

105TH CONGRESS
1ST SESSION

H. R. 1661

IN THE SENATE OF THE UNITED STATES

JULY 23, 1997

Received; read twice and referred to the Committee on the Judiciary

AN ACT

To implement the provisions of the Trademark Law Treaty.

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

1 **SECTION 1. SHORT TITLE.**

2 This Act may be cited as the “Trademark Law Trea-
3 ty Implementation Act”.

4 **SEC. 2. REFERENCE TO THE TRADEMARK ACT OF 1946.**

5 For purposes of this Act, the Act entitled “An Act
6 to provide for the registration and protection of trade-
7 marks used in commerce, to carry out the provisions of
8 certain international conventions, and for other purposes”,
9 approved July 5, 1946 (15 U.S.C. 1051 et seq.), shall be
10 referred to as the “Trademark Act of 1946”.

11 **SEC. 3. APPLICATION FOR REGISTRATION; VERIFICATION.**

12 (a) APPLICATION FOR USE OF TRADEMARK.—Sec-
13 tion 1(a) of the Trademark Act of 1946 (15 U.S.C.
14 1051(a)) is amended to read as follows:

15 “SECTION 1. (a)(1) The owner of a trademark used
16 in commerce may request registration of its trademark on
17 the principal register hereby established by paying the pre-
18 scribed fee and filing in the Patent and Trademark Office
19 an application and a verified statement, in such form as
20 may be prescribed by the Commissioner, and such number
21 of specimens or facsimiles of the mark as used as may
22 be required by the Commissioner.

23 “(2) The application shall include specification of the
24 applicant’s domicile and citizenship, the date of the appli-
25 cant’s first use of the mark, the date of the applicant’s

1 first use of the mark in commerce, the goods in connection
2 with which the mark is used, and a drawing of the mark.

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

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

9 “(B) to the best of the verifier’s knowledge and
10 belief, the facts recited in the application are accu-
11 rate;

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

13 “(D) to the best of the verifier’s knowledge and
14 belief, no other person has the right to use such
15 mark in commerce either in the identical form there-
16 of or in such near resemblance thereto as to be like-
17 ly, when used on or in connection with the goods of
18 such other person, to cause confusion, or to cause
19 mistake, or to deceive, except that, in the case of
20 every application claiming concurrent use, the appli-
21 cant shall—

22 “(i) state exceptions to the claim of exclu-
23 sive use; and

24 “(ii) shall specify, to the extent of the ver-
25 ifier’s knowledge—

1 “(I) any concurrent use by others;

2 “(II) the goods on or in connection
3 with which and the areas in which each
4 concurrent use exists;

5 “(III) the periods of each use; and

6 “(IV) the goods and area for which
7 the applicant desires registration.

8 “(4) The applicant shall comply with such rules or
9 regulations as may be prescribed by the Commissioner.
10 The Commissioner shall promulgate rules prescribing the
11 requirements for the application and for obtaining a filing
12 date herein.”.

13 (b) APPLICATION FOR BONA FIDE INTENTION TO
14 USE TRADEMARK.—Subsection (b) of section 1 of the
15 Trademark Act of 1946 (15 U.S.C. 1051(b)) is amended
16 to read as follows:

17 “(b)(1) A person who has a bona fide intention,
18 under circumstances showing the good faith of such per-
19 son, to use a trademark in commerce may request reg-
20 istration of its trademark on the principal register hereby
21 established by paying the prescribed fee and filing in the
22 Patent and Trademark Office an application and a verified
23 statement, in such form as may be prescribed by the Com-
24 missioner.

1 “(2) The application shall include specification of the
2 applicant’s domicile and citizenship, the goods in connec-
3 tion with which the applicant has a bona fide intention
4 to use the mark, and a drawing of the mark.

