

107<sup>TH</sup> CONGRESS  
1<sup>ST</sup> SESSION

# S. 407

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

FEBRUARY 27, 2001

Mr. LEAHY (for himself and Mr. HATCH) 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. 2. 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 trademarks 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           lieves 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**  
21 **UNITED STATES APPLICATIONS OR REG-**  
22 **ISTRATIONS.**

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



1 **“SEC. 63. RESTRICTION, ABANDONMENT, CANCELLATION,**  
2 **OR EXPIRATION OF A BASIC APPLICATION OR**  
3 **BASIC REGISTRATION.**

4 “With respect to an international application trans-  
5 mitted to the International Bureau under section 62, the  
6 Director shall notify the International Bureau whenever  
7 the basic application or basic registration which is the  
8 basis for the international application has been restricted,  
9 abandoned, or canceled, or has expired, with respect to  
10 some or all of the goods and services listed in the inter-  
11 national registration—

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

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

19 **“SEC. 64. REQUEST FOR EXTENSION OF PROTECTION SUB-**  
20 **SEQUENT TO INTERNATIONAL REGISTRA-**  
21 **TION.**

22 “The holder of an international registration that is  
23 based upon a basic application filed with the Patent and  
24 Trademark Office or a basic registration granted by the  
25 Patent and Trademark Office may request an extension

1 of protection of its international registration by filing such  
2 a request—

3 “(1) directly with the International Bureau; or

4 “(2) with the Patent and Trademark Office for  
5 transmittal to the International Bureau, if the re-  
6 quest is in such form, and contains such transmittal  
7 fee, as may be prescribed by the Director.

8 **“SEC. 65. EXTENSION OF PROTECTION OF AN INTER-**  
9 **NATIONAL REGISTRATION TO THE UNITED**  
10 **STATES UNDER THE MADRID PROTOCOL.**

11 “(a) IN GENERAL.—Subject to the provisions of sec-  
12 tion 68, the holder of an international registration shall  
13 be entitled to the benefits of extension of protection of that  
14 international registration to the United States to the ex-  
15 tent necessary to give effect to any provision of the Madrid  
16 Protocol.

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

1 **“SEC. 66. EFFECT OF FILING A REQUEST FOR EXTENSION**  
2 **OF PROTECTION OF AN INTERNATIONAL**  
3 **REGISTRATION TO THE UNITED STATES.**

4 “(a) **REQUIREMENT FOR REQUEST FOR EXTENSION**  
5 **OF PROTECTION.**—A request for extension of protection  
6 of an international registration to the United States that  
7 the International Bureau transmits to the Patent and  
8 Trademark Office shall be deemed to be properly filed in  
9 the United States if such request, when received by the  
10 International Bureau, has attached to it a declaration of  
11 bona fide intention to use the mark in commerce that is  
12 verified by the applicant for, or holder of, the international  
13 registration.

14 “(b) **EFFECT OF PROPER FILING.**—Unless extension  
15 of protection is refused under section 68, the proper filing  
16 of the request for extension of protection under subsection  
17 (a) shall constitute constructive use of the mark, confer-  
18 ring the same rights as those specified in section 7(c), as  
19 of the earliest of the following:

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

23 “(2) The date of recordal of the request for ex-  
24 tension of protection, if the request for extension of  
25 protection was made after the international registra-  
26 tion date.

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

3   **“SEC. 67. RIGHT OF PRIORITY FOR REQUEST FOR EXTEN-**  
4                   **SION OF PROTECTION TO THE UNITED**  
5                   **STATES.**

6           “The holder of an international registration with an  
7   extension of protection to the United States shall be enti-  
8   tled to claim a date of priority based on the right of pri-  
9   ority within the meaning of article 4 of the Paris Conven-  
10   tion for the Protection of Industrial Property if—

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

13           “(2)(A) the international application contained  
14   a request for extension of protection to the United  
15   States; or

16           “(B) the date of recordal of the request for ex-  
17   tension of protection to the United States is not  
18   later than 6 months after the date of the first reg-  
19   ular national filing (within the meaning of article  
20   4(A)(3) of the Paris Convention for the Protection  
21   of Industrial Property) or a subsequent application  
22   (within the meaning of article 4(C)(4) of the Paris  
23   Convention).

