shall be printed to furnish one copy to each Member of Congress; the Secretary and the Sergeant at Arms of the Senate; the Clerk, Sergeant at Arms, and Chief Administrative Officer of the House of Representatives; two copies to the libraries of the Senate and House, and the Congressional Library; seven hundred copies to the Joint Economic Committee; and the required number of copies to the Superintendent of Documents for distribution to depository libraries; and the Superintendent of Documents is authorized to have copies printed for sale to the public.


Editorial Notes

Codification

Section was not enacted as a part of the Employment Act of 1946 which comprises this chapter.

"Joint Economic Committee" substituted in text for "Joint Committee on the Economic Report" to conform to act June 16, 1956, ch. 399, §2, 70 Stat. 290. See section 1024(a) of this title.

Amendments

1966—Pub. L. 90–442 substituted "Chief Administrative Officer" for "Doorkeeper".


CHAPTER 22—TRADEMARKS

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§ 1051. Application for registration; verification

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.

(2) The application shall include specification of the applicant’s domicile and citizenship, the date of the applicant’s first use of the mark, the date of the applicant’s first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier’s knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier’s knowledge and belief, no other person has the right to use such mark in commerce 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 of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b) Application for bona fide intention to use trademark

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant’s domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant’s bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier’s knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier’s knowledge and belief, no other person has the right to use such mark in commerce 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 of such other person, to cause confusion, or to cause mistake, or to deceive.

(c) Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b), an applicant who has made use of the mark in commerce may
claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a).

(d) Verified statement that trademark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant’s first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Director shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Director shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Director shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) Designation of resident for service of process and notices

If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States 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 specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States 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 on the Director.

(f) Third-party submission of evidence

A third party may submit for consideration in the record of an application evidence relevant to a ground for refusal of registration. The third-party submission shall identify the ground for refusal and include a concise description of each piece of evidence submitted in support of each identified ground for refusal. Not later than 2 months after the date on which the submission is filed, the Director shall determine whether the evidence should be included in the record of the application. The Director shall establish by regulation appropriate procedures for the consideration of evidence submitted by a third party under this subsection and may prescribe a fee to accompany the submission. If the Director determines that the third-party evidence should be included in the record of the application, only the evidence and the ground for refusal to which the evidence relates may be so included. Any determination by the Director whether or not to include evidence in the record of an application shall be final and non-reviewable, and a determination to include or to not include evidence in the record shall not prejudice any party’s right to raise any issue and rely on any evidence in any other proceeding.

notices or process be served by leaving with such per-
ess in proceedings affecting the mark and provided that
sec. (e) generally. Prior to amendment, subsec. (e) re-
connection with which the mark is used in commerce.''
subsec. (d) and redesignated former subsec. (d) as (e).
and (c) as pars. (2) and (3), respectively, of subsec. (a).
''prescribed'' for ''filing''.
ally'' after ''the mark as'', and in par. (2), substituted
first use of the mark in commerce''.
''goods in connection'', in par. (1)(C), struck out ''actu-
manner in which the mark is used on or in connec-
tion with which the mark is used on or in connection
with such goods or services'' after ''notice of allowance
is used on or in connection with such goods or serv-
iafter ''use by others, the
ceive'' for ''as might be calculated to deceive'', and
struck out "or services" after "use by others, the
goods":

Statutory Notes and Related Subsidiaries

Effective Date of 2020 Amendment
Pub. L. 116–260, div. Q, title II, § 223(c), Dec. 27, 2020, 134 Stat. 2201, provided that: "The amendment made by subsection (a) [amending this section] shall take effect 1 year after the date of enactment of this Act [Dec. 27, 2020]."

Effective Date of 1999 Amendment
Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1998, see section 1006(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 1 of Title 33, Patents.

Effective Date of 1998 Amendment
Pub. L. 105–330, title I, §109(b), Oct. 30, 1998, 112 Stat. 3069, provided that: "This title [see Short Title of 1998 Amendment note below] and the amendments made by this title shall apply to any application for registration of a trademark pending on, or filed on or after, the effective date of this Act [probably should be "this title", see section 110 of Pub. L. 105–330, set out as an Effective Date of 1998 Amendment note below]."
"(1) on the date that is 1 year after the date of the enactment of this Act [Oct. 30, 1998], or
"(2) upon the entry into force of the Trademark Law Treaty with respect to the United States [Aug. 12, 2000], whichever occurs first."
Pub. L. 105–330, title II. §201(b), Oct. 30, 1998, 112 Stat. 3070, provided that: "The amendments made by this section [amending this section and sections 1052, 1057, 1064, 1091, 1094, 1113 to 1115, 1121, and 1124 of this title] shall take effect on the date of enactment of this Act [Oct. 30, 1998], and shall apply only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark."

Effective Date of 1988 Amendment
Pub. L. 100–667, title I, §136, Nov. 16, 1988, 102 Stat. 3948, provided that: "This title and the amendments made by this title [see Short Title of 1988 Amendment note below] shall become effective on the date which is one year after the date of enactment of this Act [Nov. 16, 1988]."

Effective Date of 1975 Amendment

Effective Date
Section 46(a) of act July 5, 1946, provided that this chapter shall be in force and take effect one year from July 5, 1946.

Short Title of 2020 Amendment
Pub. L. 116–260, div. Q, title II, §221(a), Dec. 27, 2020, 134 Stat. 2200, provided that: "This subtitle [subtitle B (§§221–223) of title II of div. Q of Pub. L. 116–260, enacting sections 1066a and 1066b of this title, amending this section and sections 1062, 1064, 1065, 1068, 1070, 1071, 1092, 1094, and 1116 of this title, and enacting provisions set out as notes under this section and sections 1066a, 1064, 1065, 1068, and 1116 of this title] may be cited as the 'Trade-
mordenization Act of 2020' or the 'TM Act of 2020'."

AMENDMENTS
2002—Subsec. (d)(1). Pub. L. 107–273, §13207(b)(1), in first sentence, substituted "specifying the date of the applicant’s first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce," for "specifying the date of the applicant’s first use of the mark in commerce and., those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce." Subsec. (e). Pub. L. 107–273, §13207(b)(2), amended subsec. (e) generally. Prior to amendment, subsec. (e) required applicant not domiciled in United States to designate name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark and provided that notices or process be served by leaving with such person or mailing to him a copy, or upon Director if designated person cannot be found. Pub. L. 106–113 substituted "Director" for "Commissioner" wherever appearing.
1998—Subsec. (a). Pub. L. 105–330, §109(a), amended subsec. (a) generally. Prior to amendment, subsec. (a) related to application by owner of a trademark used in commerce to register the trademark by filing in the Patent and Trademark Office a written application in prescribed form and verified by applicant, by paying prescribed fee, and by complying with prescribed rules or regulations. Subsec. (b), Pub. L. 105–330, §109(b), amended subsec. (b) generally. Prior to amendment, subsec. (b) related to application, by person with bona fide intention, under circumstances showing good faith, to use a trademark in commerce to register trademark by filing in the Patent and Trademark Office a written application in prescribed form and verified by applicant, by paying prescribed fee, and by complying with prescribed rules or regulations. Subsec. (d)(1), Pub. L. 105–330, §201(a)(1)(A), inserted "and," after "specifying the date of the applicant’s first use of the mark in commerce." Pub. L. 105–330, §201(a)(1)(B), which directed the striking out of "and, the mode or manner in which the mark is used on or in connection with such goods or services", was executed by striking out ", and the mode or manner in which the mark is used on or in connection with such goods or services" after "notice of allowance on or in connection with which the mark is used in commerce", to reflect the probable intent of Congress. Subsec. (d)(4), Pub. L. 105–330, §109(c), amended par. (4) generally. Prior to amendment, par. (4) read as follows: "The failure to timely file a verified statement of use under this subsection shall result in abandonment of the application." 1988—Subsec. (a). Pub. L. 100–667, §103(1) to (7), inserted "(a)" preceding introductory provisions and substituted "may apply to register his or her" for "may register his", redesignated former subsecs. (a) to (c) as pars. (1) to (3), respectively, redesignated former pars. (1) to (3) as subpars. (A) to (C), respectively, in par. (1)(A), substituted "used on or in connection with" for "applied to" and "goods on or in connection" for "goods in connection", in par. (1)(C), struck out "actually" after "the mark as", and in par. (2), substituted "prescribed" for "filing". Subsecs. (b), (c), Pub. L. 100–667, §103(3), (9), added subsecs. (b) and (c) and redesignated former subsecs. (b) and (c) as subpars. (2) and (3), respectively, of subsec. (a). Subsecs. (d), (e), Pub. L. 100–667, §103(8), (9), added subsec. (d) and redesignated former subsec. (d) as (e). 1975—Subsecs. (a), (b), (d), Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office". 1962—Subsec. (a)(1). Pub. L. 87–772 substituted "as to be likely, when applied to the goods of such other per-
Title 15—Commerce and Trade

§ 1051

Short Title of 2010 Amendment

Short Title of 2006 Amendment
Pub. L. 109–312, § 1(a), Oct. 6, 2006, 120 Stat. 1730, provided that: “This Act [amending sections 1065, 1066, 1068, 1069, 1091, 1092, 1094, 1095, 1111, 1112, 1114 to 1118, 1121, and 1125 to 1127 of this title] may be cited as the ‘Trademark Dilution Revision Act of 2006’.”

Short Title of 2004 Amendment
Pub. L. 108–482, § 1, Dec. 23, 2004, 118 Stat. 3912, provided that: “This Act [amending section 1117 of this title, section 504 of Title 17, Copyrights, sections 2318 and 3559 of Title 18, Crimes and Criminal Procedure, and sections 85 and 112 of Title 28, Judiciary and Judicial Procedure, and enacting provisions set out as notes under this section, section 1117 of this title, sections 2311 and 2318 of Title 18, and listed in a table relating to sentencing guidelines set out as a note under section 991 of Title 28] may be cited as the ‘Intellectual Property Protection and Courts Amendments Act of 2004’.”

Short Title of 2002 Amendment

Short Title of 1999 Amendments
Pub. L. 106–113, div. B, § 1000(a)(9) [title III, §§ 3001(a), 3003(a)], Nov. 29, 1999, 113 Stat. 1356, 1501A–545, provided that: “This title [enacting section 1129 of this title, amending sections 1114, 1116, 1117, 1125, and 1127 of this title, section 470a of Title 16, Conservation, and section 1338 of Title 28, Judiciary and Judicial Procedure, and enacting provisions set out as notes under this section, 1117 of this title and listed in a table relating to sentencing guidelines set out as a note under section 991 of Title 28, Judiciary and Judicial Procedure] may be cited as the ‘Fraudulent Online Identity Sanctions Act’.”

Short Title of 2001 Amendments

Short Title of 1998 Amendments

Short Title of 1996 Amendments

Short Title of 1992 Amendment
Pub. L. 102–542, § 1, Oct. 27, 1992, 106 Stat. 3567, provided that: “This Act [enacting section 1122 of this title, amending sections 1114, 1125, and 1127 of this title, and enacting provisions set out as a note under section 1114 of this title] may be cited as the ‘Trademark Remedy Clarification Act’.”

Short Title of 1988 Amendment
Pub. L. 100–667, title I, § 101, Nov. 16, 1988, 102 Stat. 3955, provided that: “This Act [amending this section and sections 1052 to 1060, 1062, 1066, 1069, 1071, 1091, 1092, 1094, 1095, 1111, 1112, 1114 to 1118, 1121, and 1125 to 1127 of this title, redesignating section 1121 of this title as section 1121(b) of this title, and enacting provisions set out as notes under sections 1051 and 1052 of this title] may be cited as the ‘Trademark Law Revision Act of 1988’.”

Short Title of 1984 Amendment
Pub. L. 98–629, title I, § 101, Nov. 8, 1984, 98 Stat. 3335, provided that: “This title [amending sections 1064 and 1127 of this title and enacting provisions set out as a note under section 1064(b) may be cited as the ‘Trademark Clarification Act of 1984’.”

Short Title
Act July 5, 1946, ch. 540, 60 Stat. 427, which is classified to this chapter, is popularly known as the “Lanham Act” and also as the “Trademark Act of 1946”.

Repeal of Inconsistent Provisions; Certain Provisions Not Affected
Act July 5, 1946, ch. 540, title XI, § 46(a), 60 Stat. 444, as amended by Pub. L. 106–43, §§ 6(b), Aug. 5, 1999, 113 Stat. 220, provided in part that all acts and parts of acts inconsistent with this chapter are repealed effective one year from July 5, 1946, but that “nothing contained in this Act [this chapter] shall be construed as limiting, restricting, modifying, or repealing any statute in force on the effective date of this Act [July 5, 1947] which does not relate to trademarks, or as restricting or increasing the authority of any Federal department or regulatory agency except as may be specifically provided in this Act [this chapter].”


Savings Provision

Separability
Act July 5, 1946, ch. 540, title XI, § 50, 60 Stat. 446, provided that: “If any provision of this Act [this chapter] or the application of such provision to any person or circumstance is held invalid, the remainder of the Act shall not be affected thereby.”

Deadline for Procedures
Pub. L. 116–260, div. Q, title II, § 3323(b), Dec. 27, 2020, 134 Stat. 2291, provided that: “Not later than 1 year after the date of enactment of this Act [Dec. 27, 2020],
the Director shall establish the appropriate procedures described in section 1(f) of the Trademark Act of 1946 [15 U.S.C. 1051(f)], as added by subsection (a)."

For definitions of terms used in section 222(b) of Pub. L. 116–260, set out above, see section 222 of Pub. L. 116–260, set out as a note below.]  

PENDING PROCEEDINGS AND EXISTING REGISTRATION AND RIGHTS UNDER PRIOR ACTS

Act July 5, 1946, ch. 540, title XI, §46(a), 60 Stat. 444, provided, in part that this chapter, except as otherwise specifically provided therein, shall not affect any suit, proceeding or appeal pending on the effective date of this chapter and that the repeal of all inconsistent acts "shall not affect the validity of registrations granted or applied for under any of said Acts prior to the effective date of this Act [July 5, 1947], or rights or remedies thereunder except as provided in sections 8, 12, 14, 15, and 47 of this Act [sections 1058, 1062, 1064, and 1065 of this title and note under this section]."

Act July 5, 1946, ch. 540, title XI, §§46(b), 47, 60 Stat. 445, provided:

"(a) Registrations now existing under the Act of March 3, 1981, or the Act of February 20, 1905 [sections 81 to 109 of this title], shall continue in full force and effect for the unexpired terms thereof and may be renewed under the provisions of section 9 of this Act [section 1059 of this title]. Such registrations and the renewals thereof shall be subject to and entitled to the benefits of the provisions of this Act [this chapter] to the same extent and with the same force and effect as though registered on the principal register established by this Act [this chapter] except as limited in sections 8, 12, 14, and 15 of this Act [sections 1058, 1062, 1064, 1065, of this title]. Marks registered under the ‘ten-year proviso’ of section 5 of the Act of February 20, 1905, as amended [former section 85 of this title], shall be deemed to have become distinctive of the registrant’s goods in commerce under paragraph (f) of section 2 of this Act [section 1052 of this title] and may be renewed under section 9 hereof [section 1059 of this title] as marks coming within said paragraph.

Registrations now existing under the Act of March 19, 1920 [former sections 121 to 128 of this title], shall expire six months after the effective date of this Act [July 5, 1947], or twenty years from the dates of their registrations, whichever date is later. Such registrations shall be subject to and entitled to the benefits of the provisions of this Act [this chapter] relating to marks registered on the supplemental register established by this Act [this chapter] and may not be renewed unless renewal is required to support foreign registrations. In that event renewal may be effected on the supplemental register under the provisions of section 9 of this Act [section 1059 of this title]."

"(b) Marks registered under previous Acts may, if eligible, also be registered under this Act [this chapter]."

"(c) 47. (a) All applications for registration pending in the Patent Office at the effective date of this Act [July 5, 1947] may be amended, if practicable, to bring them under the provisions of this Act [this chapter]. The prosecution of such applications so amended and the grant of registrations thereon shall be proceeded with in accordance with the provisions of this Act [this chapter]. If such amendments are not made, the prosecution of said applications shall be proceeded with and registrations thereon granted in accordance with the Act under which said applications were filed, and said Acts are hereby continued in force to this extent and for this purpose only, notwithstanding the foregoing general repeal thereof.

"(b) In any case in which an appeal is pending before the United States Court of Customs and Patent Appeals or any United States Circuit Court of Appeals or the United States Court of Appeals for the District of Columbia or the United States Supreme Court at the effective date of this Act [July 5, 1947], the court, if it be of the opinion that the provisions of this Act [this chapter] are applicable to the subject matter of the appeal, may apply such provision or may remand the case to the Commissioner [now Director] or to the district court for the taking of additional evidence or a new trial or for reconsideration of the decision on the record as made, as the appellate court may deem proper.''

Act July 5, 1946, ch. 540, title XI, §49, 60 Stat. 446, provided: "Nothing herein [in this chapter] shall adversely affect the rights or the enforcement of rights in marks acquired in good faith prior to the effective date of this Act [July 5, 1947]."  

DEFINITIONS APPLICABLE TO SECTIONS OF PUB. L. 116–260


‘‘(1) DIRECTOR.—The term ‘Director’ means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

‘‘(2) TRADEMARK ACT OF 1946.—The term ‘Trademark Act of 1946’ means the Act entitled ‘An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes’, approved July 5, 1946 (15 U.S.C. 1051 et. seq) (commonly referred to as the ‘Trademark Act of 1946’ or the ‘Lanham Act’).

EMERGENCY RELIEF FROM POSTAL SITUATION AFFECTING TRADEMARK CASES

Relief as to filing date of trademark application or registration and excusal of delayed fees or actions affected by postal situation beginning on Mar. 18, 1970, and ending on or about Mar. 30, 1970, see note set out under section 111 of Title 35, Patents.

Executive Documents

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce to Secretary of Commerce, with certain exceptions, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3774, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§1052. Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living indi-
vidual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided. That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant, is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant’s goods in commerce before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.