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

7 “(A) that the person making the verification be-
8 lieves that he or she, or the juristic person in whose
9 behalf he or she makes the verification, to be enti-
10 tled to use the mark in commerce;

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

13 “(C) that, to the best of the verifier’s knowl-
14 edge and belief, the facts recited in the application
15 are accurate; and

16 “(D) that, to the best of the verifier’s knowl-
17 edge and belief, no other person has the right to use
18 such mark in commerce either in the identical form
19 thereof or in such near resemblance thereto as to be
20 likely, when used on or in connection with the goods
21 of such other person, to cause confusion, or to cause
22 mistake, or to deceive.

23 Except for applications filed pursuant to section 44, no
24 mark shall be registered until the applicant has met the
25 requirements of subsections (c) and (d) of this section.

1 “(4) The applicant shall comply with such rules or
 2 regulations as may be prescribed by the Commissioner.
 3 The Commissioner shall promulgate rules prescribing the
 4 requirements for the application and for obtaining a filing
 5 date herein.”.

6 (c) CONSEQUENCE OF DELAYS.—Paragraph (4) of
 7 section 1(d) of the Trademark Act of 1946 (15 U.S.C.
 8 1051(d)(4)) is amended to read as follows:

9 “(4) The failure to timely file a verified statement
 10 of use under paragraph (1) or an extension request under
 11 paragraph (2) shall result in abandonment of the applica-
 12 tion, unless it can be shown to the satisfaction of the Com-
 13 missioner that the delay in responding was unintentional,
 14 in which case the time for filing may be extended, but for
 15 a period not to exceed the period specified in paragraphs
 16 (1) and (2) for filing a statement of use.”.

17 **SEC. 4. REVIVAL OF ABANDONED APPLICATION.**

18 Section 12(b) of the Trademark Act of 1946 (15
 19 U.S.C. 1062(b)) is amended in the last sentence by strik-
 20 ing “unavoidable” and by inserting “unintentional”.

21 **SEC. 5. DURATION OF REGISTRATION; CANCELLATION; AF-**
 22 **FIDAVIT OF CONTINUED USE; NOTICE OF**
 23 **COMMISSIONER’S ACTION.**

24 Section 8 of the Trademark Act of 1946 (15 U.S.C.
 25 1058) is amended to read as follows:

1 “DURATION

2 “SEC. 8. (a) Each registration shall remain in force
3 for 10 years, except that the registration of any mark shall
4 be canceled by the Commissioner for failure to comply
5 with the provisions of subsection (b) of this section, upon
6 the expiration of the following time periods, as applicable:

7 “(1) For registrations issued pursuant to the
8 provisions of this Act, at the end of 6 years follow-
9 ing the date of registration.

10 “(2) For registrations published under the pro-
11 visions of section 12(c), at the end of 6 years follow-
12 ing the date of publication under such section.

13 “(3) For all registrations, at the end of each
14 successive 10-year period following the date of reg-
15 istration.

16 “(b) During the 1-year period immediately preceding
17 the end of the applicable time period set forth in sub-
18 section (a), the owner of the registration shall pay the pre-
19 scribed fee and file in the Patent and Trademark Office—

20 “(1) an affidavit setting forth those goods or
21 services recited in the registration on or in connec-
22 tion with which the mark is in use in commerce and
23 such number of specimens or facsimiles showing cur-
24 rent use of the mark as may be required by the
25 Commissioner; or

1 “(2) an affidavit setting forth those goods or
2 services recited in the registration on or in connec-
3 tion with which the mark is not in use in commerce
4 and showing that any such nonuse is due to special
5 circumstances which excuse such nonuse and is not
6 due to any intention to abandon the mark.

7 “(c) The owner of the registration may make the sub-
8 missions required by this section, or correct any deficiency
9 in a timely filed submission, within a grace period of 6
10 months after the end of the applicable time period set
11 forth in subsection (a). Such submission must be accom-
12 panied by a surcharge prescribed therefor. If any submis-
13 sion required by this section filed during the grace period
14 is deficient, the deficiency may be corrected within the
15 time prescribed after notification of the deficiency. Such
16 submission must be accompanied by a surcharge pre-
17 scribed therefor.

18 “(d) Special notice of the requirement for affidavits
19 under this section shall be attached to each certificate of
20 registration and notice of publication under section 12(c).

