

105TH CONGRESS
2D SESSION

S. 2191

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

IN THE SENATE OF THE UNITED STATES

JUNE 18, 1998

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

A BILL

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

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

3 **SECTION 1. SHORT TITLE.**

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

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

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

12 **“TITLE XII—THE MADRID PROTOCOL**

13 **“SEC. 60. DEFINITIONS.**

14 “For purposes of this title:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

20 **“SEC. 61. INTERNATIONAL APPLICATIONS BASED ON**
21 **UNITED STATES APPLICATIONS OR REG-**
22 **ISTRATIONS.**

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

1 istration granted by the Patent and Trademark Office,
2 who—

3 “(1) is a national of the United States,

4 “(2) is domiciled in the United States, or

5 “(3) has a real and effective industrial or com-
6 mercial establishment in the United States,

7 may file an international application by submitting to the
8 Patent and Trademark Office a written application in
9 such form, together with such fees, as may be prescribed
10 by the Commissioner.

11 **“SEC. 62. CERTIFICATION OF THE INTERNATIONAL APPLI-**
12 **CATION.**

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

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

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

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

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

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

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

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

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

4 “(2) with the Patent and Trademark Office for

5 transmittal to the International Bureau, if the re-

6 quest is in such form, and contains such transmittal

7 fee, as may be prescribed by the Commissioner.

8 **“SEC. 65. EXTENSION OF PROTECTION OF AN INTER-**

9 **NATIONAL REGISTRATION TO THE UNITED**

10 **STATES UNDER THE MADRID PROTOCOL.**

11 “(a) IN GENERAL.—Subject to the provisions of sec-

12 tion 68, the holder of an international registration shall

13 be entitled to the benefits of extension of protection of that

14 international registration to the United States to the ex-

15 tent necessary to give effect to any provision of the Madrid

16 Protocol.

17 “(b) IF UNITED STATES IS OFFICE OF ORIGIN.—An

18 extension of protection resulting from an international

19 registration of a mark shall not apply to the United States

20 if the Patent and Trademark Office is the office of origin

21 with respect to that mark.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

16 “(2) If the Commissioner has sent a notification of
17 the possibility of opposition under paragraph (1)(C), the
18 Commissioner shall, if applicable, transmit to the Inter-
19 national Bureau a notification of refusal on the basis of
20 the opposition, together with a statement of all the
21 grounds for the opposition, within 7 months after the be-
22 ginning of the opposition period or within 1 month after
23 the end of the opposition period, whichever is earlier.

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

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

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

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

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

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

4 “(a) ISSUANCE OF EXTENSION OF PROTECTION.—
5 Unless a request for extension of protection is refused
6 under section 68, the Commissioner shall issue a certifi-
7 cate of extension of protection pursuant to the request and
8 shall cause notice of such certificate of extension of protec-
9 tion to be published in the Official Gazette of the Patent
10 and Trademark Office.

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

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

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

20 **“SEC. 70. DEPENDENCE OF EXTENSION OF PROTECTION TO**
21 **THE UNITED STATES ON THE UNDERLYING**
22 **INTERNATIONAL REGISTRATION.**

23 “(a) EFFECT OF CANCELLATION OF INTERNATIONAL
24 REGISTRATION.—If the International Bureau notifies the
25 Patent and Trademark Office of the cancellation of an

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

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

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

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

11 **“SEC. 71. AFFIDAVITS AND FEES.**

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

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

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

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

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

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

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

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

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

13 **“SEC. 73. INCONTESTABILITY.**

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

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

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

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

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

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

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

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

○