Editorial Notes

References in Text


Constitutionality

For information regarding constitutionality of certain provisions of this section, see Congressional Research Service, The Constitution of the United States of America: Analysis and Interpretation, Table of Laws Held Unconstitutional in Whole or in Part by the Supreme Court.

Prior Provisions


2006—Pub. L. 109–312, which directed substitution of “A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.” for last two sentences in subsec. (f) of this section, was executed by making the substitution for “A mark which when used would cause dilution under section 1125(c) of this title may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which when used would cause dilution under section 1125(c) of this title...
may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title." In concluding provisions of section to reflect the probable intent of Congress.


Subsec. (d). Pub. L. 106–113 substituted "Director" for "Commissioner" wherever appearing.

1998—Pub. L. 105–330, § 201(a)(12), substituted "‘trademark’ for ‘‘trade-mark’’ in introductory provi-
sions.

Subsec. (e). Pub. L. 105–330, § 201(a)(2)(A), struck out "‘or’ before ‘‘(d)’’ and inserted ‘‘, or (5) comprises any
matter that, as a whole, is functional’’ before period at end.

Subsec. (f). Pub. L. 105–330, § 201(a)(2)(B), substituted "‘subsections (a), (b), (c), (d), (e)(3), and (e)(5)’’ for ‘‘paragraphs (a), (b), (c), (d), and (e)(3)’’.

Subsec. (f). Pub. L. 105–182, § 330(a)(2), substituted "‘(d), and (e)(3)’’ for ‘‘and (d)’’ and inserted at end "‘Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically descriptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

1998—Subsec. (d). Pub. L. 100–667, § 104(a), amended subsec. (d) generally. Prior to amendment, subsec. (d) read as follows: "Consists of or comprises an immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.

1993—Subsec. (e). Pub. L. 103–182, § 338(a)(1), amended subsec. (e) generally. Prior to amendment, subsec. (e) read as follows: "Consists of a mark which, (1) when used on or in connection with the goods of the applicant, is primarily descriptively misdescriptive of them, or (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of or deceptively misdescriptive of them, except as indicated by historical origin may be registrable under section 1054 of this title, or (3) is primarily merely a surname."

1992—Subsec. (f). Pub. L. 105–182, § 330(a)(2), substituted "‘(d), and (e)(3)’’ for ‘‘and (d)’’ and inserted at end "‘Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically descriptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

1998—Subsec. (d). Pub. L. 100–667, § 104(a), amended subsec. (d) generally. Prior to amendment, subsec. (d) read as follows: "Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive; "Provided. That when the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the goods in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use thereof in commerce prior to any of the filing dates of the applications involved, and provisions directing that issuance of the mark be upon such conditions and limitations as to the mode or place of use of the marks or the goods in connection with which such marks are used, for provisions which required issuance under conditions and limitations as to the mode or place of use of the goods in connection with which such registrations may be granted, and eliminated provisions which limited confusion, mistake, or deception to purchasers, required written notice of applications for concurrent registrations and of hearings thereon, and publication in the Official Gazette upon a decision to grant such a registration and permitted a court to order such a registration under section 4915 of the Revised Statutes.

Statutory Notes and Related Subsidiaries

Effective Date of 1999 Amendments

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Pub. L. 106–43, § 2(e), Aug. 5, 1999, 113 Stat. 219, provided that: "The amendments made by this section [amending this section and sections 1063, 1064, and 1092 of this title] shall take effect on the date of enactment of this Act [Aug. 5, 1999] and shall apply only to any application for registration filed on or after January 16, 1999."

Effective Date of 1998 Amendment

Amendment by Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

Effective Date of 1994 Amendment


Effective Date of 1993 Amendment

Pub. L. 103–182, title III, § 335, Dec. 8, 1993, 107 Stat. 216, which provided that the amendments made: (1) by sections 322, 341, and 335 of Pub. L. 103–182 took effect on the date NAFTA entered into force with respect to the United States (Jan. 1, 1994); (2) by section 331 of Pub. L. 103–182 applied to patent applications filed on or after Dec. 8, 1993; and (3) by section 335 of Pub. L. 103–182 applied only to trademark applications filed on or after Dec. 8, 1993, was repealed by Pub. L. 116–113, 116–113,
§ 1054. Collective marks and certification marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, indicating indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner of a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.


Editorial Notes

Prior Provisions


Amendments

1999—Pub. L. 106–43 substituted “‘trademarks’” for “‘trade-marks’” wherever appearing. 1988—Pub. L. 100–667 substituted “‘origin,’” for “‘origin used in commerce,’” and “‘except in the case of certification marks when’” for “‘except when’” and struck out after first sentence “‘The Commissioner may establish a separate register for such collective marks and certification marks.’”

Statutory Notes and Related Subsidiaries

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Statutory Notes and Related Subsidiaries

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

Chapter 15—Commerce and Trade

$1053. Service marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.


Editorial Notes

Amendments

1999—Pub. L. 106–43 substituted “‘trademarks’” for “‘trade-marks’” wherever appearing. 1988—Pub. L. 100–667 struck out “‘used in commerce’” after “‘applicable, service marks’” and “‘except when used so as to represent falsely that the owner thereof makes or sells the goods on which such mark is used. The Commissioner may establish a separate register for such service marks’” after “‘case of trade-marks’”.

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Statutory Notes and Related Subsidiaries

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Effective Date of 1975 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Marks Registered Under Ten-Year Provisio of Trade-Mark Act of 1905

Marks registered under the “‘ten-year proviso’” of section 5 of the act of Feb. 20, 1905, as amended, deemed to have become distinctive of the registrant’s goods in commerce under par. (f) of this section, see section 46(b) of act July 5, 1946, set out in note under section 1051 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1054. Collective marks and certification marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, indicating indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.


Editorial Notes

Prior Provisions


Amendments

1999—Pub. L. 106–43 substituted “‘trademarks’” for “‘trade-marks’” wherever appearing. 1988—Pub. L. 100–667 substituted “‘origin,’” for “‘origin used in commerce,’” and “‘except in the case of certification marks when’” for “‘except when’” and struck out after first sentence “‘The Commissioner may establish a separate register for such collective marks and certification marks.’”

Statutory Notes and Related Subsidiaries

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.
§ 1055. Use by related companies affecting validity and registration

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration or registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public. If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.


Editorial Notes

Amendments

1988—Pub. L. 100–667 inserted at end “If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.”

Statutory Notes and Related Subsidiaries

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1056. Disclaimer of unregistrable matter

(a) Compulsory and voluntary disclaimers

The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) Prejudice of rights

No disclaimer, including those made under subsection (e) of section 1057 of this title, shall prejudice or affect the applicant’s or registrant’s rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.

(As added Nov. 16, 1988, Pub. L. 100–667, title I, § 106, 102 Stat. 3938.)

Editorial Notes

Amendments

1989—Pub. L. 100–113 substituted “Director” for “Commissioner”.

1988—Subsec. (b). Pub. L. 100–667 substituted “subsection (e)” for “paragraph (d)”.

Executive Documents

Transfer of Functions

For transfer of functions of other offices, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1057. Certificates of registration

(a) Issuance and form

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the United States Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon, and a record thereof shall be kept in the United States Patent and Trademark Office. The registration shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the United States Patent and Trademark Office, and any conditions and limitations that may be imposed in the registration.

(b) Certificate as prima facie evidence

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

(c) Application to register mark considered constructive use

Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing—

(1) has used the mark;
(2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or
(3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) of this title to register the mark which is pending or has resulted in registration of the mark.

(d) Issuance to assignee

A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the United States Patent and Trademark Office. In case of change of ownership the Director shall, at the request of the owner and upon a proper showing and the payment of the prescribed fee, issue a certificate stating the fact and nature of such mistake occurred in good faith through the fault of the applicant, the Director is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: Provided, That the correction does not involve such changes in the registration as to require republication of the mark.

(e) Surrender, cancellation, or amendment by owner

Upon application of the owner the Director may permit any registration to be surrendered for cancellation, and upon cancellation appropriate entry shall be made in the records of the United States Patent and Trademark Office. Upon application of the owner and payment of the prescribed fee, the Director for good cause may permit any registration to be amended or to be disclaimed in part: Provided, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the United States Patent and Trademark Office and upon the certificate of registration.

(f) Copies of United States Patent and Trademark Office records as evidence

Copies of any records, books, papers, or drawings belonging to the United States Patent and Trademark Office relating to marks, and copies of registrations, when authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his name by an employee of the Office duly designated by the Director, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefor and paying the prescribed fee shall have such copies.

(g) Correction of United States Patent and Trademark Office mistake

Whenever a material mistake in a registration, incurred through the fault of the United States Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration and such corrected registration shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the Director a new certificate of registration may be issued without charge. All certificates of correction herefore issued in accordance with the rules of the United States Patent and Trademark Office and the registrations to which they are attached shall have the same force and effect as if such certificates and their issue had been specifically authorized by statute.

(h) Correction of applicant’s mistake

Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Director is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: Provided, That the correction does not involve such changes in the registration as to require republication of the mark.

Editorial Notes

Prior Provisions

Subses. (a) and (c) are from acts Feb. 20, 1905, ch. 592, § 11, 33 Stat. 727; Mar. 4, 1925, ch. 535, § 3, 43 Stat. 1269. Subsec. (e) is from act Mar. 19, 1920, ch. 104, § 7, 41 Stat. 535. Subsec. (f) is from act Mar. 4, 1925, ch. 535, § 1, 43 Stat. 1268.

Amendments


Provided That the correction
§ 1058. Duration, affidavits and fees

(a) Time periods for required affidavits

Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director unless the owner of the registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods:

(1) Within the 1-year period immediately preceding the expiration of 6 years following the date of registration under this chapter or the date of the publication under section 1062(c) of this title.

(2) Within the 1-year period immediately preceding the expiration of 10 years following the date of registration, and each successive 10-year period following the date of registration.

(3) The owner may file the affidavit required under this section within the 6-month grace period immediately following the expiration of the periods established in paragraphs (1) and (2), together with the fee described in subsection (b) and the additional grace period surcharge prescribed by the Director.

(b) Requirements for affidavit

The affidavit referred to in subsection (a) shall—
accompanied by the additional deficiency surcharge prescribed by the Director; and
(D) be accompanied by the fee prescribed by the Director.

c) Deficient affidavit
If any submission filed within the period set forth in subsection (a) is deficient, including that the affidavit was not filed in the name of the owner of the registration, the deficiency may be corrected after the statutory time period, within the time prescribed after notification of the deficiency. Such submission shall be accompanied by the additional deficiency surcharge prescribed by the Director.

d) Notice of requirement
Special notice of the requirement for such affidavit shall be attached to each certificate of registration and notice of publication under section 1062(c) of this title.

(e) Notification of acceptance or refusal
The Director shall notify any owner who files any affidavit required by this section of the Director's acceptance or refusal thereof, in the case of a refusal, the reasons therefor.

(f) Designation of resident for service of process and notices
If the owner is not domiciled in the United States, the owner may designate, by a document filed in the United States 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 specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Director.

1999—Subsecs. (a) to (c). Pub. L. 106–113, §1000(a)(9) [title IV, §4732(b)(1)(B)], substituted “Director” for “Commissioner” wherever appearing.

Subsec. (e). Pub. L. 106–113, §1000(a)(9) [title IV, §4732(b)(1)(B), (C)], amended subsec. (e) identically, substituting “Director” for “Commissioner”.


1998—Pub. L. 105–330 amended section catchline and text generally. Prior to amendment, text consisted of subsecs. (a) to (c) relating to affidavits of continuing use, registrations published under other provisions of law, and notification of acceptance or refusal of affidavits.

1996—Subsec. (a). Pub. L. 100–667 substituted “ten” for “twenty” and “setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce” for “showing that said mark is in use in commerce or showing that it is being used”. Pub. L. 100–667 redesignated subsec. (b) as (a) and inserted “ domicile” after “in the United States”.

1992—Subsecs. (a), (b). Pub. L. 97–247 struck out “still” after “showing that said mark is”, and inserted “ in commerce” after “use”.


Statutory Notes and Related Subsidiaries

Effective Date of 1999 Amendment
Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1998 Amendment

expiration date of the registration is on or after the effective date of this Act [probably should be “this title”], see section 110 of Pub. L. 108–330, set out as an Effective Date of 1998 Amendment note under section 1051 of this title]."

For provisions relating to applicability of amendment by Pub. L. 105–330 to applications for registration of trademarks, see section 109(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

Pub. L. 105–330, title I, §109(c), Oct. 30, 1998, 112 Stat. 3069, provided that: “The provisions of section 8 of the Trademark Act of 1946 [15 U.S.C. 1058], as amended by section 105 of this Act, shall apply to the filing of an affidavit if the sixth or tenth anniversary of the registration, or the sixth anniversary of publication of the registration under section 12(c) of the Trademark Act of 1946 [15 U.S.C. 1062(c)], for which the affidavit is filed is on or after the effective date of this Act [probably should be “this title”], see section 110 of Pub. L. 105–330, set out as an Effective Date of 1998 Amendment note under section 1051 of this title]."

**Effective Date of 1988 Amendment**

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

**Effective Date of 1982 Amendment**


**Repeal and Effect on Existing Rights**

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, and saving clause, see notes set out under section 1051 of this title.

**References to Trademark Act of 1946**


**Pending Applications**


**Executive Documents**

**Transfer of Functions**

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1283, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1059. Renewal of registration

(a) Period of renewal; time for renewal

Subject to the provisions of section 1058 of this title, each registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the Director. Such application may be made at any time within 1 year before the end of each successive 10-year period for which the registration was issued or renewed, or it may be made within a grace period of 6 months after the end of each successive 10-year period, upon payment of a fee and surcharge prescribed therefor. If any application filed under this section is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.

(b) Notification of refusal of renewal

If the Director refuses to renew the registration, the Director shall notify the registrant of the Commissioner’s refusal and the reasons therefor.

(c) Designation of resident for service of process and notices

If the registrant is not domiciled in the United States the registrant may designate, by a document filed in the United States 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 serving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States 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 on the Director.


**Editorial Notes**

**Prior Provisions**


**Amendments**

2002—Subsec. (c). Pub. L. 107–273 amended subsec. (c) generally. Prior to amendment, text read as follows: “If the registrant is not domiciled in the United States, the registrant shall designate by a written document filed in the Patent and Trademark Office the name and address of some 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 specified in the last designation so filed. If

1 So in original. Probably should be “Director’s”. 
the person so designated cannot be found at the address
given in the last designation, such notice or process
may be served upon the Director.'
1998—Subsec. (a). Pub. L. 106–113, §1000(a)(9) [title IV, §4732(b)(1)(B)], substituted ‘‘Director’’ for ‘‘Commissi-

Subsec. (b). Pub. L. 106–113, §1000(a)(9) [title IV, §4732(b)(1)(B)], amended subsec. (b) identically, sub-

Subsec. (c). Pub. L. 106–113, §1000(a)(9) [title IV, §4732(b)(1)(B)], substituted ‘‘Director’’ for ‘‘Commissi-

1998—Pub. L. 105–330 amended section catchline and
text generally. Prior to amendment, text consisted of
subsecs. (a) to (c) relating to period of renewal and
time for renewal, notification of refusal of renewal, and
applicants for renewal not domiciled in the United
States.
‘‘ten’’ for ‘‘twenty’’.
Subsec. (c). Pub. L. 100–667, §111(2), substituted
‘‘1051(e)’’ for ‘‘1051(d)’’.
1962—Pub. L. 87–772 designated existing provisions as
subsecs. (a) and (c), added subsec. (b), and among other
changes, amended subsec. (a) by substituting provisions
requiring a verified application specifying the goods or
services recited in the registration on or in connection
with which the mark is still in use in commerce and
having attached a specimen showing current use of the
mark, or showing that any nonuse is due to special cir-
cumstances which excuse the nonuse and that it’s not
due to an intention to abandon the mark, for provisions
requiring an affidavit by the registrant stating that the
mark is still in use in commerce.

Statutory Notes and Related Subsidaries

Effective Date of 1999 Amendment
Amendment by Pub. L. 106–113 effective 4 months
after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731]
of Pub. L. 106–113, set out as a note under section 1 of
Title 35, Patents.

Effective Date of 1998 Amendment
Amendment by Pub. L. 105–330 effective on the date
that is 1 year after Oct. 30, 1998, see section 110 of Pub.
L. 105–330, set out as a note under section 1051 of this
title.

For provisions relating to applicability of amend-
ment by Pub. L. 105–330 to applications for registration of
trademarks, see section 106(b) of Pub. L. 105–330, set
out as a note under section 1051 of this title.

3069, provided that: ‘‘The amendment made by section
106 (amending this section) shall apply to the filing of
an application for renewal of a registration if the expi-
ration date of the registration for which the renewal
application is filed is on or after the effective date of
this Act [probably should be ‘‘this title’’, see section
110 of Pub. L. 105–330, set out as an Effective Date of
1998 Amendment note under section 1051 of this title].’’

Effective Date of 1988 Amendment
Amendment by Pub. L. 100–667 effective one year
after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set
out as a note under section 1051 of this title.

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chap-
ter on pending proceedings and existing registrations
and rights under prior acts, see notes set out under sec-
section 1051 of this title.

Renewal Under Prior Acts
Renewal of registrations under prior acts, see section
46(b) of act July 5, 1946, set out as a note under section
1051 of this title.

Extension of Time for Renewal by Foreign Regrant

Act July 17, 1946, ch. 587, 60 Stat. 568, provided for ex-
tension of time for renewal by a foreign registrant and
expired by its own terms July 17, 1949.

§ 1060. Assignment

(a)(1) A registered mark or a mark for which
an application to register has been filed shall be
assignable with the good will of the business in
which the mark is used, or with that part of the
good will of the business connected with the use
of and symbolized by the mark. Notwithstanding
the preceding sentence, no application to reg-
ister a mark under section 1051(b) of this title
shall be assignable prior to the filing of an
amendment under section 1051(c) of this title to
bring the application into conformity with section
1051(a) of this title or the filing of the verified
statement of use under section 1051(d) of this
title, except for an assignment to a suc-
cessor to the business of the applicant, or por-
tion thereof, to which the mark pertains, if that
business is ongoing and existing.