1 **“SEC. 68. EXAMINATION OF AND OPPOSITION TO REQUEST**  
2 **FOR EXTENSION OF PROTECTION; NOTIFICA-**  
3 **TION OF REFUSAL.**

4 “(a) EXAMINATION AND OPPOSITION.—(1) A request  
5 for extension of protection described in section 66(a) shall  
6 be examined as an application for registration on the Prin-  
7 cipal Register under this Act, and if on such examination  
8 it appears that the applicant is entitled to extension of  
9 protection under this title, the Director shall cause the  
10 mark to be published in the Official Gazette of the Patent  
11 and Trademark Office.

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

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

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

23 “(b) NOTIFICATION OF REFUSAL.—If, a request for  
24 extension of protection is refused under subsection (a), the  
25 Director shall declare in a notification of refusal (as pro-  
26 vided in subsection (c)) that the extension of protection

1 cannot be granted, together with a statement of all  
2 grounds on which the refusal was based.

3 “(c) NOTICE TO INTERNATIONAL BUREAU.—(1)  
4 Within 18 months after the date on which the Inter-  
5 national Bureau transmits to the Patent and Trademark  
6 Office a notification of a request for extension of protec-  
7 tion, the Director shall transmit to the International Bu-  
8 reau any of the following that applies to such request:

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

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

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

16 “(2) If the Director has sent a notification of the pos-  
17 sibility of opposition under paragraph (1)(C), the Director  
18 shall, if applicable, transmit to the International Bureau  
19 a notification of refusal on the basis of the opposition, to-  
20 gether with a statement of all the grounds for the opposi-  
21 tion, within 7 months after the beginning of the opposition  
22 period or within 1 month after the end of the opposition  
23 period, whichever is earlier.

24 “(3) If a notification of refusal of a request for exten-  
25 sion of protection is transmitted under paragraph (1) or

1 (2), no grounds for refusal of such request other than  
2 those set forth in such notification may be transmitted to  
3 the International Bureau by the Director after the expira-  
4 tion of the time periods set forth in paragraph (1) or (2),  
5 as the case may be.

6 “(4) If a notification specified in paragraph (1) or  
7 (2) is not sent to the International Bureau within the time  
8 period set forth in such paragraph, with respect to a re-  
9 quest for extension of protection, the request for extension  
10 of protection shall not be refused and the Director shall  
11 issue a certificate of extension of protection pursuant to  
12 the request.

13 “(d) DESIGNATION OF AGENT FOR SERVICE OF  
14 PROCESS.—In responding to a notification of refusal with  
15 respect to a mark, the holder of the international registra-  
16 tion of the mark shall designate, by a written document  
17 filed in the Patent and Trademark Office, the name and  
18 address of a person resident in the United States on whom  
19 may be served notices or process in proceedings affecting  
20 the mark. Such notices or process may be served upon  
21 the person so designated by leaving with that person, or  
22 mailing to that person, a copy thereof at the address speci-  
23 fied in the last designation so filed. If the person so des-  
24 ignated cannot be found at the address given in the last

1 designation, such notice or process may be served upon  
2 the Director.

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

4 “(a) ISSUANCE OF EXTENSION OF PROTECTION.—

5 Unless a request for extension of protection is refused  
6 under section 68, the Director shall issue a certificate of  
7 extension of protection pursuant to the request and shall  
8 cause notice of such certificate of extension of protection  
9 to be published in the Official Gazette of the Patent and  
10 Trademark Office.

11 “(b) EFFECT OF EXTENSION OF PROTECTION.—

12 From the date on which a certificate of extension of pro-  
13 tection is issued under subsection (a)—

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

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

20 **“SEC. 70. DEPENDENCE OF EXTENSION OF PROTECTION TO**

21 **THE UNITED STATES ON THE UNDERLYING**

22 **INTERNATIONAL REGISTRATION.**

23 “(a) EFFECT OF CANCELLATION OF INTERNATIONAL

24 REGISTRATION.—If the International Bureau notifies the

25 Patent and Trademark Office of the cancellation of an

1 international registration with respect to some or all of  
2 the goods and services listed in the international registra-  
3 tion, the Director shall cancel any extension of protection  
4 to the United States with respect to such goods and serv-  
5 ices as of the date on which the international registration  
6 was canceled.

7       “(b) EFFECT OF FAILURE TO RENEW INTER-  
8 NATIONAL REGISTRATION.—If the International Bureau  
9 does not renew an international registration, the cor-  
10 responding extension of protection to the United States  
11 shall cease to be valid as of the date of the expiration of  
12 the international registration.

