew an international registration, the corresponding extension of protection to the United States
shall cease to be valid as of the date of the expiration of
the international registration.

(c) TRANSFORMATION OF AN EXTENSION OF PRO-
TECTION INTO A UNITED STATES APPLICATION.—The
holder of an international registration canceled in whole
or in part by the International Bureau at the request of
the office of origin, under Article 6(4) of the Madrid Pro-
tocol, may file an application, under section 1 or 44 of
this Act, for the registration of the same mark for any
of the goods and services to which the cancellation applies
that were covered by an extension of protection to the
United States based on that international registration.
Such an application shall be treated as if it had been filed
on the international registration date or the date of
recordal of the request for extension of protection with the
International Bureau, whichever date applies, and, if the
extension of protection enjoyed priority under section 67
of this title, shall enjoy the same priority. Such an applica-
tion shall be entitled to the benefits conferred by this sub-
section only if the application is filed not later than 3
months after the date on which the international registra-
tion was canceled, in whole or in part, and only if the ap-
plication complies with all the requirements of this Act
which apply to any application filed pursuant to section
1 or 44.
“SEC. 71. AFFIDAVITS AND FEES.

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

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

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

“(A) within the 6-month period preceding the expiration of such 10-year period the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) together with a fee prescribed by the Commissioner; or
“(B) within 3 months after the expiration of such 10-year period, the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) together with the fee described in subparagraph (A) and an additional fee prescribed by the Commissioner.

“(b) CONTENTS OF AFFIDAVIT.—The affidavit referred to in subsection (a) shall set forth those goods or services recited in the extension of protection on or in connection with which the mark is in use in commerce and the holder of the international registration shall attach to the affidavit a specimen or facsimile showing the current use of the mark in commerce, or shall set forth that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. Special notice of the requirement for such affidavit shall be attached to each certificate of extension of protection.

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

“An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party
or in a country that is a member of an intergovernmental organization that is a Contracting Party.

"SEC. 73. INCONTESTABILITY.

"The period of continuous use prescribed under section 15 for a mark covered by an extension of protection issued under this title may begin no earlier than the date on which the Commissioner issues the certificate of the extension of protection by under section 69.".

SEC. 4. EFFECTIVE DATE.

This Act shall take effect on the date on which the Madrid Protocol enters into force with respect to the United States.