(2) In any assignment authorized by this sec-
tion, it shall not be necessary to include the
good will of the business connected with the use
of and symbolized by any other mark used in the
business or by the name or style under which
the business is conducted.

(3) Assignments shall be by instruments in
writing duly executed. Acknowledgment shall be
prima facie evidence of the execution of an
assignment, and when the prescribed information
reporting the assignment is recorded in the
United States Patent and Trademark Office, the
record shall be prima facie evidence of execu-
tion.

(4) An assignment shall be void against any
subsequent purchaser for valuable consideration
without notice, unless the prescribed informa-
tion reporting the assignment is recorded in the
United States Patent and Trademark Office within
3 months after the date of the assign-
ment or prior to the subsequent purchase.

(5) The United States Patent and Trademark
Office shall maintain a record of information on
assignments, in such form as may be prescribed
by the Director.

(b) An assignee not domiciled in the United
States may designate by a document filed in the
United States 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 per-
son so designated by leaving with that person or
mailing to that person a copy thereof at the
address specified in the last designation so filed. If
the person so designated cannot be found at the
address given in the last designation, or if the
assignee does not designate by a document filed
in the United States Patent and Trademark Of-
office the name and address of a person resident in
the United States on whom may be served no-
tices or process in proceedings affecting the
mark, such notices or process may be served
upon the Director.

(July 5, 1946, ch. 540, title I, §10, 60 Stat. 431;
...

Editorial Notes

Prior Provisions


Amendments

2002—Subsecs. (a), (b), Pub. L. 107–273 amended subsecs. (a) and (b) generally, in subsec. (a) substituting pars. (1) to (5) for substantially identical redesignated provisions, and in subsec. (b) adding provisions relating to service on Director if assignee does not designate name and address of a person resident in the United States on whom may be served notices or process.


Pub. L. 106–43, §6(a)(1), which directed the amendment of the penultimate sentence of this section by substituting “assignment” for “subsequent purchase”, was executed by making the substitution for “subsequent purchase” in two places in the penultimate sentence of subsec. (a), after “date of the” and “prior to the”, to reflect the probable intent of Congress.


1998—Pub. L. 105–330 amended section catchline and text generally. Prior to amendment, text read as follows:

“A registered mark or a mark for which application to register has been filed shall be assignable with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of and symbolized by the mark. However, no application to register a mark under section 1051(b) of this title shall be assignable prior to the filing of the verified statement of use under section 1051(d) of this title, except to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section it shall not be necessary to include the goodwill of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted. Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment and when recorded in the Patent and Trademark Office the record shall be prima facie evidence of execution. An assignment shall be void as against any subsequent purchaser for a valuable consideration without notice, unless it is recorded in the Patent and Trademark Office within three months after the date thereof or prior to such subsequent purchase. A separate record of assignments submitted for recording hereunder shall be maintained in the Patent and Trademark Office.

An assignee not domiciled in the United States shall be subject to and comply with the provisions of section 1031(e) of this title.

1988—Pub. L. 100–667 substituted “.” However, no application to register a mark under section 1051(b) of this title shall be assignable prior to the filing of the verified statement of use under section 1051(d) of this title, except to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section it shall not be necessary to include the goodwill of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted. Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment and when recorded in the Patent and Trademark Office the record shall be prima facie evidence of execution. An assignment shall be void as against any subsequent purchaser for a valuable consideration without notice, unless it is recorded in the Patent and Trademark Office within three months after the date thereof or prior to such subsequent purchase. A separate record of assignments submitted for recording hereunder shall be maintained in the Patent and Trademark Office.

An assignee not domiciled in the United States shall be subject to and comply with the provisions of section 1031(e) of this title.


1962—Pub. L. 87–772 substituted provisions which require a separate record of assignments to be kept in the Patent Office, for provisions which required the Commissioner to keep such record, and eliminated provisions permitting the cancellation of any assigned registration at any time if the registered mark is being used by, or with the permission of, the assignee so as to misrepresent the source of the goods or services in connection with which the mark is used.

Statutory Notes and Related Subsidiaries

Effective Date of 1999 Amendment

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 110 of Pub. L. 106–113, set out as a note under section 1051 of this title.

For provisions relating to applicability of amendment by Pub. L. 106–330 to applications for registration of trademarks, see section 109(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

Effective Date of 1998 Amendment


Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1975 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§1061. Execution of acknowledgments and verifications

Acknowledgments and verifications required under this chapter may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States or before any official authorized to administer oaths in the foreign country concerned whose authority is proved by a certificate of a diplomatic or consular officer
§ 1062. Publication

(a) Examination and publication

Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office: Provided, That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 1066 of this title the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

(b) Refusal of registration; amendment of application; abandonment; extensions of time to respond

(1) If the applicant is found not entitled to registration, the examiner shall notify the applicant thereof and of the reasons therefor. The applicant may reply or amend the application, which shall then be reexamined. This procedure may be repeated until the examiner finally refuses registration of the mark or the application is abandoned as described in paragraph (2).

(2) After notification under paragraph (1), the applicant shall have a period of 6 months in which to reply or amend the application, or such shorter time that is not less than 60 days, as prescribed by the Director by regulation. If the applicant fails to reply or amend or appeal within the relevant time period, including any extension under paragraph (3), the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the application may be revived and such time may be extended. The Director may prescribe a fee to accompany any request to revive.

(3) The Director shall provide, by regulation, for extensions of time to respond to the examiner for any time period under paragraph (2) that is less than 6 months. The Director shall allow the applicant to obtain extensions of time to reply or amend aggregating 6 months from the date of notification under paragraph (1) when the applicant so requests. However, the Director may set by regulation the time for individual periods of extension, and prescribe a fee, by regulation, for any extension request. Any request for extension shall be filed on or before the date on which a reply or amendment is due under paragraph (1).

(c) Republication of marks registered under prior acts

A registrant of a mark registered under the provisions of the Act of March 3, 1881, or the Act of February 20, 1905, may, at any time prior to the expiration of the registration thereof, upon the payment of the prescribed fee file with the Director an affidavit setting forth those goods stated in the registration on which said mark is in use in commerce and that the registrant claims the benefits of this chapter for said mark. The Director shall publish notice thereof with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section 1058 of this title. Marks published under this subsection shall not be subject to the provisions of section 1063 of this title.


Editorial Notes

Prior Provisions


Amendments

1982—Pub. L. 97-247 substituted "is" for "shall be" after "whose authority", and inserted ", or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States".

Statutory Notes and Related Subsidiaries

Effective Date of 1982 Amendment

Amendment by Pub. L. 97-247 effective Aug. 27, 1982, see section 17(a) of Pub. L. 97-247, set out as a note under section 41 of Title 35, Patents.

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1561 of this title.

§ 1062. Publication

(a) Examination and publication

Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office: Provided, That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 1066 of this title, the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

(b) Refusal of registration; amendment of application; abandonment; extensions of time to respond

(1) If the applicant is found not entitled to registration, the examiner shall notify the applicant thereof and of the reasons therefor. The applicant may reply or amend the application, which shall then be reexamined. This procedure may be repeated until the examiner finally refuses registration of the mark or the application is abandoned as described in paragraph (2).

(2) After notification under paragraph (1), the applicant shall have a period of 6 months in which to reply or amend the application, or such shorter time that is not less than 60 days, as prescribed by the Director by regulation. If the applicant fails to reply or amend or appeal within the relevant time period, including any extension under paragraph (3), the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the application may be revived and such time may be extended. The Director may prescribe a fee to accompany any request to revive.

(3) The Director shall provide, by regulation, for extensions of time to respond to the examiner for any time period under paragraph (2) that is less than 6 months. The Director shall allow the applicant to obtain extensions of time to reply or amend aggregating 6 months from the date of notification under paragraph (1) when the applicant so requests. However, the Director may set by regulation the time for individual periods of extension, and prescribe a fee, by regulation, for any extension request. Any request for extension shall be filed on or before the date on which a reply or amendment is due under paragraph (1).

(c) Republication of marks registered under prior acts

A registrant of a mark registered under the provisions of the Act of March 3, 1881, or the Act of February 20, 1905, may, at any time prior to the expiration of the registration thereof, upon the payment of the prescribed fee file with the Director an affidavit setting forth those goods stated in the registration on which said mark is in use in commerce and that the registrant claims the benefits of this chapter for said mark. The Director shall publish notice thereof with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section 1058 of this title. Marks published under this subsection shall not be subject to the provisions of section 1063 of this title.


Editorial Notes

References in Text


Prior Provisions


Amendments

2020—Subsec. (b). Pub. L. 116-260 amended subsec. (b) generally. Prior to amendment, text read as follows: "If the applicant is found not entitled to registration, the
§ 1063. Opposition to registration

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

(b) Unless registration is successfully opposed—

(1) a mark entitled to registration on the principal register based on an application filed under section 1051(a) of this title or pursuant to section 1126 of this title shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or

(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1051(b) of this title.

Editorial Notes

Prior Provisions


Amendments

2006—Subsec. (a). Pub. L. 109-312 substituted ““the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment”’ for ““as a result of dilution”’.


Pub. L. 106-43 inserted ““including as a result of dilution under section 1125(c) of this title,”’ after “principal register” in first sentence.

1998—Pub. L. 106-113 inserted ““an”’ for ““a”’ after “required fee, file”, inserted ““when requested prior to the expiration of an extension”’ after “Commissioner for good cause” and struck out provision that an unverified opposition could be filed by a duly authorized attorney, but such opposition would be null and void unless verified by the opposer within a reasonable time after such filing is fixed by the Commissioner.
1975—Pub. L. 93–600 substituted provisions relating to extensions of time for filing opposition upon written request prior to the expiration of the thirty-day period for an additional thirty days, and further extensions for good cause, for provisions relating to extensions of the time for filing opposition for good cause shown. Pub. L. 93–596 substituted ‘‘Patent and Trademark Office’’ for ‘‘Patent Office’’.

1962—Pub. L. 87–772 inserted ‘‘An opposition may be amended under such conditions as may be prescribed by the Commissioner’’, and struck out ‘‘notice of’’ after ‘‘file a verified’’ and ‘‘time for filing’’.

Statutory Notes and Related Subsidiaries

Effective Date of 1999 Amendments


Effective Date of 1988 Amendment

Amendment by Pub. L. 101–466 effective one year after Nov. 16, 1988, see section 126 of Pub. L. 101–466, set out as a note under section 1051 of this title.

Effective Date of 1982 Amendment

Amendment by Pub. L. 97–247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97–247, set out as a note under section 194 of Title 5, Government Organization and Employees.

Effective Date of 1975 Amendments


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1061 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1283, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1064. Cancellation of registration

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this chapter.

(2) Within five years from the date of publication under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 1062 of this title.

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.

(6) At any time after the 3-year period following the date of registration, if the registered mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration:

Provided. That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required. Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.
Nothing in paragraph (6) shall be construed to limit the timing applicable to any other ground for cancellation. A registration under section 1126(e) or 1141f of this title shall not be cancelled pursuant to paragraph (6) if the registrant demonstrates that any nonuse is due to special circumstances that excuse such nonuse.


**Editorial Notes**

**References in Text**

Acts March 3, 1881 and February 20, 1905, referred to in opening par. and pars. (2) and (4), are acts Mar. 3, 1881, ch. 81, 21 Stat. 396, and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by Act July 5, 1946, ch. 540, § 46(a), 60 Stat. 441. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

**Prior Provisions**


**Amendments**

2020—Pub. L. 116–260, § 225(b)(3), in concluding proviso, inserted “Nothing in paragraph (6) shall be construed to limit the timing applicable to any other ground for cancellation. A registration under section 1126(e) or 1141f of this title shall not be cancelled pursuant to paragraph (6) if the registrant demonstrates that any nonuse is due to special circumstances that excuse such nonuse.” after “identification certification mark is applied.”


2006—Pub. L. 109–312 substituted “. including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title,” for “. including as a result of dilution under section 1125(c) of this title,” in introductory provisions.

1999—Pub. L. 106–43 inserted “. including as a result of dilution under section 1125(c) of this title,” after “diluted” in introductory provisions.

1988—Pub. L. 105–330, § 301, inserted at end “Nothing in paragraph (6) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.”

Par. (3). Pub. L. 105–330, § 201(a)(4), inserted “. or is functional,” before “or has been abandoned.”

1988—Pub. L. 105–667, § 115(1), (7), in introductory provisions, inserted “as follows” and substituted “1905.” for “1905— ,” and in concluding proviso substituted “paragraphs (3) and (6) for “subsections (c) and (e).”

Par. (1). Pub. L. 105–667, § 115(2), substituted “(1) Within” for “(a) within” and “chapter.” for “chapter; or”.

Par. (2). Pub. L. 100–667, § 115(3), substituted “(2) Within” for “(b) within” and “1905.” for “1905—.”

Par. (3). Pub. L. 100–667, § 115(4), substituted “(3)” for “(c)” and amended text generally. Prior to amendment, text read as follows: “at any time if the registered mark becomes the common descriptive name of an article or substance, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsections (b), (c), or (d) of section 1052 of this title for a registration hereunder, or contrary to similar prohibitory provisions of said prior Acts for a registration hereunder, or if the registrants mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services in connection with which the mark is used. A registered mark shall not be deemed to be the common descriptive name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the common descriptive name of goods or services in connection with which it has been used or is being used by.”

1982—Pub. L. 97–247 struck out “verified” before “petition to cancel” in provision preceding par. (a). Pub. L. 98–620 inserted provision that a registered mark shall not be deemed to be the common descriptive name of goods or services solely because such mark is also used as a name of or to identify a unique product or service, and that the primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the common descriptive name of goods or services in connection with which it has been used.

1962—Pub. L. 87–772 inserted provisions which require a verified petition to cancel a registration, redesignated par. (d) as (e), added par. (d) which is composed of provisions formerly part of par. (c), and in said par. (c), substituted “registrant” for “assignee,” and struck out “on which the patent has expired” before “or has been abandoned,” and “has been assigned and” before “is being used by.”

**Statutory Notes and Related Subsidiaries**

**Effective Date of 2020 Amendment**

Pub. L. 116–260, div. Q, title II, § 225(g), Dec. 27, 2020, 191 Stat. 2238, provided that: “The amendments made by this section [enacting sections 1066a and 1066b of this title and amending this section and sections 1065, 1070, 1071, and 1094 of this title] shall take effect upon the expiration of the 1-year period beginning on the date of enactment of this Act [Dec. 27, 2020], and shall apply to any mark registered before, on, or after that effective date.”

**Effective Date of 1999 Amendment**

Amendment by Pub. L. 106–43 effective Aug. 5, 1999, and applicable only to any application for registration filed on or after Jan. 16, 1996, see section 2(e) of Pub. L. 106–43, set out as a note under section 1052 of this title.

**Effective Date of 1998 Amendment**

Amendment by section 201(a)(4) of Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

**Effective Date of 1988 Amendment**

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.
Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3), (5), and (6) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark registered under this chapter of such mark, the right of the owner to use such registered mark in commerce for the goods or services or a portion thereof, for which it is registered, shall be incontestable:

(1) there has been no final decision adverse to the owner’s claim of ownership of such mark for such goods or services, or to the owner’s right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Director within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and other matters specified in paragraphs (1) and (2) hereof; and

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Director within one year after the expiration of any period of five consecutive years beginning after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Director shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

Editorial Notes

References in Text

§ 1066. Interference; declaration by Director

Upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared be-

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

$1066a. Ex parte expungement

(a) Petition

Notwithstanding sections 1057(b) and 1072 of this title, and subsections (a) and (b) of section 1115 of this title, any person may file a petition to expunge a registration of a mark on the basis that the mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration.

(b) Contents of petition

A petition filed under subsection (a), together with any supporting documents, shall—

(1) identify the registration that is the subject of the petition;
(2) identify each good or service recited in the registration for which it is alleged that the mark has never been used in commerce;  
(3) include a verified statement that sets forth—  
(A) the elements of the reasonable investigation the petitioner conducted to determine that the mark has never been used in commerce or in connection with the goods and services identified in the petition; and  
(B) any additional facts that support the allegation that the mark has never been used in commerce or in connection with the identified goods and services;  
(4) include any supporting evidence on which the petitioner relies; and  
(5) be accompanied by the fee prescribed by the Director.  
(c) Initial determination; institution  
(1) Prima facie case determination, institution, and notification  
The Director shall, for each good or service identified under subsection (b)(2), determine whether the petition sets forth a prima facie case of the mark having never been used in commerce on or in connection with each such good or service, institute an ex parte expungement proceeding for each good or service for which the Director determines that a prima facie case has been set forth, and provide a notice to the registrant and petitioner of the determination of whether or not the proceeding was instituted. Such notice shall include a copy of the petition and any supporting documents and evidence that were included with the petition.  
(2) Reasonable investigation guidance  
The Director shall promulgate regulations regarding what constitutes a reasonable investigation under subsection (b)(3) and the general types of evidence that could support a prima facie case that a mark has never been used in commerce, but the Director shall retain the discretion to determine whether a prima facie case is set out in a particular proceeding.  
(3) Determination by Director  
Any determination by the Director whether or not to institute a proceeding under this section shall be final and non-reviewable, and shall not prejudice any party’s right to raise any issue and rely on any evidence in any other proceeding, except as provided in subsection (j).  
(d) Ex parte expungement procedures  
The procedures for ex parte expungement shall be the same as the procedures for examination under section 1062(b) of this title, except that the Director shall promulgate regulations establishing and governing a proceeding under this section, which may include regulations that—  
(1) set response and extension times particular to this type of proceeding, which, notwithstanding section 1062(b)(3) of this title, need not be extendable to 6 months;  
(2) set limits governing the timing and number of petitions filed for a particular registration or by a particular petitioner or real parties in interest; and  
(3) define the relation of a proceeding under this section to other proceedings concerning the mark.  
(e) Registrant’s evidence of use  
A registrant’s documentary evidence of use shall be consistent with when a mark shall be deemed to be in use in commerce under the definition of “use in commerce” in section 1127 of this title, but shall not be limited in form to that of specimens as provided in section 1051(a) of this title.  
(f) Excusable nonuse  
During an ex parte expungement proceeding, for a mark registered under section 1126(e) of this title or an extension of protection under section 1141f of this title, the registrant may offer evidence showing that any nonuse was excusable for special circumstances that excuse such nonuse. In such a case, the examiner shall determine whether the facts and evidence demonstrate excusable nonuse and shall not find that the registration should be cancelled under subsection (g) for any good or service for which excusable nonuse is demonstrated.  
(g) Examiner’s decision; order to cancel  
For each good or service for which it is determined that a mark has never been used in commerce, and for which the provisions of subsection (f) do not apply, the examiner shall find that the registration should be cancelled for each such good or service. A mark shall not be found to have never been used in commerce if there is evidence of use in commerce by the registrant that temporally would have supported registration at the time the application was filed or the relevant allegation of use was made, or after registration, but before the petition to expunge was filed under subsection (a), or an ex parte expungement proceeding was instituted by the Director under subsection (h). Unless overturned on review of the examiner’s decision, the Director shall issue an order cancelling the registration, in whole or in part, after the time for appeal has expired or any appeal proceeding has terminated.  
(h) Ex parte expungement by the Director  
(1) In general  
The Director may, on the Director’s own initiative, institute an ex parte expungement proceeding if the Director discovers information that supports a prima facie case of a mark having never been used in commerce on or in connection with any good or service covered by a registration. The Director shall promptly notify the registrant of such determination, at which time the ex parte expungement proceeding shall proceed according to the same procedures for ex parte expungement established pursuant to subsection (d). If the Director determines, based on the Director’s own initiative, to institute an expungement proceeding, the Director shall transmit or make available the information that formed the basis for that determination as part of the institution notice sent to the registrant.
(2) Rule of construction

Nothing in this subsection shall be construed to limit any other authority of the Director.