13       “(c) TRANSFORMATION OF AN EXTENSION OF PRO-  
14 TECTION INTO A UNITED STATES APPLICATION.—The  
15 holder of an international registration canceled in whole  
16 or in part by the International Bureau at the request of  
17 the office of origin, under article 6(4) of the Madrid Pro-  
18 tocol, may file an application, under section 1 or 44 of  
19 this Act, for the registration of the same mark for any  
20 of the goods and services to which the cancellation applies  
21 that were covered by an extension of protection to the  
22 United States based on that international registration.  
23 Such an application shall be treated as if it had been filed  
24 on the international registration date or the date of  
25 recordal of the request for extension of protection with the

1 International Bureau, whichever date applies, and, if the  
2 extension of protection enjoyed priority under section 67  
3 of this title, shall enjoy the same priority. Such an applica-  
4 tion shall be entitled to the benefits conferred by this sub-  
5 section only if the application is filed not later than 3  
6 months after the date on which the international registra-  
7 tion was canceled, in whole or in part, and only if the ap-  
8 plication complies with all the requirements of this Act  
9 which apply to any application filed pursuant to section  
10 1 or 44.

11 **“SEC. 71. AFFIDAVITS AND FEES.**

12       “(a) REQUIRED AFFIDAVITS AND FEES.—An exten-  
13 sion of protection for which a certificate of extension of  
14 protection has been issued under section 69 shall remain  
15 in force for the term of the international registration upon  
16 which it is based, except that the extension of protection  
17 of any mark shall be canceled by the Director—

18               “(1) at the end of the 6-year period beginning  
19 on the date on which the certificate of extension of  
20 protection was issued by the Director, unless within  
21 the 1-year period preceding the expiration of that 6-  
22 year period the holder of the international registra-  
23 tion files in the Patent and Trademark Office an af-  
24 fidavit under subsection (b) together with a fee pre-  
25 scribed by the Director; and

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

5                   “(A) within the 6-month period preceding  
6                   the expiration of such 10-year period the holder  
7                   of the international registration files in the Pat-  
8                   ent and Trademark Office an affidavit under  
9                   subsection (b) together with a fee prescribed by  
10                  the Director; or

11                   “(B) within 3 months after the expiration  
12                   of such 10-year period, the holder of the inter-  
13                   national registration files in the Patent and  
14                   Trademark Office an affidavit under subsection  
15                   (b) together with the fee described in subpara-  
16                   graph (A) and an additional fee prescribed by  
17                  the Director.

18           “(b) CONTENTS OF AFFIDAVIT.—The affidavit re-  
19           ferred to in subsection (a) shall set forth those goods or  
20           services recited in the extension of protection on or in con-  
21           nection with which the mark is in use in commerce and  
22           the holder of the international registration shall attach to  
23           the affidavit a specimen or facsimile showing the current  
24           use of the mark in commerce, or shall set forth that any  
25           nonuse is due to special circumstances which excuse such

1 nonuse and is not due to any intention to abandon the  
2 mark. Special notice of the requirement for such affidavit  
3 shall be attached to each certificate of extension of protec-  
4 tion.

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

6 “An extension of protection may be assigned, to-  
7 gether with the goodwill associated with the mark, only  
8 to a person who is a national of, is domiciled in, or has  
9 a bona fide and effective industrial or commercial estab-  
10 lishment either in a country that is a Contracting Party  
11 or in a country that is a member of an intergovernmental  
12 organization that is a Contracting Party.

13 **“SEC. 73. INCONTESTABILITY.**

14 “The period of continuous use prescribed under sec-  
15 tion 15 for a mark covered by an extension of protection  
16 issued under this title may begin no earlier than the date  
17 on which the Director issues the certificate of the exten-  
18 sion of protection under section 69, except as provided in  
19 section 74.

20 **“SEC. 74. RIGHTS OF EXTENSION OF PROTECTION.**

21 “An extension of protection shall convey the same  
22 rights as an existing registration for the same mark, if—

23 “(1) the extension of protection and the exist-  
24 ing registration are owned by the same person;

1           “(2) the goods and services listed in the exist-  
2           ing registration are also listed in the extension of  
3           protection; and

4           “(3) the certificate of extension of protection is  
5           issued after the date of the existing registration.”.

6 **SEC. 3. EFFECTIVE DATE.**

7           This Act and the amendments made by this Act shall  
8           take effect on the date on which the Madrid Protocol (as  
9           defined in section 60(1) of the Trademark Act of 1946)  
10          enters into force with respect to the United States.

○