21 “(e) The Commissioner shall notify any owner who
22 files 1 of the affidavits required by this section of the Com-
23 missioner’s acceptance or refusal thereof and, in the case
24 of a refusal, the reasons therefor.

1 “(f) If the registrant is not domiciled in the United
2 States, the registrant shall designate by a written docu-
3 ment filed in the Patent and Trademark Office the name
4 and address of some person resident in the United States
5 on whom may be served notices or process in proceedings
6 affecting the mark. Such notices or process may be served
7 upon the person so designated by leaving with that person
8 or mailing to that person a copy thereof at the address
9 specified in the last designation so filed. If the person so
10 designated cannot be found at the address given in the
11 last designation, such notice or process may be served
12 upon the Commissioner.”.

13 **SEC. 6. RENEWAL OF REGISTRATION.**

14 Section 9 of the Trademark Act of 1946 (15 U.S.C.
15 1059) is amended to read as follows:

16 “RENEWAL OF REGISTRATION

17 “SEC. 9. (a) Subject to the provisions of section 8,
18 each registration may be renewed for periods of 10 years
19 at the end of each successive 10-year period following the
20 date of registration upon payment of the prescribed fee
21 and the filing of a written application, in such form as
22 may be prescribed by the Commissioner. Such application
23 may be made at any time within 1 year before the end
24 of each successive 10-year period for which the registra-
25 tion was issued or renewed, or it may be made within a
26 grace period of 6 months after the end of each successive

1 10-year period, upon payment of a fee and surcharge pre-
2 scribed therefor. If any application filed during the grace
3 period is deficient, the deficiency may be corrected within
4 the time prescribed after notification of the deficiency,
5 upon payment of a surcharge prescribed therefor.

6 “(b) If the Commissioner refuses to renew the reg-
7 istration, the Commissioner shall notify the registrant of
8 the Commissioner’s refusal and the reasons therefor.

9 “(c) If the registrant is not domiciled in the United
10 States, the registrant shall designate by a written docu-
11 ment filed in the Patent and Trademark Office the name
12 and address of some person resident in the United States
13 on whom may be served notices or process in proceedings
14 affecting the mark. Such notices or process may be served
15 upon the person so designated by leaving with that person
16 or mailing to that person a copy thereof at the address
17 specified in the last designation so filed. If the person so
18 designated cannot be found at the address given in the
19 last designation, such notice or process may be served
20 upon the Commissioner.”.

21 **SEC. 7. RECORDING ASSIGNMENT OF MARK.**

22 Section 10 of the Trademark Act of 1946 (15 U.S.C.
23 1060) is amended to read as follows:

24 “ASSIGNMENT

25 “SEC. 10. (a) A registered mark or a mark for which
26 an application to register has been filed shall be assignable

1 with the good will of the business in which the mark is
2 used, or with that part of the good will of the business
3 connected with the use of and symbolized by the mark.
4 Notwithstanding the preceding sentence, no application to
5 register a mark under section 1(b) shall be assignable
6 prior to the filing of an amendment under section 1(c)
7 to bring the application into conformity with section 1(a)
8 or the filing of the verified statement of use under section
9 1(d), except for an assignment to a successor to the busi-
10 ness of the applicant, or portion thereof, to which the
11 mark pertains, if that business is ongoing and existing.
12 In any assignment authorized by this section, it shall not
13 be necessary to include the good will of the business con-
14 nected with the use of and symbolized by any other mark
15 used in the business or by the name or style under which
16 the business is conducted. Assignments shall be by instru-
17 ments in writing duly executed. Acknowledgment shall be
18 prima facie evidence of the execution of an assignment,
19 and when the prescribed information reporting the assign-
20 ment is recorded in the Patent and Trademark Office, the
21 record shall be prima facie evidence of execution. An as-
22 signment shall be void against any subsequent purchaser
23 for valuable consideration without notice, unless the pre-
24 scribed information reporting the assignment is recorded
25 in the Patent and Trademark Office within 3 months after

1 the date of the subsequent purchase or prior to the subse-
 2 quent purchase. The Patent and Trademark Office shall
 3 maintain a record of information on assignments, in such
 4 form as may be prescribed by the Commissioner.