(i) Time for institution

(1) When petition may be filed, ex parte expungement proceeding instituted

A petition for ex parte expungement of a registration under subsection (a) may be filed, or the Director may institute on the Director’s own initiative an ex parte expungement proceeding of a registration under subsection (h), at any time following the expiration of 3 years after the date of registration and before the expiration of 10 years following the date of registration.

(j) Limitation on later ex parte expungement proceedings

(1) No co-pending proceedings

With respect to a particular registration, while an ex parte expungement proceeding is pending, no later ex parte expungement proceeding may be instituted with respect to the same goods or services that are the subject of a pending ex parte expungement proceeding.

(2) Estoppel

With respect to a particular registration, for goods or services previously subject to an instituted expungement proceeding for which, in that proceeding, it was determined that the registrant had used the mark for particular goods or services, as relevant, and the registration was not cancelled as to those goods or services, no further ex parte expungement proceedings may be instituted as to those goods or services, regardless of the identity of the petitioner.

(k) Use in commerce requirement not altered

Nothing in this section shall affect the requirement for use in commerce of a mark registered under section 1051(a) or 1091 of this title.

(2) Amendment

A petition for reexamination

A petition filed under subsection (a), together with any supporting documents, shall—

(1) identify the registration that is the subject of the petition;

(2) identify each good and service recited in the registration for which it is alleged that the mark was not in use in commerce on or in connection with on or before the relevant date;

(3) include a verified statement that sets forth—

(A) the elements of the reasonable investigation the petitioner conducted to determine that the mark was not in use in commerce on or in connection with the identified goods and services identified in the petition or before the relevant date; and

(B) any additional facts that support the allegation that the mark was not in use in commerce on or before the relevant date on or in connection with the identified goods and services;

(4) include supporting evidence on which the petitioner relies; and

(5) be accompanied by the fee prescribed by the Director.

(d) Initial determination; institution

(1) Prima facie case determination, institution, and notification

The Director shall, for each good or service identified under subsection (c)(2), determine whether the petition sets forth a prima facie case of the mark having not been in use in
commerce on or in connection with each such good or service, institute an ex parte reexamination proceeding for each good or service for which the Director determines that the prima facie case has been set forth, and provide a notice to the registrant and petitioner of the determination of whether or not the proceeding was instituted. Such notice shall include a copy of the petition and any supporting documents and evidence that were included with the petition.

(2) Reasonable investigation guidance

The Director shall promulgate regulations regarding what constitutes a reasonable investigation under subsection (c)(3) and the general types of evidence that could support a prima facie case that the mark was not in use in commerce on or in connection with a good or service on or before the relevant date, but the Director shall retain discretion to determine whether a prima facie case is set out in a particular proceeding.

(3) Determination by Director

Any determination by the Director whether or not to institute a reexamination proceeding under this section shall be final and non-reviewable, and shall not prejudice any party’s right to raise any issue and rely on any evidence in any other proceeding, except as provided in subsection (j).

(c) Reexamination procedures

The procedures for reexamination shall be the same as the procedures established under section 1062(b) of this title except that the Director shall promulgate regulations establishing and governing a proceeding under this section, which may include regulations that—

(1) set response and extension times particular to this type of proceeding, which, notwithstanding section 1062(b)(3) of this title, need not be extendable to 6 months;
(2) set limits governing the timing and number of petitions filed for a particular registration or by a particular petitioner or real parties in interest; and
(3) define the relation of a reexamination proceeding under this section to other proceedings concerning the mark.

(f) Registrant’s evidence of use

A registrant’s documentary evidence of use shall be consistent with when a mark shall be deemed to be in use in commerce under the definition of “use in commerce” in section 1127 of this title, but shall not be limited in form to that of specimens as provided in section 1051(a) of this title.

(g) Examiner’s decision; order to cancel

For each good or service for which it is determined that the registration should not have issued because the mark was not in use in commerce on or before the relevant date, the examiner shall find that the registration should be cancelled for each such good or service. Unless overturned on review of the examiner’s decision, the Director shall issue an order cancelling the registration, in whole or in part, after the time for appeal has expired or any appeal proceeding has terminated.

(h) Reexamination by Director

(1) In general

The Director may, on the Director’s own initiative, institute an ex parte reexamination proceeding if the Director discovers information that supports a prima facie case of the mark having not been used in commerce on or in connection with some or all of the goods or services covered by the registration on or before the relevant date. The Director shall promptly notify the registrant of such determination, at which time reexamination shall proceed according to the same procedures established pursuant to subsection (e). If the Director determines, based on the Director’s own initiative, to institute an ex parte reexamination proceeding, the Director shall transmit or make available the information that formed the basis for that determination as part of the institution notice.

(2) Rule of construction

Nothing in this subsection shall be construed to limit any other authority of the Director.

(i) Time for institution

A petition for ex parte reexamination may be filed, or the Director may institute on the Director’s own initiative an ex parte reexamination proceeding, at any time not later than 5 years after the date of registration of a mark registered based on use in commerce.

(j) Limitation on later ex parte reexamination proceedings

(1) No co-pending proceedings

With respect to a particular registration, while an ex parte reexamination proceeding is pending, no later ex parte reexamination proceeding may be instituted with respect to the same goods or services that are the subject of a pending ex parte reexamination proceeding.

(2) Estoppel

With respect to a particular registration, for any goods or services previously subject to an instituted ex parte reexamination proceeding for which, in that proceeding, it was determined that the registrant had used the mark for particular goods or services before the relevant date, and the registration was not cancelled as to those goods or services, no further ex parte reexamination proceedings may be initiated as to those goods or services, regardless of the identity of the petitioner.

(k) Supplemental register

The provisions of subsection (b) apply, as appropriate, to registrations under section 1091 of this title. Nothing in this section shall be construed to limit the timing of a cancellation action under section 1092 of this title.


Statutory Notes and Related Subsidiaries

**Effective Date**

Section effective upon the expiration of the 1-year period beginning on Dec. 27, 2020, and applicable to any
mark registered before, on, or after that effective date, see section 225(p) of div Q of Pub. L. 116–260, set out as an Effective Date of 2020 Amendment note under section 1064 of this title.

REGULATIONS

Director required to issue regulations to carry out this section no later than 1 year after Dec. 27, 2020, see section 225(f) of Pub. L. 116–260, set out as a note under section 1066a of this title.

§ 1067. Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board

(a) In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

(b) The Trademark Trial and Appeal Board shall include the Director, Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and administrative trademark judges who are appointed by the Secretary of Commerce, in consultation with the Director.

(c) AUTHORITY OF THE SECRETARY.—The Secretary of Commerce may, in his or her discretion, deem the appointment of an administrative trademark judge who, before August 12, 2008, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative trademark judge.

(d) DEFENSE TO CHALLENGE OF APPOINTMENT.—It shall be a defense to a challenge to the appointment of an administrative trademark judge on the basis of the judge’s having been originally appointed by the Director that the administrative trademark judge so appointed was acting as a de facto officer.


Editorial Notes

PRIOR PROVISIONS


AMENDMENTS

2008—Subsec. (b). Pub. L. 110–313, §1(b)(1), inserted “Deputy Director of the United States Patent and Trademark Office” after “Director,” and substituted “appointed by the Secretary of Commerce, in consultation with the Director” for “appointed by the Director”.

Subsecs. (c), (d). Pub. L. 110–313, §1(b)(2), added subsecs. (c) and (d).

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

EFFECTIVE DATE OF 1980 AMENDMENT; BOARD MEMBERSHIP AS OF OCTOBER 15, 1980, UNAFFECTED

Pub. L. 96–455, §2, Oct. 15, 1980, 94 Stat. 2024, provided that: “This amendment [amending this section] shall become effective on the date of its enactment [Oct. 15, 1980]. Members of the Trademark Trial and Appeal Board on the date of enactment shall continue to be members under and in accordance with the provisions of section 17 of the Act of July 5, 1946, as amended [this section], in effect immediately preceding the date of enactment.”

EFFECTIVE DATE OF 1975 AMENDMENT


EFFECTIVE DATE OF 1958 AMENDMENT

Pub. L. 85–609, §3, Aug. 8, 1958, 72 Stat. 541, provided that: “This Act [amending this section and sections 1070, 1071, 1092, and 1113 of this title] shall take effect on approval [Aug. 8, 1958]; it shall apply to ex parte appeals taken to the Commissioner prior to the date of approval which have not been heard but shall not apply to any such appeal which has been heard or decided in which event further proceedings may be had as though this Act had not been passed; it shall apply to inter partes cases instituted prior to the date of approval which have not been heard by an examiner of inter-
ferences, but shall not apply to any such case which has been heard or decided by an examiner of interferences in which event further proceedings may be had as though this Act had not passed.’’

**Repeal and Effect on Existing Rights**

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

**Executive Documents**

**Transfer of Functions**

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1068. Action of Director in interference, opposition, and proceedings for concurrent use registration or for cancellation

In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings. The authority of the Director under this section includes the authority to reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board: Provided, That in the case of the registration, in whole or in part, of the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings, the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings. The authority of the Director under this section includes the authority to reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board:

**Editorial Notes**

**Prior Provisions**


**Amendments**

2003—Pub. L. 116–260 inserted ‘‘The authority of the Director under this section includes the authority to reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board’’ after ‘‘established in the proceedings’’.

1999—Pub. L. 106–113 substituted ‘‘Director’’ for ‘‘Commissioner’’ in two places.

1988—Pub. L. 100–667 substituted ‘‘the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register’’ for ‘‘or restrict’’, and ‘‘may refuse’’ for ‘‘or may refuse’’, and inserted provisions that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.

**Statutory Notes and Related Subsidiaries**

**Effective Date of 1999 Amendment**

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

**Effective Date of 1988 Amendment**

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

**Repeal and Effect on Existing Rights**

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

**Construction of 2020 Amendment**

Pub. L. 116–260, div. Q, title II, §228(b), Dec. 27, 2020, 154 Stat. 2210, provided that:

‘‘(1) Authority before date of enactment.—The amendments made by subsection (a) [amending this section and sections 1070 and 1092 of this title] shall not be construed to require the Director to reconsider, modify, or set aside any particular decision of the Trademark Trial and Appeal Board.

‘‘(2) Authority with respect to particular decisions.—The amendments made by subsection (a) shall not be construed to require the Director to reconsider, modify, or set aside any particular decision of the Trademark Trial and Appeal Board:

‘‘(Director’’ as used in section 228(b) of Pub. L. 116–260, set out above, means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, see section 222 of Pub. L. 116–260, set out as a note under section 1051 of this title.)

**Executive Documents**

**Transfer of Functions**

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1069. Application of equitable principles in inter partes proceedings

In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied.

§ 1070. Appeals to Trademark Trial and Appeal Board from decisions of examiners

An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks or a final decision by an examiner in an ex parte expungement proceeding or ex parte re-examination proceeding upon the payment of the prescribed fee. The Director may reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board under this section.


Editorial Notes

Prior Provisions


Amendments

2020—Pub. L. 116–260, § 228(a)(2), inserted “The Director may reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board under this section.” at end.

Pub. L. 116–260, § 225(d)(1), inserted “or a final decision by an examiner in an ex parte expungement proceeding or ex parte reexamination proceeding” after “registration of marks”.

1958—Pub. L. 85–609 substituted “Trademark Trial and Appeal Board” for “Commissioner in person” and “fee” for “fees”, and struck out “of interferences or” after “examiner in charge”.

Statutory Notes and Related Subsidiaries

Effective Date of 2020 Amendment

Amendment by section 225(d)(1) of div. Q of Pub. L. 116–260 effective upon the expiration of the 1-year period beginning on Dec. 27, 2020, and applicable to any mark registered before, on, or after that effective date, see section 225(p) of div. Q of Pub. L. 116–260, set out as a note under section 1064 of this title.

Effective Date of 1958 Amendment

For effective date and applicability of amendment by Pub. L. 85–609, see section 3 of Pub. L. 85–609, set out as a note under section 1067 of this title.

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1061 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1071. Appeal to courts

(a) Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure

(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 1058 of this title or section 1141k of this title, an applicant for renewal, or a registrant subject to an ex parte expungement proceeding or an ex parte re-examination proceeding, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a
civil action under subsection (b) of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(3) The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the United States Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the United States Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the United States Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Director, which shall be entered of record in the United States Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(b) Civil action; persons entitled to; jurisdiction of court; status of Director; procedure

(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit, except for a registrant subject to an ex parte expungement proceeding or an ex parte reexamination proceeding, is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(2) The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the United States Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the United States Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there are adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the Eastern District of Virginia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.


Editorial Notes

Codification

Pub. L. 93–596, which provided for the substitution of "Patent and Trademark Office" for "Patent Office" each time appearing in this chapter, became effective Jan. 2, 1975, as did Pub. L. 93–600, which in the course of amending subsec. (a)(3) and (4) of this section, referred merely to "Patent Office". "Patent and Trademark Office" has been substituted for "Patent Office" in subsec. (a)(3) and (4) on authority of Pub. L. 93–596.

Prior Provisions


Amendments

2020—Subsec. (a)(1). Pub. L. 116–260, § 225(d)(2)(A), substituted "an applicant for renewal, or a registrant sub-
ject to an ex parte expungement proceeding or an ex parte reexamination proceeding” for “or an applicant for renewal”.

Subsec. (b)(1). Pub. L. 116–260, § 225(b)(2)(B), inserted “, except for a registrant subject to an ex parte expungement proceeding or an ex parte reexamination proceeding,” before “is dissatisfied”.


1980—Subsec. (a)(1). Pub. L. 111–146, § 3(c)(3), inserted “or section 1141k of this title” after “section 1058 of this title”.


Subsec. (b)(4). Pub. L. 111–146, § 3(c)(1), (3), inserted “‘United States’ before ‘Patent and Trademark Office’, and substituted ‘If there are’ for ‘If there be’.


1988—Subsec. (a)(1). Pub. L. 100–667, § 129, made technical amendments to references in the original act to subsection (b) of this section resulting in no change in text, and substituted “paragraph (2) of this subsection” for “subsection (a)(2) of this section” and “action under subsection” for “action under said subsection”.

Subsec. (a)(4). Pub. L. 100–667, § 120, inserted provision that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.

Subsec. (b)(1). Pub. L. 100–667, § 120, made technical amendments to references in the original act to subsection (a) of this section resulting in no change in text and inserted provision that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.

Subsec. (b)(3). Pub. L. 100–667, § 120, amended first sentence generally. Prior to amendment, first sentence read as follows: “In all cases where there is no adverse party, a copy of the complaint shall be served on the Commissioner; and all the expenses of the proceedings shall be paid by the party bringing them, whether the final decision is in his favor or not.”

1984—Subsec. (a)(2). Pub. L. 98–620 substituted provisions requiring the appellant to file a written notice of appeal in the Patent and Trademark Office directed to the Commissioner for provisions requiring the appellant to file the notice of appeal with the Commissioner, and struck out provision which required the notice of appeal to specify the party or parties taking the appeal, to designate the decision or part thereof appealed from, and to state that the appeal was being taken to the United States Court of Appeals for the Federal Circuit.

Subsec. (a)(3). Pub. L. 98–620 substituted provisions requiring the Commissioner to transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office for provisions which required the Commissioner to transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant, and any additional papers and evidence specified by the appellant, and inserted provision that the court may request that the Commissioner forward the original or certified copies of such documents during the pendency of the appeal.

Subsec. (a)(4). Pub. L. 98–620 substituted provisions requiring the court to review the decision from which the appeal is taken on the record before the Patent and Trademark Office, and, upon its determination, to issue its mandate and opinion for provisions which required the court to decide such appeal on the evidence produced before the Patent and Trademark Office and to return to the Commissioner a certificate of its proceedings and decision.


1975—Subsec. (a)(2). Pub. L. 93–600 substituted provisions relating to filing of notice of appeal with the Commissioner and the contents of such notice of appeal, for provisions relating to giving notice of appeal to the Commissioner and requiring filing in the Patent Office reasons for appeal.

Subsec. (a)(3). Pub. L. 93–600 inserted provision requiring the Commissioner to furnish the court with a brief explaining the grounds of the decision of the Office.


Subsec. (a)(4). Pub. L. 93–600 substituted “decide” for “hear and determine” and struck out “Upon its determination,” before “the court shall return” and provision requiring the decision to be confined to the points set forth in the reasons of appeal.


1962—Pub. L. 87–772 amended section generally, and among other changes, incorporated with necessary changes in language, the various provisions of Title 35, Patents, relating to the procedure of appeals to the Court of Customs and Patent Appeals and review by civil action in patent cases, which had previously been incorporated by reference only.

1958—Pub. L. 85–609 authorized appeals by persons dissatisfied with the decision of the Trademark Trial and Appeal Board, and substituted “Trademark Trial and Appeal Board” for ‘‘Commissioner” in proviso.


Statutory Notes and Related Subsidiaries

Effective Date of 2020 Amendment

Amendment by Pub. L. 116–260 effective upon the expiration of the 1-year period beginning on Dec. 27, 2020, and applicable to any mark registered before, on, or after that effective date, see section 218(k) of div. Q of Pub. L. 116–260, set out as a note under section 1064 of this title.

Effective Date of 2011 Amendment

Pub. L. 112–29, § 9(b), Sept. 16, 2011, 125 Stat. 316, provided that: “The amendments made by this section (amending this section and sections 123, 145, 146, 154, and 293 of Title 35, Patents) shall take effect on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any civil action commenced on or after that date.”

Effective Date of 1999 Amendment

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1984 Amendment

Amendment by Pub. L. 98–620 applicable to proceedings pending in the Patent and Trademark Office on Nov. 8, 1984, and to appeals pending in the United States Court of Appeals for the Federal Circuit on that date, see section 414(c) of Pub. L. 98–620, set out as a note under section 142 of Title 35, Patents.
§ 1072. Registration as constructive notice of claim of ownership

Registration of a mark on the principal register provided by this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, shall be constructive notice of the registrant’s claim of ownership thereof.

(July 5, 1946, ch. 549, title I, §22, 60 Stat. 435.)

Executive Documents

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1089. Supplemental register

(a) Marks registrable

In addition to the principal register, the Director shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled “An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes”, to be called the supplemental register. All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register provided in this chapter, except those declared to be unregistrable under subsections (a), (b), (c), (d), and (e)(3) of section 1052 of this title, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1051 of this title so far as they are applicable. Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before December 8, 1993.

(b) Application and proceedings for registration

Upon the filing of an application for registration on the supplemental register and payment of the prescribed fee the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the applicant is found not entitled to registration the provisions of subsection (b) of section 1062 of this title shall apply.

(c) Nature of mark

For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant’s goods or services.

(July 5, 1946, ch. 549, title II, §23, 60 Stat. 435; Pub. L. 85–609, set out as a note under section 1064 of this title.)
§ 1092 TITLE 15—COMMERCE AND TRADE Page 1270

July 5, 1946, ch. 540, § 46(a), 60 Stat. 444, insofar as inconsistent.

Prior Provisions


Amendments


Pub. L. 106–43 substituted “trademarks” for “trade-marks”.

Subsec. (b). Pub. L. 106–113 substituted “Commissioner” for “Director”.

1995—Subsec. (a). Pub. L. 104–330 substituted “device, any matter that as a whole is not functional,” for “or device”.

1993—Subsec. (a). Pub. L. 103–182 substituted “(d), and (e)(3)” for “(d)” and inserted at end “Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, or in connection with any goods or services, since before December 8, 1993.”

1988—Pub. L. 100–667, § 121(6), struck out undesignated concluding par. which read as follows: “Upon a proper showing by the applicant that he requires domestic registration as a basis for foreign protection of his mark, the Commissioner may waive the requirement of a full year’s use and may grant registration forthwith.”

Subsec. (a). Pub. L. 100–667, § 121(1), (4), designated first par. as subsec. (a), made technical amendment to reference in the original act to subsections (a), (b), (c), and (d) of section 1052 of this title resulting in no change in text, substituted “are in lawful use in commerce by the proprietor thereof,” on “have been in lawful use in commerce by the owner thereof, on” for “have been in lawful use in commerce by the proprietor thereof, upon”, struck out “for the year preceding the filing of the application” after “any goods and services”, and inserted “subsections (a) and (e)” of before “section 1051”.

Subsec. (b). Pub. L. 100–667, § 121(2), (5), designated second par. as subsec. (b) and substituted “prescribed fee” for “fee herein provided”.


1962—Pub. L. 87–772 struck out “has begun the lawful use of his mark in foreign commerce and that he before ‘requires domestic registration’ in last par.

Statutory Notes and Related Subsidiaries

Effective Date of 1999 Amendment

Amendment by Pub. L. 106–113 effective 4 months after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1998 Amendment

Amendment by Pub. L. 106–113 effective August 9, 1998, see section 105(b) of Title IV, § 4731 of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1996 Amendment

Amendment by Pub. L. 104–330 applicable only to trademark applications filed on or after Dec. 8, 1992, see section 335(c) of Pub. L. 103–182, formerly set out in a note under section 1052 of this title.

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1092. Publication; not subject to opposition; cancellation

Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that such person is or will be damaged by the registration of a mark on the supplemental register—

(1) for which the effective filing date is after the date on which such person’s mark became famous and which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title; or

(2) on grounds other than dilution by blurring or dilution by tarnishment, such person may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. The Director shall refer such application to the Trademark Trial and Appeal Board which shall give notice thereof to the registrant. If it is found after a hearing before the Board that the registrant is not entitled to registration, or that the mark has been abandoned, the registration shall be canceled by the Director, unless the Director reconsiders the decision of the Board, and modifies or sets aside, such decision. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.


Editorial Notes

Prior Provisions

$1094

Reorganization Plan No. 5 of 1950 Amendment by Pub. L. 85–609 as subject to Reorganization Plan No. 5 of 1950, see note set out under section 1067 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§1093. Registration certificates for marks on principal and supplemental registers to be different

The certificates of registration for marks registered on the supplemental register shall be conspicuously different from certificates issued for marks registered on the principal register.

(July 5, 1946, ch. 540, title II, §25, 60 Stat. 436.)

Statutory Notes and Related Subsidiaries

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§1094. Provisions of chapter applicable to registrations on supplemental register

The provisions of this chapter shall govern so far as applicable applications for registration and registrations on the supplemental register as well as those on the principal register, but applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 1051(b), 1052(e), 1052(f), 1057(b), 1057(c), 1062(a), 1063 to 1068, inclusive, 1072, 1115 and 1124 of this title. Registrations on the supplemental register shall be subject to ex parte expungement and ex parte reexamination under sections 1066a and 1066b of this title, respectively.


Editorial Notes

Prior Provisions


Amendments

2020—Pub. L. 116–260 inserted “Registrations on the supplemental register shall be subject to ex parte expungement and ex parte reexamination under sections 1066a and 1066b of this title, respectively.” at end. 1998—Pub. L. 105–330 substituted “’1057(c),’” for “’1057(c),’”.

1988—Pub. L. 100–667 inserted reference to sections 1051(b) and 1057(c).
§ 1095. Registration on principal register not precluded

Registration of a mark on the principal register or under the Act of March 19, 1920, shall not preclude registration by the registrant on the principal register established by this chapter. Registration of a mark on the principal register shall not constitute an admission that the mark has not acquired distinctiveness.


Editorial Notes

REFERENCES IN TEXT

Act of March 19, 1920, referred to in text, is act Mar. 19, 1920, ch. 194, §§1-9, 41 Stat. 333, which was generally classified to sections 121 to 128 of this title, and which was repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(a), 60 Stat. 444.

AMENDMENTS

1988—Pub. L. 100-667 inserted at end “Registration of a mark on the supplemental register shall not constitute an admission that the mark has not acquired distinctiveness.”

§ 1096. Registration on supplemental register not used to stop importations

Registration on the supplemental register or under the Act of March 19, 1920, shall not be filed in the Department of the Treasury or be used to stop importations.

(July 5, 1946, ch. 540, title II, §28, 60 Stat. 436.)

Editorial Notes

REFERENCES IN TEXT

Act of March 19, 1920, referred to in text, is act Mar. 19, 1920, ch. 194, §§1-9, 41 Stat. 333, which was generally classified to sections 121 to 128 of this title, and which was repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(b), 60 Stat. 444.

§ 1111. Notice of registration; display with mark; recovery of profits and damages in infringement suit

Notwithstanding the provisions of section 1072 of this title, a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words “Registered in U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.” or the letter R encircled within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this chapter unless the defendant had actual notice of the registration.


Editorial Notes

PRIOR PROVISIONS


AMENDMENTS

1988—Pub. L. 100-667 struck out “as used” after “with the mark”.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words ‘Registered in U.S. Patent and Trademark Office’ or ‘Reg. U.S. Pat. & Tm. Off.’ or ‘Reg. U.S. Pat. Off.’” for “Patent Office, may give notice that his mark is registered by displaying with the mark the words ‘Registered in U.S. Patent Office’ or ‘Reg. U.S. Pat. Off.’”.

1962—Pub. L. 87-772 substituted “in the Patent Office, may for “under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register established by this chapter, shall”, and “to give such notice of registration,” for “so to mark goods bearing the registered mark, or by a registrant under the Act of March 19, 1920, or by the registrant of a mark on the supplemental register provided by this chapter”.

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2020 AMENDMENT

Amendment by Pub. L. 116-260 effective upon the expiration of the 1-year period beginning on Dec. 27, 2020, and applicable to any mark registered before, on, or after that effective date, see section 223(g) of div. Q of Pub. L. 116-260, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1998 AMENDMENT

Amendment by Pub. L. 105-330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 203(a)(1) of Pub. L. 105-330, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Statutory Notes and Related Subsidiaries

SUBCHAPTER III—GENERAL PROVISIONS

EFFECT ON PROVISIONS IN STATUTES

Statutory Notes and Related Subsidiaries

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1975 Amendment

Pub. L. 93–596, § 4, Jan. 2, 1975, 88 Stat. 489, provided that: ‘‘This Act [amending this section, sections 1051, 1052, 1057, 1058, 1060, 1062, 1063, 1065, 1067, 1069, 1071, 1092, 1112, 1113, 1116 to 1120, 1123, and 1127 of this title, and sections 2 to 4, 6 to 8, 10, 11, 21 to 29, 31 to 33, 41, 104, 119, 121, 122, 135, 142 to 144, 146, 152, 153, 253 to 255, 261, 288, and 293 of Title 35, Patents, and enacting provisions set out as a note under section 1 of Title 35] shall become effective upon enactment [Jan. 2, 1975]. However, any registrant may continue to give notice of his registration in accordance with section 29 of the Trademark Act of 1946 (60 Stat. 427), as amended Oct. 9, 1962 (76 Stat. 769) [this section], as an alternative to notice in accordance with section 29 of the Trademark Act as amended by section 2 of this Act, regardless of whether his mark was registered before or after the effective date of this Act.’’

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§ 1112. Classification of goods and services; registration in plurality of classes

The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant’s or registrant’s rights. The applicant may apply to register a mark for any or all of the goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce; Provided, That if the Director by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid, and the Director may issue a single certificate of registration for such mark.


Editorial Notes

Prior Provisions


Amendments


1988—Pub. L. 100–667 inserted ‘‘or registrant’s’’ after ‘‘applicant’s’’ and substituted ‘‘may apply for’’ for ‘‘may file an application’’, ‘‘goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce’’, ‘‘goods and services upon or in connection with which he is actually using the mark’’, and ‘‘Provided, That if the Commissioner by regulation permits the filing of an application for the registration of a mark for goods or services which fall’’ for ‘‘Provided, That when such goods or services fall’’.


1962—Pub. L. 87–772, among other changes, substituted ‘‘may’’ for ‘‘shall’’.

Statutory Notes and Related Subsidiaries

Effective Date of 1999 Amendment

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731(b)(1)(B)] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1975 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1113. Fees

(a) Applications; services; materials

The Director shall establish fees for the filing and processing of an application for the registration of a trademark or other mark and for all other services performed by and materials furnished by the Patent and Trademark Office related to trademarks and other marks. Fees established under this subsection may be adjusted by the Director once each year to reflect, in the aggregate, any fluctuations during the preceding 12 months in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 percent may be ignored. No fee established under this section shall take effect until at least 30 days after notice of the fee has been published in the Federal Register and in the Official Gazette of the Patent and Trademark Office.

(b) Waiver; Indian products

The Director may waive the payment of any fee for any service or material related to trademark or other marks in connection with an occasional request made by a department or agency of the Government, or any officer thereof. The Indian Arts and Crafts Board will not be charged any fee to register Government trademarks of genuineness and quality for Indian products or for products of particular Indian tribes and groups.

Editorial Notes

Prior Provisions


Amendments


1991—Subsec. (a). Pub. L. 102–204 amended subsec. (a) generally. Prior to amendment, subsec. (a) read as follows: “The Commissioner will establish fees for the filing and processing of an application for the registration of a trademark or other mark and for all other services performed by and materials furnished by the Patent and Trademark Office related to trademarks and other marks. However, no fee for the filing or processing of an application for the registration of a trademark or other mark or for the renewal or assignment of a trademark or other mark will be adjusted more than once every three years. No fee established under this section will take effect prior to sixty days following notice in the Federal Register.”


Pub. L. 97–247 struck out provisions directing that fees be set and adjusted by the Commissioner to cover in aggregate 50 per centum of the estimated average cost to the Office of processing and that fees for all other services or materials related to trademarks and other marks recover the estimated average cost to the Office of performing the service or furnishing the material.

1961—Subsec. (a). Pub. L. 96–517 in revising fee provisions required the Commissioner to establish fees based on recovery of estimated average cost of processing applications, performing services and providing material; authorized triennial adjustments; and prescribed an effective date for fees; deleted prior provisions containing statutory schedule covering fees for filing; applications for registration and renewals, affidavits, revival petitions for abandoned applications, opposition or application for cancellation, disclaimers, and notice of benefits for a mark to be published; and fees covering: appeals from examiners in charge of registering a mark, see section 201(b) of Pub. L. 105–330, set out as a note under title 35, Patents.

1958—Pub. L. 85–609 struck out “to the Commissioner” after “on appeal from an examiner in charge of the registration of marks”, and provisions which required payment of a $25 fee on appeals from an examiner in charge of interferences to the Commissioner.

Statutory Notes and Related Subsidiaries

Effective Date of 1999 Amendment

Effective Date of 1998 Amendment
Amendment by Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

Effective Date of 1982 Amendment

Effective Date of 1980 Amendment
Amendment by Pub. L. 96–517 effective Dec. 12, 1980, with provision for continuation of fees in effect as of such date until corresponding fees are established under this section, see section 8(a), (d) of Pub. L. 96–517, set out as a note under section 41 of Title 35, Patents.

Effective Date of 1975 Amendment

Effective Date of 1965 Amendment
For effective date and applicability of amendment by Pub. L. 89–83, see section 7(a), (d) of Pub. L. 89–83, set out as a note under section 41 of Title 35, Patents.

Effective Date of 1958 Amendment
For effective date and applicability of amendment by Pub. L. 85–609, see section 3 of Pub. L. 85–609, set out as a note under section 1067 of this title.

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations
and rights under prior acts, see notes set out under sec-

APPROPRIATIONS AND FEES AUTHORIZED TO BE CARRIED OVER

For provisions authorizing fees collected under this chapter, and certain appropriations, to remain available until expended, see section 2 of Pub. L. 99–607, set out as a note under section 52 of Title 35, Patents.

TRADEMARK FEES


Pub. L. 103–179, § 4, Dec. 3, 1993, 107 Stat. 2040, provided that: “Effective on the date of the enactment of this Act (Dec. 3, 1993), the fee under section 31(a) of the Trademark Act of 1946 (15 U.S.C. 1113(a)) for filing an application for the registration of a trademark shall be $245. Any adjustment of such fee under the second sentence of such section may not be effective before October 1, 1994.”

Pub. L. 102–204, §5(f)(2), Dec. 10, 1991, 105 Stat. 1640, provided that fees established by Commissioner of Patents and Trademarks under 15 U.S.C. 1113(a) during fiscal year 1992 could reflect fluctuations during the preceding 3 years in the Consumer Price Index and could take effect on or after 1 day after such fees are published in the Federal Register and that the last sentence of 31 U.S.C. 31(a) and 5 U.S.C. 553 did not apply to the establishment of such fees.

Similar provisions were contained in the following prior appropriation acts:


REORGANIZATION PLAN NO. 5 OF 1950

Amendment by Pub. L. 85–609 as subject to Reorgani-

ization Plan No. 5 of 1950, see note set out under sec-

tion 1067 of this title.

Executive Documents

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appen-
dix to Title 5, Government Organization and Employ-

ees.

§ 1114. Remedies; infringement; innocent infringe-

ment by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeits, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive;

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term “any person” includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(2) Notwithstanding any other provision of this chapter, the remedies given to the owner of a right infringed under this chapter or to a person bringing an action under section 1125(a) or (d) of this title shall be limited as follows:

(A) Where an infringer or violator is engaged solely in the business of printing the mark or violating matter for others and establishes that he or she was an innocent infringer or innocent violator, the owner of the right infringed or person bringing the action under section 1125(a) or (d) of this title shall be limited as against such infringer or violator only to an injunction against future printing.

(B) Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication as defined in section 2510(12) of title 18, the remedies of the owner of the right infringed or person bringing the action under section 1125(a) of this title shall be limited as against such infringer or violator only to an injunction against future printing.

(C) Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication shall be limited to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.

(D) Injunctive relief shall not be available to the owner of the right infringed or person bringing the action under section 1125(a) of this title with respect to an issue of a newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter where re-
straining the dissemination of such infringing matter or violating matter in any particular issue of such periodical or in an electronic communication would delay the delivery of such issue or transmission of such electronic communication after the regular time for such delivery or transmission, and such delay would be due to the method by which publication and distribution of such periodical or transmission of such electronic communication is customarily conducted in accordance with sound business practice, and not due to any method or device adopted to evade this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter or violating matter.

(D)(i)(I) A domain name registrar, a domain name registry, or other domain name registration authority that takes any action described under clause (ii) affecting a domain name shall not be liable for monetary relief or, except as provided in subclause (II), for injunctive relief, to any person for such action, regardless of whether the domain name is finally determined to infringe or dilute the mark.