5 “(b) An assignee not domiciled in the United States
 6 shall designate by a written document filed in the Patent
 7 and Trademark Office the name and address of some per-
 8 son resident in the United States on whom may be served
 9 notices or process in proceedings affecting the mark. Such
 10 notices or process may be served upon the person so des-
 11 ignated by leaving with that person or mailing to that per-
 12 son a copy thereof at the address specified in the last des-
 13 ignation so filed. If the person so designated cannot be
 14 found at the address given in the last designation, such
 15 notice or process may be served upon the Commissioner.”.

16 **SEC. 8. INTERNATIONAL CONVENTIONS; COPY OF FOREIGN**
 17 **REGISTRATION.**

18 Section 44 of the Trademark Act of 1946 (15 U.S.C.
 19 1126) is amended—

20 (1) in subsection (d)—

21 (A) by striking “23, or 44(e) of this Act”
 22 and inserting “or 23 of this Act or under sub-
 23 section (e) of this section”; and

1 (B) in paragraphs (3) and (4), by striking
2 “this subsection (d)” and inserting “this sub-
3 section”; and

4 (2) in subsection (e), by striking the second
5 sentence and inserting the following: “Such appli-
6 cant shall submit, within such time period as may be
7 prescribed by the Commissioner, a certification or a
8 certified copy of the registration in the country of
9 origin of the applicant.”.

10 **SEC. 9. MISCELLANEOUS AMENDMENTS.**

11 (a) CANCELLATION OF FUNCTIONAL MARKS.—Sec-
12 tion 14(3) of the Trademark Act of 1946 (15 U.S.C.
13 1064(3)) is amended by inserting “or is functional,” be-
14 fore “or has been abandoned”.

15 (b) INCONTESTABILITY DEFENSES.—Section 33(b)
16 of the Trademark Act of 1946 (15 U.S.C. 1115(b)) is
17 amended—

18 (1) by redesignating paragraph (8) as para-
19 graph (9); and

20 (2) by inserting after paragraph (7) the follow-
21 ing:

22 “(8) That the mark is functional; or”.

23 (c) REMEDIES IN CASES OF DILUTION OF FAMOUS
24 MARKS.—

1 (1) INJUNCTIONS.—(A) Section 34(a) of the
2 Trademark Act of 1946 (15 U.S.C. 1116(a)) is
3 amended in the first sentence by striking “section
4 43(a)” and inserting “subsection (a) or (c) of sec-
5 tion 43”.

6 (B) Section 43(c)(2) of the Trademark Act of
7 1946 (15 U.S.C. 1125(c)(2)) is amended in the first
8 sentence by inserting “as set forth in section 34”
9 after “relief”.

10 (2) DAMAGES.—Section 35(a) of the Trade-
11 mark Act of 1946 (15 U.S.C. 1117(a)) is amended
12 in the first sentence by striking “or a violation
13 under section 43(a),” and inserting “a violation
14 under section 43(a), or a willful violation under sec-
15 tion 43(c),”.

16 (3) DESTRUCTION OF ARTICLES.—Section 36 of
17 the Trademark Act of 1946 (15 U.S.C. 1118) is
18 amended in the first sentence—

19 (A) by striking “or a violation under sec-
20 tion 43(a),” and inserting “a violation under
21 section 43(a), or a willful violation under sec-
22 tion 43(c),”; and

23 (B) by inserting after “in the case of a vio-
24 lation of section 43(a)” the following: “or a
25 willful violation under section 43(c)”.

1 **SEC. 10. EFFECTIVE DATE.**

2 This Act and the amendments made by this Act shall
3 take effect—

4 (1) on the date that is 1 year after the date of
5 the enactment of this Act, or

6 (2) upon the entry into force of the Trademark
7 Law Treaty with respect to the United States,
8 whichever occurs first.

Passed the House of Representatives July 22, 1997.

Attest:

ROBIN H. CARLE,

Clerk.