(ii) A domain name registrar, domain name registry, or other domain name registration authority described in subclause (I) may be subject to injunctive relief only if such registrar, registry, or other registration authority has—

(aa) not expeditiously deposited with a court, in which an action has been filed regarding the disposition of the domain name, documents sufficient for the court to establish the court’s control and authority regarding the disposition of the registration and use of the domain name;

(bb) transferred, suspended, or otherwise modified the domain name during the pendency of the action, except upon order of the court;

(cc) willfully failed to comply with any such court order.

(iii) An action referred to under clause (i)(I) is any action of refusing to register, removing from registration, transferring, temporarily disabling, or permanently canceling a domain name—

(I) in compliance with a court order under section 1125(d) of this title; or

(II) in the implementation of a reasonable policy by such registrar, registry, or authority prohibiting the registration of a domain name that is identical to, confusingly similar to, or dilutive of another’s mark.

(iv) A domain name registrar, a domain name registry, or other domain name registration authority shall not be liable for damages under this section for the registration or maintenance of a domain name for another absent a showing of bad faith intent to profit from such registration or maintenance of the domain name.

(v) If a registrar, registry, or other registration authority takes an action described under clause (ii) based on a knowing and material misrepresentation by any other person that a domain name is identical to, confusingly similar to, or dilutive of a mark, the person making the knowing and material misrepresentation shall be liable for any damages, including costs and attorney’s fees, incurred by the domain name registrant as a result of such action. The court may also grant injunctive relief to the domain name registrant, including the reactivation of the domain name or the transfer of the domain name to the domain name registrant.

(E) As used in this paragraph—

(i) the term “violator” means a person who violates section 1125(a) of this title; and

(ii) the term “violating matter” means matter that is the subject of a violation under section 1125(a) of this title.

(3)(A) Any person who engages in the conduct described in paragraph (11) of section 110 of title 17 and who complies with the requirements set forth in that paragraph is not liable on account of such conduct for a violation of any right under this chapter. This subparagraph does not preclude liability, nor shall it be construed to restrict the defenses or limitations on rights granted under this chapter, of a person for conduct not described in paragraph (11) of section 110 of title 17, even if that person also engages in conduct described in paragraph (11) of section 110 of such title.

(B) A manufacturer, licensee, or licensor of technology that enables the making of limited portions of audio or video content of a motion picture imperceptible as described in subparagraph (A) is not liable on account of such manufacture or license for a violation of any right under this chapter, if such manufacturer, licensee, or licensor ensures that the technology provides a clear and conspicuous notice at the beginning of each performance that the performance intended by the director or copyright holder of the motion picture. The limitations on liability in subparagraph (A) and this subparagraph shall not apply to a manufacturer, licensee, or licensor of technology that fails to comply with this paragraph.

(C) The requirement under subparagraph (B) to provide notice shall apply only with respect to technology manufactured after the end of the 180-day period beginning on April 27, 2005.

(D) Any failure by a manufacturer, licensee, or licensor of technology to qualify for the exemption under subparagraphs (A) and (B) shall not be construed to create an inference that such party that engages in conduct described in paragraph (11) of section 110 of title 17 is liable for trademark infringement by reason of such conduct.


(a) Evidentiary value; defenses

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b), which might have been asserted if such mark had not been registered.

(b) Incontestability; defenses

To the extent that the right to use the registered mark has become incontestable under
section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations stated therein except when one of the following defenses or defects is established: 

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or 

(2) That the mark has been abandoned by the registrant; or 

(3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or 

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or 

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant’s prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: Provided, however, That this defense or defect shall apply only for the area in which such continuous prior use is proved; or 

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: Provided, however, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant’s mark: or 

(7) That the mark has been or is being used to violate the antitrust laws of the United States; or 

(8) That the mark is functional; or 

(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable. 

(4) That the use of the name, term, or device charged as an infringement was adopted with such geographic origin; or 

(6) That the mark whose use is charged as an infringement was adopted with-
"(a) or" before "(c) of section 1062". "only where the said mark has been published pursuant to subsections (c) of section 1062 of this title and shall apply" after "defect shall apply", and "under subsection (a) or (c) of section 1062 of this title" after "registrant's mark", in par. (6).

**Statutory Notes and Related Subsidiaries**

**Effective Date of 1998 Amendment**

Amendment by Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

**Effective Date of 1988 Amendment**

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 105–330, set out as a note under section 1051 of this title.

**Repeal and Effect on Existing Rights**

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§ 1116. Injunctive relief

(a) Jurisdiction; service

The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c), or (d) of section 1125 of this title. A plaintiff seeking any such injunction shall be entitled to a rebuttable presumption of irreparable harm upon a finding of a violation identified in this subsection in the case of a motion for a permanent injunction or upon a finding of likelihood of success on the merits for a violation identified in this subsection in the case of a motion for a preliminary injunction or temporary restraining order. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States district court in whose jurisdiction the defendant may be found.

(b) Transfer of certified copies of court papers

The said courts shall have jurisdiction to enforce said injunction, as provided in this chapter, as fully as if the injunction had been granted by the district court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all papers on file in his office upon which said injunction was granted.

(c) Notice to Director

It shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding involving a mark registered under the provisions of this chapter to give notice thereof in writing to the Director setting forth in order so far as known the names and addresses of the litigants and the designating number or numbers of the registration or registrations upon which the action, suit, or proceeding has been brought, and in the event any other registration be subsequently included in the action, suit, or proceeding by amendment, answer, or other pleading, the clerk shall give like notice thereof to the Director, and within one month after the judgment is entered or an appeal is taken the clerk of the court shall give notice thereof to the Director, and it shall be the duty of the Director on receipt of such notice forthwith to endorse the same upon the file wrapper of the said registration or registrations and to incorporate the same as a part of the contents of said file wrapper.

(d) Civil actions arising out of use of counterfeit marks

(1)(A) In the case of a civil action arising under section 1114(1)(a) of this title or section 220506 of title 36 with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order under subsection (a) of this section pursuant to this subsection providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.

(B) As used in this subsection the term "counterfeit mark" means—

(i) a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered; or

(ii) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of this chapter are made available by reason of section 220506 of title 36;

but such term does not include any mark or designation used on or in connection with goods or services of which the manufacture 1 or producer was, at the time of the manufacture or production in question authorized to use the mark or designation for the type of goods or services so manufactured or produced, by the holder of the right to use such mark or designation.

(2) The court shall not receive an application under this subsection unless the applicant has

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1 So in original. Probably should be "manufacturer".
given such notice of the application as is reason-
able under the circumstances to the United
States attorney for the judicial district in which
such order is sought. Such attorney may partici-
pate in the proceedings arising under such appli-
cation if such proceedings may affect evidence
of an offense against the United States. The
court may deny such application if the court
determines that the public interest in a potential
prosecution so requires.

(3) The application for an order under this sub-
section shall—
(A) be based on an affidavit or the verified
complaint establishing facts sufficient to sup-
port the findings of fact and conclusions of law
required for such order; and
(B) contain the additional information re-
quired by paragraph (5) of this subsection to be
set forth in such order.

(4) The court shall not grant such an applica-
tion unless—
(A) the person obtaining an order under this
subsection provides the security determined
adequate by the court for the payment of such
damages as any person may be entitled to re-
cover as a result of a wrongful seizure or
wrongful attempted seizure under this subsec-
tion; and
(B) the court finds that it clearly appears
from specific facts that—
(i) an order other than an ex parte seizure
order is not adequate to achieve the pur-
poses of section 1114 of this title;
(ii) the applicant has not publicized the re-
quested seizure;
(iii) the applicant is likely to succeed in
showing that the person against whom sei-
zure would be ordered used a counterfeit
mark in connection with the sale, offering
for sale, or distribution of goods or services;
(iv) an immediate and irreparable injury
will occur if such seizure is not ordered;
(v) the matter to be seized will be located
at the place identified in the application;
(vi) the harm to the applicant of denying
the application outweighs the harm to the
legitimate interests of the person against
whom seizure would be ordered of granting
the application; and
(vii) the person against whom seizure
would be ordered, or persons acting in con-
cert with such person, would destroy, move,
hide, or otherwise make such matter inac-
cessible to the court, if the applicant were to
proceed on notice to such person.

(5) An order under this subsection shall set
forth—
(A) the findings of fact and conclusions of
law required for the order;
(B) a particular description of the matter to
be seized, and a description of each place at
which such matter is to be seized;
(C) the time period, which shall end not
later than seven days after the date on which
such order is issued, during which the seizure
is to be made;
(D) the amount of security required to be
provided under this subsection; and
(E) a date for the hearing required under
paragraph (10) of this subsection.

(6) The court shall take appropriate action to
protect the person against whom an order under
this subsection is directed from publicity, by or
at the behest of the plaintiff, about such order
and any seizure under such order.

(7) Any materials seized under this subsection
shall be taken into the custody of the court. For
seizures made under this section, the court shall
enter an appropriate protective order with re-
spect to discovery and use of any records or in-
formation that has been seized. The protective
order shall provide for appropriate procedures to
ensure that confidential, private, proprietary, or
privileged information contained in such records
is not improperly disclosed or used.

(8) An order under this subsection, together
with the supporting documents, shall be sealed
until the person against whom the order is di-
rected has an opportunity to contest such order,
except that any person against whom such order
is issued shall have access to such order and sup-
porting documents after the seizure has been
carried out.

(9) The court shall order that service of a copy
of the order under this subsection shall be made
by a Federal law enforcement officer (such as a
United States marshal or an officer or agent of
the United States Customs Service, Secret Ser-
vice, Federal Bureau of Investigation, or Post Of-
fice) or may be made by a State or local law en-
forcement officer, who, upon making service,
shall carry out the seizure under the order. The
court shall issue orders, when appropriate, to
protect the defendant from undue damage from
the disclosure of trade secrets or other confiden-
tial information during the course of the sei-
zure, including, when appropriate, orders re-
stricting the access of the applicant (or any
agent or employee of the applicant) to such se-
crets or information.

(10)(A) The court shall hold a hearing, unless
waived by all the parties, on the date set by the
court in the order of seizure. That date shall be
not sooner than ten days after the order is
issued and not later than fifteen days after the
order is issued, unless the applicant for the
order shows good cause for another date or un-
less the party against whom such order is di-
rected consents to another date for such hear-
ing. At such hearing the party obtaining the
order shall have the burden to prove that the
facts supporting findings of fact and conclusions
of law necessary to support such order are still
in effect. If that party fails to meet that burden,
the seizure order shall be dissolved or modified
appropriately.

(B) In connection with a hearing under this
paragraph, the court may make such orders
modifying the time limits for discovery under
the Rules of Civil Procedure as may be nec-
essary to prevent the frustration of the purposes
of such hearing.

(11) A person who suffers damage by reason of
a wrongful seizure under this subsection has a
cause of action against the applicant for the
order under which such seizure was made, and
shall be entitled to recover such relief as may be
appropriate, including damages for lost profits,
cost of materials, loss of good will, and punitive
damages in instances where the seizure was
sought in bad faith, and, unless the court finds
extenuating circumstances, to recover a reasonable attorney's fee. The court in its discretion may award prejudgment interest on relief recovered under this paragraph, at an annual interest rate established under section 6621(a)(2) of title 26—commencing on the date of service of the claimant's pleading setting forth the claim under this paragraph and ending on the date such recovery is granted, or for such shorter time as the court deems appropriate.


Editorial Notes

REFERENCES IN TEXT


PRIOR PROVISIONS


AMENDMENTS

2020—Subsec. (a). Pub. L. 116–260 inserted after first sentence “A plaintiff seeking any such injunction shall be entitled to a rebuttable presumption of irreparable harm upon a finding of a violation identified in this subsection in the case of a motion for a permanent injunction or upon a finding of likelihood of success on the merits for a violation identified in this subsection in the case of a motion for a preliminary injunction or temporary restraining order.”

2008—Subsec. (d)(7). Pub. L. 110–403 amended par. (7) generally. Prior to amendment, par. (7) read as follows: “Any materials seized under this subsection shall be taken into the custody of the court. The court shall enter an appropriate protective order with respect to discovery by the applicant of any records that have been seized. The protective order shall provide for appropriate procedures to assure that confidential information contained in such records is not improperly disclosed to the applicant.”


1999—Subsec. (a), Pub. L. 106–113, § 1000(a)(9) [title III, § 3003(a)(1)], substituted “(a), (c), or (d)” for “(a) or (c)” in first sentence.

Pub. L. 106–43 substituted “subsection (a) or (c) of section 1125 of this title” for “subsection (a) of this title” in first sentence.


1996—Subsec. (d)(9). Pub. L. 104–153 inserted first sentence and struck out former first sentence which read as follows: “The court shall order that a United States marshal or other law enforcement officer is to serve a copy of the order under this subsection and then is to carry out the seizure under such order.”

1988—Subsec. (a), Pub. L. 100–667, § 128(c), inserted “or to prevent a violation under section 1125(a) of this title” after “Office” in first sentence.

Subsec. (c). Pub. L. 100–667, § 128(d), substituted “proceeding involving a mark registered” for “proceeding arising” and “judgment is entered or an appeal is taken” for “decision is rendered, appeal taken or a decision issued”.

Subsec. (d)(1)(B). Pub. L. 100–667, § 128(e), inserted “on or after” after “or designation used” in concluding provisions.

1984—Pub. L. 98–473 designated first, second, and third undesignated pars. as subssecs. (a), (b), and (c), respectively, and added subsec. (d).


Statutory Notes and Related Subsidaries

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title III, § 3003(a)(1)] of Pub. L. 106–113 applicable to all domain names registered before, on, or after Nov. 29, 1999, see section 1000(a)(9) [title III, § 3010] of Pub. L. 106–113, set out as a note under section 1117 of this title.

Amendment by section 1000(a)(9) [title IV, § 4732(b)(1)(B)] of Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT


REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

CONSTRUCTION OF 2020 AMENDMENT

Pub. L. 116–260, div. Q, title II, § 226(b), Dec. 27, 2020, 134 Stat. 2208, provided that: “The amendment made by subsection (a) [amending this section] shall not be construed to mean that a plaintiff seeking an injunction was not entitled to a presumption of irreparable harm before the date of enactment of this Act [Dec. 27, 2020].”

TRANSFER OF FUNCTIONS

For transfer of functions, personnel, assets, and liabilities of the United States Customs Service of the Department of the Treasury, including functions of the Secretary of the Treasury relating thereto, to the Secretary of Homeland Security, and for treatment of related references, see sections 203(1), 551(d), 552(d), and 557 of Title 6, Domestic Security, and the Department of Homeland Security Reorganization Plan of November 25, 2002, as modified, set out as a note under section 542 of Title 6. For establishment of U.S. Customs and Border Protection in the Department of Homeland Security, treated as if included in Pub. L. 107–296 as of Nov. 25, 2002, see section 211 of Title 6, as amended generally by Pub. L. 114–125, and section 802(b) of Pub. L. 114–125, set out as a note under section 211 of Title 6.
§ 1117

TITLE 15—COMMERCE AND TRADE

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§ 1117. Recovery for violation of rights

(a) Profits; damages and costs; attorney fees

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant’s profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant’s sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(b) Treble damages for use of counterfeit mark

In assessing damages under subsection (a) for any violation of section 1114(1)(a) of this title or section 220506 of title 36, in a case involving use of a counterfeit mark or designation (as defined in section 1116(d) of this title), the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever amount is greater, together with a reasonable attorney’s fee, if the violation consists of—

(1) intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, offering for sale, or distribution of goods or services; or

(2) providing goods or services necessary to the commission of a violation specified in paragraph (1), with the intent that the recipient of the goods or services would put the goods or services to use in committing the violation.

In such a case, the court may award prejudgment interest on such amount at an annual interest rate established under section 6621(a)(2) of title 26, beginning on the date of the service of the claimant’s pleadings setting forth the claim for such entry of judgment and ending on the date such entry is made, or for such shorter time as the court considers appropriate.

(c) Statutory damages for use of counterfeit marks

In a case involving the use of a counterfeit mark (as defined in section 1116(d) of this title) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a), an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services in the amount of—

(1) not less than $1,000 or more than $200,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or

(2) if the court finds that the use of the counterfeit mark was willful, not more than $2,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.

(d) Statutory damages for violation of section 1125(d)(1)

In a case involving a violation of section 1125(d)(1) of this title, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statutory damages in the amount of not less than $1,000 and not more than $100,000 per domain name, as the court considers just.

(e) Rebuttable presumption of willful violation

In the case of a violation referred to in this section, it shall be a rebuttable presumption that the violation is willful for purposes of determining relief if the violator, or a person acting in concert with the violator, knowingly provided or knowingly caused to be provided materially false contact information to a domain name registrar, domain name registry, or other domain name registration authority in registering, maintaining, or renewing a domain name in connection with the violation. Nothing in this subsection limits what may be considered a willful violation under this section.


Editorial Notes

Prior Provisions


Amendments

2008—Subsec. (b), Pub. L. 110-403, §103, amended subsec. (b) generally. Prior to amendment, text read as follows: “In assessing damages under subsection (a) of this section, the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever is greater, together with a reasonable attorney’s fee, in the case of any violation of section 1114(a) of this title or section 220506 of title 36 that consists of intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, offering for sale, or distribution of goods or services. In such cases, the court may in its discretion award prejudgment interest on such amount at an annual interest rate established under section 6621(a)(2) of title 26, commencing on the date of the service of the claimant’s pleadings setting forth the claim for such entry and ending on the date such entry is made, or for such shorter time as the court deems appropriate.”

Subsec. (c)(1). Pub. L. 110-403, §104(1), substituted “$1,000” for “$500” and “$200,000” for “$100,000”.

Subsec. (c)(2). Pub. L. 110-403, §104(2), substituted “$2,000,000” for “$1,000,000”.

2004—Subsec. (e), Pub. L. 108-482 added subsec. (e), 2002—Subsec. (a). Pub. L. 107-273, §13207(a), substituted “a violation under section 1125(a) or (d) of this title,” for “a violation under section 1125(a), (c), or (d) of this title.”


1999—Subsec. (a), Pub. L. 106-113, §1000(a)(9) [title III, §3000(a)(2)], inserted “, (c), or (d)” after “section 1125(a)” in first sentence.

Pub. L. 106-43 substituted “a violation under section 1125(a) of this title, or a willful violation under section 1125(c) of this title, for “or a violation under section 1125(a) of this title, in first sentence.


1996—Subsec. (c), Pub. L. 104-153 added subsec. (c).

1988—Subsec. (a). Pub. L. 100-667 inserted “, or a violation under section 1125(a) of this title,” after “Office” in first sentence.

1986—Subsec. (b), Pub. L. 99-514 substituted “Internal Revenue Code of 1986” for “Internal Revenue Code of 1948”, which for purposes of codification was translated as “title 26” thus requiring no change in text.

1984—Pub. L. 98-473 designated existing provisions as subsec. (a) and added subsec. (b).

1975—Pub. L. 93-960 inserted provisions relating to awarding of attorney fees in exceptional cases.


1962—Pub. L. 87-772 substituted “1114” for “1113(b)(b)”.

Statutory Notes and Related Subsidiaries

Effective Date of 1999 Amendment


“Sections 3002(a), 3003, 3004, 3005, and 3008 of this title (amending this section and sections 1114, 1116, 1125, and 1127 of this title, and enacting provisions set out as a note under section 1051 of this title[1] shall apply to all domain names registered before, on, or after the date of the enactment of this Act [Nov. 29, 1999], except that damages under subsection (a) or (d) of section 35 of the Trademark Act of 1946 (15 U.S.C. 1117), as amended by section 3003 of this title, shall not be available with respect to the registration, trafficking, or use of a domain name that occurs before the date of the enactment of this Act.”

Effective Date of 1998 Amendment

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

Effective Date of 1975 Amendments

Amendment by Pub. L. 93-600 effective Jan. 2, 1975, but not to affect any suit, proceeding, or appeal then pending, see section 4 of Pub. L. 93-600, set out as a note under section 1051 of this title.


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Construction of 2004 Amendment


“(a) FREE SPEECH AND PRESS.—Nothing in this title (see Short Title of 2004 Amendment note set out under section 1051 of this title) shall enlarge or diminish any rights of free speech or of the press for activities related to the registration or use of domain names.

“(b) DISCRETION OF COURTS IN DETERMINING RELIEF.—Nothing in this title shall restrict the discretion of a court in determining damages or other relief to be assessed against a person found liable for the infringement of intellectual property rights.

“(c) DISCRETION OF COURTS IN DETERMINING TERMS OF IMPRISONMENT.—Nothing in this title shall be construed to limit the discretion of a court to determine the appropriate term of imprisonment for an offense under applicable law.”

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§1118. Destruction of infringing articles

In any action arising under this chapter, in which a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) of this title, or a willful violation under section 1125(c) of this title, shall have been established, the court may order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the registered mark or, in the case of a violation of section 1125(a) of this title or a willful violation under section 1125(c) of this title,
the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation, or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed. The party seeking an order under this section for destruction of articles seized under section 1116(d) of this title shall give ten days’ notice to the United States attorney for the judicial district in which such order is sought (unless good cause is shown for lesser notice) and such United States attorney may, if such destruction may affect evidence of an offense against the United States, seek a hearing on such destruction or participate in any hearing otherwise to be held with respect to such destruction.


Editorial Notes

Prior Provisions


Amendments

1999—Pub. L. 106–43, in first sentence, substituted “a violation under section 1125(a) of this title, or a willful violation under section 1125(c) of this title,” for “or a violation under section 1125(a) of this title,” and inserted “or a willful violation under section 1125(c) of this title” before “, the word,”.

1988—Pub. L. 100–667 inserted in first sentence “, or a violation under section 1125(a) of this title,” after “Office” and “, or, in the case of a violation of section 1125(a) of this title, the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation,” and “registered mark”.

1984—Pub. L. 98–473 inserted “The party seeking an order under this section for destruction of articles seized under section 1116(d) of this title shall give ten days’ notice to the United States attorney for the judicial district in which such order is sought (unless good cause is shown for lesser notice) and such United States attorney may, if such destruction may affect evidence of an offense against the United States, seek a hearing on such destruction or participate in any hearing otherwise to be held with respect to such destruction.”


Statutory Notes and Related Subsidiaries

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1561 of this title.

Effective Date of 1975 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1283, set out in the Appendix to Title 5, Government Organization and Employees.

§1120. Civil liability for false or fraudulent registration

Any person who shall procure registration in the Patent and Trademark Office of a mark by

Effective Date of 1999 Amendment

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1975 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, see Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1283, set out in the Appendix to Title 5, Government Organization and Employees.
a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.


Editorial Notes

Prior Provisions


Amendments


Statutory Notes and Related Subsidiaries

Effective Date of 1975 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Executive Documents

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 3 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§1121. Jurisdiction of Federal courts; State and local requirements that registered trademarks be altered or displayed differently; prohibition

(a) The district and territorial courts of the United States shall have original jurisdiction and the courts of appeals of the United States (other than the United States Court of Appeals for the Federal Circuit) shall have appellate jurisdiction, of all actions arising under this chapter, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties.

(b) No State or other jurisdiction of the United States or any political subdivision or any agency thereof may require alteration of a registered mark, or require that additional trademarks, service marks, trade names, or corporate names that may be associated with or incorporated into the registered mark be displayed in the mark in a manner differing from the display of such additional trademarks, service marks, trade names, or corporate names contemplated by the registered mark as exhibited in the certificate of registration issued by the United States Patent and Trademark Office.


Editorial Notes

Codification

Pub. L. 100–667, §131(b)(1), transferred section 39a of act July 5, 1946, which was classified to section 1121a of this title, to subsec. (b) of this section.

In subsec. (a), the words “and the United States Court of Appeals for the District of Columbia” following “the Courts of Appeal of the United States” have been deleted as superfluous in view of section 41 of Title 28, Judiciary and Judicial Procedure, which includes the District of Columbia within the eleven judicial circuits of the United States. The word “and” has been inserted preceding “the courts of appeal of the United States” to preserve the conjunctive sense of the sentence.

Prior Provisions


Amendments


1988—Subsec. (a). Pub. L. 100–667, §131(a), designated existing provisions as subsec. (a). Subsec. (b). Pub. L. 100–667, §131(b), redesignated section 1121a of this title as subsec. (b) of this section and substituted “service marks” for “servicemarks” in two places.

1982—Pub. L. 97–164 inserted “(other than the United States Court of Appeals for the Federal Circuit)”.

Statutory Notes and Related Subsidiaries

Effective Date of 1998 Amendment

Amendment by Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1982 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§1121a. Transferred

Editorial Notes

Codification

Section, act July 5, 1946, ch. 540, title VI, §39a, as added Oct. 12, 1982, Pub. L. 97–296, 96 Stat. 1316, which prohibited State and local requirements that registered trademarks be altered or displayed differently, was transferred to subsec. (b) of section 39 of act July 5, 1946, by section 131(b)(1) of Pub. L. 100–667 and is classified to section 1121(b) of this title.
§ 1122. Liability of United States and States, and instrumentalities and officials thereof

(a) Waiver of sovereign immunity by the United States

The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or non-governmental entity, for any violation under this chapter.

(b) Waiver of sovereign immunity by States

Any State, instrumentality of a State or any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or non-governmental entity, for any violation under this chapter.

(c) Remedies

In a suit described in subsection (a) or (b) for a violation described therein, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for such a violation in a suit against any person other than the United States or any agency or instrumentality thereof, or any individual, firm, corporation, or other person acting for the United States and with authorization and consent of the United States, or a State, instrumentality of a State, or officer or employee of a State or instrumentality of a State acting in his or her official capacity. Such remedies include injunctive relief under section 1116 of this title, actual damages, costs and attorney’s fees under section 1116 of this title, destruction of infringing articles under section 1118 of this title, the remedies provided for under sections 1114, 1119, 1120, 1124 and 1125 of this title, and for any other remedies provided under this chapter.


Editorial Notes

PRIORITY PROVISIONS

A prior section 1122, act July 5, 1946, ch. 540, title VI, §40, 60 Stat. 440, related to review of cases by the Supreme Court, prior to repeal by act May 24, 1949, ch. 139, §142, 63 Stat. 109. See section 1254 of Title 28, Judiciary and Judicial Procedure.

AMENDMENTS


Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1006(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

EFFECTIVE DATE OF 1975 AMENDMENT


REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Executive Documents

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 6 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1124. Importation of goods bearing infringing marks or names forbidden

Except as provided in subsection (d) of section 1526 of title 19, no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer, or
§ 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term “any person” includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.
§ 1125

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), “dilution by blurring” is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source of the person’s own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if—

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection—

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action

The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action against that person, with respect to that mark, that—

(A) is brought by another person under the common law or a statute of a State; and

(B)(i) seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.
(7) Savings clause

Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

(d) Cyberpiracy prevention

(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that—

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

(B)(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c).

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if—

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c); and

(ii) the court finds that the owner—

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by—

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which—

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the
registration and use of the domain name are deposited with the court.

(D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall—

(I) expeditiously deposit with the court documents sufficient to establish the court’s control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.


Editorial Notes

REFERENCES IN TEXT


CONSTITUTIONALITY

For information regarding constitutionality of this section, see Congressional Research Service, The Constitution of the United States of America: Analysis and Interpretation, Table of Laws Held Unconstitutional in Whole or in Part by the Supreme Court.

PRIOR PROVISIONS


AMENDMENTS

2012—Subsec. (c)(6). Pub. L. 112–190 added subpars. (A) and (B) and struck out former subpars. (A) and (B) which read as follows:

"(A)(i) is brought by another person under the common law or a statute of a State; and

"(ii) seeks to prevent dilution by blurring or dilution by tarnishment; or

"(B) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

2006—Subsec. (c). Pub. L. 106–312, § 2(1), added subsec. (c) and struck out former subsec. (c) which related to remedies for dilution of famous marks.


1992—Subsec. (a). Pub. L. 102–542 designated existing provisions as par. (1), redesignated former pars. (1) and (2) as subpars. (A) and (B), respectively, and added par. (2).

1988—Subsec. (a). Pub. L. 100–667 amended subsec. (a) generally. Prior to amendment, subsec. (a) read as follows: "Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation."

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2012 AMENDMENT

Pub. L. 112–190, § 1(b), Oct. 5, 2012, 126 Stat. 1436, provided that: "The amendment made by subsection (a) [amending this section] shall apply to any action commenced on or after the date of the enactment of this Act [Oct. 5, 2012]."

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 applicable to all domain names registered before, on, or after Nov. 29, 1999, see section 1000(a)(9) [title III, § 3010] of Pub. L. 106–113, set out as a note under section 1117 of this title.

EFFECTIVE DATE OF 1996 AMENDMENT

Pub. L. 104–98, § 5, Jan. 16, 1996, 109 Stat. 987, provided that: "This Act [amending this section and section 1127 of this title and enacting provisions set out as a note under section 1051 of this title] and the amendments made by this Act will take effect on the date of the enactment of this Act [Jan. 16, 1996]."

EFFECTIVE DATE OF 1992 AMENDMENT

Amendment by Pub. L. 102–542 effective with respect to violations that occur on or after Oct. 27, 1992, see section 4 of Pub. L. 102–542, set out as a note under section 1114 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations
and rights under prior acts, see notes set out under section 1051 of this title.

STUDY ON ABUSIVE DOMAIN NAME REGISTRATIONS INVOLVING PERSONAL NAMES

"(a) Register of marks communicated by international bureaus

The Director shall keep a register of all marks communicated to him by the international bureaus provided for by the conventions for the protection of industrial property, trademarks, trade and commercial names, and the repression of unfair competition to which the United States is or may become a party, and upon the payment of the fees required by such conventions and the fees required in this chapter may place the marks so communicated upon such register. This register shall show a facsimile of the mark or trade or commercial name; the name, citizenship, and address of the registrant; the number, date, and place of the first registration of the mark, including the dates on which application for such registration was filed and granted and the term of such registration; a list of goods or services to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark. This register shall be a continuation of the register provided in section 1(a) of the Act of March 19, 1920.

(b) Benefits of section to persons whose country of origin is party to convention or treaty

Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition, to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of a mark is otherwise entitled by this chapter.

(c) Prior registration in country of origin; country of origin defined

No registration of a mark in the United States by a person described in subsection (b) of this section shall be granted until such mark has been registered in the country of origin of the applicant, unless the applicant alleges use in commerce.

For the purposes of this section, the country of origin of the applicant is the country in which he has a bona fide and effective industrial or commercial establishment, or if he has not such an establishment the country in which he is domiciled, or if he has not a domicile in any of the countries described in subsection (b) of this section, the country of which he is a national.

(d) Right of priority

An application for registration of a mark under section 1051, 1053, 1054, or 1091 of this title or under subsection (e) of this section, filed by a person described in subsection (b) of this section who has previously duly filed an application for registration of the same mark in one of the countries described in subsection (b) shall be accorded the same force and effect as would be accorded to the same application if filed in the United States on the same date on which the application was first filed in such foreign country:

Provided—

(1) the application in the United States is filed within six months from the date on which the application was first filed in the foreign country;

(2) the application conforms as nearly as practicable to the requirements of this chapter, including a statement that the applicant has a bona fide intention to use the mark in commerce;

(3) the rights acquired by third parties before the date of the filing of the first applica-
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(e) Registration on principal or supplemental register; copy of foreign registration

A mark duly registered in the country of origin of the foreign applicant may be registered on the principal register if eligible, otherwise on the supplemental register in this chapter provided. Such applicant shall submit, within such time period as may be prescribed by the Director, a true copy, a photocopy, a certification, or a certified copy of the registration in the country of origin of the applicant. The application must state the applicant’s bona fide intention to use the mark in commerce, but use in commerce need not be alleged has a bona fide intention to use the mark in commerce, but use in commerce need not be alleged, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(f) Domestic registration independent of foreign registration

The registration of a mark under the provisions of subsections (c), (d), and (e) of this section by a person described in subsection (b) shall be independent of the registration in the country of origin and the duration, validity, or transfer in the United States of such registration shall be governed by the provisions of this chapter.

(g) Trade or commercial names of foreign nationals protected without registration

Trade names or commercial names of persons described in subsection (b) of this section shall be protected without the obligation of filing or registration whether or not they form parts of marks.

(h) Protection of foreign nationals against unfair competition

Any person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this chapter shall be entitled to effective protection against unfair competition, and the remedies provided in this chapter for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.

(i) Citizens or residents of United States entitled to benefits of section

Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in subsection (b) of this section.


Editorial Notes

References in Text

Section 1(a) of the Act of March 19, 1920, referred to in subsec. (a), is section 1(a) of act Mar. 19, 1920, ch. 104, 41 Stat. 533, which was classified to section 121(a) of this title, and repealed by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444, insofar as inconsistent with this chapter.

Prior Provisions


Amendments


1998—Subsec. (d). Pub. L. 105–330, § 108(1)(A), in introductory provisions, substituted “1091 of this title or under subsection (e) of this section” for “1091 of this title, or subsection (e) of this section”.


Subsec. (e). Pub. L. 105–330, § 108(2), substituted “Such applicant shall submit, within such time period as may be prescribed by the Commissioner, a certification or a certified copy of the registration in the country of origin of the applicant” for “The application therefore shall be accompanied by a certification or a certified copy of the registration in the country of origin of the applicant”.

1988—Subsec. (a). Pub. L. 100–667, § 133(2), substituted “required in this chapter” for “herein prescribed”.

Subsec. (c). Pub. L. 100–667, § 133(1), made technical amendment in two places to references in the original act to subsection (b) of this section, resulting in no change in text.

Subsec. (d). Pub. L. 100–667, § 133(1), (3), (4), (5), in introductory provisions, made technical amendment in two places to references in the original act to subsection (b) of this section, resulting in no change in text.

Subsec. (e). Pub. L. 100–667, § 133(b), inserted at end “The application must state the applicant’s bona fide intention to use the mark in commerce, but use in commerce shall not be required prior to registration.”
Subsec. (f). Pub. L. 100–667, §133(1), (7), made technical amendment to references in the original act to subsections (c), (d), and (e) of this section and to subsection (b) of this section, resulting in no change in text.

Subsecs. (g) to (i). Pub. L. 100–667, §133(1), (8), made technical amendment to references in the original act to subsection (b) of this section, resulting in no change in text.

1962—Subsec. (b). Pub. L. 87–772 inserted “or extends reciprocal rights to nationals of the United States by law,” and substituted provisions requiring the person’s country of origin to be a party to any convention or treaty, for provisions which required such persons to be nationals of, domiciled in, or have a bona fide and effective business or commercial establishment in a foreign country which was a party to the International Convention for the Protection of Industrial Property, or the General Inter-American Convention for Trade Mark and Commercial Protection, or any other convention or treaty relating to trademarks, trade, or commercial names.

Subsec. (e). Pub. L. 87–772 inserted “certification or a” after “accompanied by a” and struck out “application for or” before “registration”.

1961—Subsec. (d). Pub. L. 87–333 inserted par. at end authorizing the right provided by this section to be based upon a subsequent application in the same foreign country, instead of the first application, provided that any foreign application filed prior to such subsequent one was withdrawn, or otherwise disposed of, without having been open to public inspection and without leaving any rights outstanding, nor any basis for claiming priority.

Statutory Notes and Related Subsidiaries

Effective Date of 1999 Amendment

Effective Date of 1998 Amendment

For provisions relating to applicability of amendment by Pub. L. 105–330 to applications for registration of trademarks, see section 109(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

Effective Date of 1998 Amendment
Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 130 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1961 Amendment
Pub. L. 87–333, §3, Oct. 3, 1961, 75 Stat. 748, provided that: “This Act [amending this section and section 119 of Title 35, Patents] shall take effect on the day when the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon, October 31, 1958, comes into force with respect to the United States and shall apply only to applications thereafter filed in the United States by persons entitled to the benefit of said convention, as revised at the time of such filing.”

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Executive Documents

Transfer of Functions
For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§1127. Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

The United States includes and embraces all territory which is under its jurisdiction and control.

The word “commerce” means all commerce which may lawfully be regulated by Congress.

The term “principal register” refers to the register provided for by sections 1051 to 1072 of this title, and the term “supplemental register” refers to the register provided for by sections 1091 to 1096 of this title.

The term “person” and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term “juristic person” includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term “person” also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The terms “applicant” and “registrant” embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

The term “Director” means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

The term “related company” means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

The terms “trade name” and “commercial name” mean any name used by a person to identify his or her business or vocation.

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on
the principal register established by this chapter,
to identify and distinguish his or her goods, in-
cluding a unique product, from those manufac-
tured or sold by others and to indicate the
source of the goods, even if that source is un-
known.

The term “service mark” means any word, name, symbol, or device, or any combina-
tion thereof—
(1) used by a person, or
(2) which a person has a bona fide intention
to use in commerce and applies to register on
the principal register established by this chapter,
to identify and distinguish the services of one
person, including a unique service, from the
services of others and to indicate the source of
the services, even if that source is unknown. Ti-
tles, character names, and other distinctive fea-
tures of radio or television programs may be
registered as service marks notwithstanding
that they, or the programs, may advertise the
goods of the sponsor.

The term “certification mark” means any
word, name, symbol, or device, or any combina-
tion thereof—
(1) used by a person other than its owner, or
(2) which its owner has a bona fide intention
to permit a person other than the owner to use
in commerce and files an application to reg-
ister on the principal register established by
this chapter,
to certify regional or other origin, material,
mode of manufacture, quality, accuracy, or
other characteristics of such person’s goods or
services or that the work or labor on the goods
or services was performed by members of a
union or other organization.

The term “collective mark” means a trade-
mark or service mark—
(1) used by the members of a cooperative, an
association, or other collective group or organi-
zation, or
(2) which such cooperative, association, or
other collective group or organization has a
bona fide intention to use in commerce and
applies to register on the principal register es-
tablished by this chapter,
and includes marks indicating membership in a
union, an association, or other organization.

The term “mark” includes any trademark,
service mark, collective mark, or certification
mark.

The term “use in commerce” means the bona
fide use of a mark in the ordinary course of
trade, and not made merely to reserve a right in
a mark. For purposes of this chapter, a mark
shall be deemed to be in use in commerce—
(1) on goods when—
(A) it is placed in any manner on the goods
or their containers or the displays associ-
ated therewith or on the tags or labels af-
fixed thereto, or if the nature of the goods
makes such placement impracticable, then
on documents associated with the goods or
their sale, and
(B) the goods are sold or transported in
commerce, and
(2) on services when it is used or displayed in
the sale or advertising of services and the
services are rendered in commerce, or the
services are rendered in more than one State
or in the United States and a foreign country
and the person rendering the services is en-
gaged in commerce in connection with the
services.

A mark shall be deemed to be “abandoned” if
either of the following occurs:
(1) When its use has been discontinued with
intention not to resume such use. Intent not to
resume may be inferred from circumstances.
Nonuse for 3 consecutive years shall be prima
facie evidence of abandonment. “Use” of a
mark means the bona fide use of such mark
made in the ordinary course of trade, and not
made merely to reserve a right in a mark.
(2) When any course of conduct of the owner,
including acts of omission as well as commis-
sion, causes the mark to become the generic
name for the goods or services on or in connec-
tion with which it is used or otherwise to lose
its significance as a mark. Purchaser motiva-
tion shall not be a test for determining aban-
donment under this paragraph.

The term “colorable imitation” includes any
mark which so resembles a registered mark as
to be likely to cause confusion or mistake or
to deceive.

The term “registered mark” means a mark
registered in the United States Patent and
Trademark Office under this chapter or under
the Act of March 3, 1881, or the Act of February
20, 1905, or the Act of March 19, 1920. The phrase
“marks registered in the Patent and Trademark
Office” means registered marks.

The term “Act of March 3, 1881”, “Act of Feb-
uary 20, 1905”, or “Act of March 19, 1920”,
means the respective Act as amended.

A “counterfeit” is a spurious mark which is
identical with, or substantially indistinguis-
able from, a registered mark.

The term “domain name” means any alpha-
numeric designation which is registered with
or assigned by any domain name registrar, domain
name registry, or other domain name registra-
tion authority as part of an electronic address
on the Internet.

The term “Internet” has the meaning given
that term in section 230(f)(4) of title 47.

Words used in the singular include the plural
and vice versa.

The intent of this chapter is to regulate com-
merce within the control of Congress by making
actionable the deceptive and misleading use of
marks in such commerce; to protect registered
marks used in such commerce from interference
by State, or territorial legislation; to protect
persons engaged in such commerce against un-
fair competition; to prevent fraud and deception
in such commerce by the use of reproductions,
copies, counterfeits, or colorable imitations of
registered marks; and to provide rights and rem-
edies stipulated by treaties and conventions re-
specting trademarks, trade names, and unfair
competition entered into between the United
States and foreign nations.


**Editorial Notes**

**References in Text**

Acts March 3, 1861, February 20, 1905, and March 19, 1920, referred to in text, are acts Mar. 3, 1881, ch. 138, 21 Stat. 562; Feb. 20, 1905, ch. 592, 33 Stat. 724; and Mar. 19, 1920, ch. 104, 41 Stat. 533, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 448, 59 Stat. 1183, and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

**Prior Provisions**


**Amendments**


1999—Pub. L. 106–113, §1006(a)(9) [title IV, §4732(b)(1)(A)], substituted par. defining “Director” for par. which read as follows: “The term ‘Commissioneer’ means the Commissioner of Patents and Trademarks.”

Pub. L. 106–113, §1006(a)(9) [title III, §3005], inserted par. defining “domain name” and “Internet” after par. defining “counterfeit.”

Pub. L. 106–43, §6(b), substituted “trademarks” for “trade-marks” in last undesignated par.

Pub. L. 106–43, §4(c), between par. defining “person” inserted: “The term ‘person’ also includes any State, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States, and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.”

L. 104–98 inserted par. defining “dilution” after par. defining “abandoned”.

1994—Pub. L. 103–465 amended par. defining “abandoned” generally. Prior to amendment, par. read as follows: “A mark shall be deemed to be ‘abandoned’ when either of the following occurs:

“(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. ‘Use’ of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

“(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.”

1967—Pub. L. 89–843 inserted after fourth undesignated par. “The term ‘person’ also includes any State, any agency or instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.”

1965—Pub. L. 89–667, §134(1), amended par. defining “related company” generally. Prior to amendment, par. read as follows: “The term ‘related company’ means any person who legitimately controls or is controlled by the registrant or applicant for registration in respect to the nature and quality of the goods or services in connection with which the mark is used.”

Pub. L. 100–667, §134(2), amended par. defining “trade name” and “commercial name” generally. Prior to amendment, par. read as follows: “The terms ‘trade name’ and ‘commercial name’ include individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturists, and others to identify their businesses, vocations, or occupations; the names or titles lawfully adopted and used by persons, firms, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.”

Pub. L. 100–667, §134(3), amended par. defining “trademark” generally. Prior to amendment, par. read as follows: “The term ‘trademark’ includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”

Pub. L. 100–667, §134(4), amended par. defining “service mark” generally. Prior to amendment, par. read as follows: “The term ‘service mark’ means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.”

Pub. L. 100–667, §134(5), amended par. defining “certification mark” generally. Prior to amendment, par. read as follows: “The term ‘certification mark’ means a mark used upon or in connection with the products or services of one or more persons other than the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of such goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.”

Pub. L. 100–667, §134(6), amended par. defining “collective mark” generally. Prior to amendment, par. read as follows: “The term ‘collective mark’ means a trade-mark or service mark used by the members of a cooperative, an association or other collective group or organization and includes marks used to indicate membership in a union, an association or other organization.”

Pub. L. 100–667, §134(7), amended par. defining “mark” generally. Prior to amendment, par. read as follows: “The term ‘mark’ includes any trade-mark, service mark, collective mark, or certification mark entitled to registration under this chapter whether registered or not.”

Pub. L. 100–667, §134(8), substituted par. defining “use in commerce” for former par. which read as follows: “For the purposes of this chapter a mark shall be deemed to be used in commerce (a) on goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto and the goods are sold or transported in commerce and (b) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in this and a
The term ‘basic application’ means the application for the registration of a mark that identifies merchandise or services of the applicant and constitutes the basis for an application for registration of the mark. Amended by Pub. L. 103–374, title VI, §653, Sept. 29, 1999, 113 Stat. 1536, 1501A–586, which related to cyberpiracy protections for individuals, was transferred to section 8331 of this title.

SUBCHAPTER IV—THE MADRID PROTOCOL

§1141. Definitions

In this subchapter:

(1) 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 ap-
application for the international registration of that mark.

(2) 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.

(3) Contracting Party
The term “Contracting Party” means any country or inter-governmental organization that is a party to the Madrid Protocol.

(4) Date of recordal
The term “date of recordal” means the date on which a request for extension of protection, filed after an international registration is granted, is recorded on the International Register.

(5) 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, mistake, or deception.

(6) Extension of protection
The term “extension of protection” means the protection resulting from an international registration that extends to the United States at the request of the holder of the international registration, in accordance with the Madrid Protocol.

(7) 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.

(8) International application
The term “international application” means an application for international registration that is filed under the Madrid Protocol.

(9) International Bureau

(10) International Register
The term “International Register” means the official collection of data concerning international registrations maintained by the International Bureau that the Madrid Protocol or its implementing regulations require or permit to be recorded.

(11) International registration
The term “international registration” means the registration of a mark granted under the Madrid Protocol.

(12) International registration date
The term “international registration date” means the date assigned to the international registration by the International Bureau.

(13) 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.

(14) Notification of refusal
The term “notification of refusal” means the notice sent by the United States Patent and Trademark Office 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 United States Patent and Trademark Office, including any extension of time granted under section 1063 of this title.


Statutory Notes and Related Subsidiaries

Effective Date

‘‘(1) the date on which the Madrid Protocol (as defined in section 60 of the Trademark Act of 1946 [this section]) enters into force with respect to the United States [Nov. 2, 2003]; or

‘‘(2) the date occurring 1 year after the date of enactment of this Act [Nov. 2, 2002].’’

""
§ 1141a. International applications based on United States applications or registrations

(a) In general

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

(b) Qualified owners

A qualified owner, under subsection (a), shall—

(1) be a national of the United States;
(2) be domiciled in the United States; or
(3) have a real and effective industrial or commercial establishment in the United States.


§ 1141b. Certification of the international application

(a) Certification procedure

Upon the filing of an application for international registration and payment of the prescribed fees, the Director 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.

(b) Transmittal

Upon examination and certification of the international application, the Director shall transmit the international application to the International Bureau.


§ 1141c. 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 1141b of this title, the Director 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 respect 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.


§ 1141d. 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 United States 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 United States 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 Director.


§ 1141e. Extension of protection of an international registration to the United States under the Madrid Protocol

(a) In general

Subject to the provisions of section 1141h of this title, 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 the United States is office of origin

Where the United States Patent and Trademark Office is the office of origin for a trademark application or registration, any international registration based on such application or registration cannot be used to obtain the benefits of the Madrid Protocol in the United States.


§ 1141f. 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 United States 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 1141h of this title, 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 1057(c) of this title, as of the earliest of the following:
§ 1141g. Right of priority for request for extension of protection to the United States

The holder of an international registration with a request for an extension of protection to the United States shall be entitled to claim a date of priority based on a right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if-

(1) the request for extension of protection contains a claim of priority; and

(2) the date of international registration or the date of the 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 for the Protection of Industrial Property).


§ 1141h. 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 1141f(a) of this title shall be examined as an application for registration on the Principal Register under this chapter, and if on such examination it appears that the applicant is entitled to extension of protection under this subchapter, the Director shall cause the mark to be published in the Official Gazette of the United States Patent and Trademark Office.

(2) Subject to the provisions of subsection (c), a request for extension of protection under this subchapter shall be subject to opposition under section 1063 of this title.

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

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

(b) Notification of refusal

If,1 a request for extension of protection is refused under subsection (a), the Director 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.

1So in original. The comma probably should not appear.

(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 Director 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 Director has sent a notification of the possibility of opposition under paragraph (1)(C), the Director 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 Director 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 Director 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 registration of the mark may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served. Such notices or process may be served upon the person designated by leaving with that person, or mailing to that person, a copy thereof at the address specified in the last designation filed. If the person designated cannot be found at the address given in the last designation, or if the holder does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person residing in the United States for service of notices or process in proceedings affecting the mark, the notice or process may be served on the Director.

§ 1141i. Effect of extension of protection

(a) Issuance of extension of protection

Unless a request for extension of protection is refused under section 1141h of this title, the Director shall issue a certificate of extension of protection pursuant to the request and shall cause notice of such certificate of extension of protection to be published in the Official Gazette of the United States 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.


§ 1141j. 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 United States 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 Director 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 protection 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 Protocol, may file an application, under section 1051 or 1126 of this title, 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 1141g of this title, shall enjoy the same priority. Such an application shall be entitled to the benefits conferred by this subsection only if the application is filed not later than 3 months after the date on which the international registration was canceled, in whole or in part, and only if the application complies with all the requirements of this chapter which apply to any application filed pursuant to section 1051 or 1126 of this title.


§ 1141k. Duration, affidavits and fees

(a) Time periods for required affidavits

Each extension of protection for which a certificate has been issued under section 1141i of this title 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 Director unless the holder of the international registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods:

(1) Within the 1-year period immediately preceding the expiration of 6 years following the date of issuance of the certificate of extension of protection.

(2) Within the 1-year period immediately preceding the expiration of 10 years following the date of issuance of the certificate of extension of protection, and each successive 10-year period following the date of issuance of the certificate of extension of protection.

(3) The holder may file the affidavit required under this section within a grace period of 6 months after the end of the applicable time period established in paragraph (1) or (2), together with the fee described in subsection (b) and the additional grace period surcharge prescribed by the Director.

(b) Requirements for affidavit

The affidavit referred to in subsection (a) shall—

(1) (A) state that the mark is in use in commerce;

(B) set forth the goods and services recited in the extension of protection and in connection with which the mark is in use in commerce;

(C) be accompanied by such number of specimens or facsimiles showing current use of the mark in commerce as may be required by the Director; and

(D) be accompanied by the fee prescribed by the Director; or

(2) (A) set forth the goods and services recited in the extension of protection and in connection with which the mark is not in use in commerce;

(B) include a showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark; and

(C) be accompanied by the fee prescribed by the Director.

(c) Deficient affidavit

If any submission filed within the period set forth in subsection (a) is deficient, including that the affidavit was not filed in the name of
the holder of the international registration, the
deficiency may be corrected after the statutory
time period, within the time prescribed after no-
tification of the deficiency. Such submission
shall be accompanied by the additional defi-
cency surcharge prescribed by the Director.

(d) Notice of requirement

Special notice of the requirement for such affi-
davit shall be attached to each certificate of ex-
tension of protection.

(e) Notification of acceptance or refusal

The Director shall notify the holder of the in-
ternational registration who files any affi-
davit required by this section of the Director’s
acceptance or refusal thereof and, in the case of
a refusal, the reasons therefor.

(f) Designation of resident for service of process
and notices

If the holder of the international registration
of the mark is not domiciled in the United
States, the holder may designate, by a docu-
ment filed in the United States 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 leav-
ing with that person or mailing to that person a
copy thereof at the address specified in the last
designation so filed. If the person so designated
cannot be found at the last designated address,
or if the holder does not designate by a docu-
m ent filed in the United States Patent and
Trademark Office the name and address of a per-
sion resident in the United States on whom
may be served notices or process in proceedings af-
f ecting the mark, such notices or process may
be served on the Director.

(July 5, 1946, ch. 540, title XII, § 71, as added Pub.

Editorial Notes

AMENDMENTS

to amendment, section related to required affidavits
and fees, contents of affidavit, notification of Direc-
tor’s acceptance or refusal, and service of notice
or process.

§ 1141f. 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 in-
dustrial or commercial establishment either in a
country that is a Contracting Party or in a
country that is a member of an intergovern-
mental organization that is a Contracting Party.

(July 5, 1946, ch. 540, title XII, § 72, as added Pub.
Stat. 1920.)

§ 1141m. Incontestability

The period of continuous use prescribed under
section 1065 of this title for a mark covered by
an extension of protection issued under this sub-
chapter may begin no earlier than the date on
which the Director issues the certificate of the
extension of protection under section 1141l of
this title, except as provided in section 1141n of
this title.

(July 5, 1946, ch. 540, title XII, § 73, as added Pub.
Stat. 1920.)

§ 1141n. Rights of extension of protection

When a United States registration and a sub-
sequently issued certificate of extension of pro-
tection to the United States are owned by the
same person, identify the same mark, and list
the same goods or services, the extension of pro-
tection shall have the same rights that accrued
to the registration prior to issuance of the cer-
tificate of extension of protection.

(July 5, 1946, ch. 540, title XII, § 74, as added Pub.
Stat. 1920.)

CHAPTER 23—DISSEMINATION OF TECH-
NICAL, SCIENTIFIC AND ENGINEERING IN-
FORMATION

§ 1151. Purpose of chapter

The purpose of this chapter is to make the re-
results of technological research and development
more readily available to industry and business,
and to the general public, by clarifying and de-
fining the functions and responsibilities of the
Department of Commerce as a central clear-
inghouse for technical information which is useful
to American industry and business.

(Sept. 9, 1950, ch. 936, § 1, 64 Stat. 823.)

§ 1152. Clearinghouse for technical information;
removal of security classification

The Secretary of Commerce (hereinafter re-
ferred to as the "Secretary") is directed to es-
ablish and maintain within the Department of
Commerce a clearinghouse for the collection
and dissemination of scientific, technical, and
engineering information, and to this end to take
such steps as he may deem necessary and desir-
able—

(a) To search for, collect, classify, coordinate,
integrate, record, and catalog such information
from whatever sources, foreign and domestic,
that may be available;

(b) To make such information available to in-
dustry and business, to State and local govern-
ments, to other agencies of the Federal Gov-
ernment, and to the general public, through the
preparation of abstracts, digests, translations,
bibliographies, indexes, and microfilm and other